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A digest of the reported cases relating



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law

A DIGEST
OF
THE REPORTED CASES
RELATING TO THE
LAW AND PRACTICE
OF
Letters Patent for Inventions
DECIDED
FROM THE PASSING OF THE STATUTE OF MONOPOLIES
TO THE PRESENT TIME.

BY
CLEMENT HIGGINS, M.A., F.C.S.,
OF THE INNER TEMPLE, ESQUIRE, BARRISTER-AT-LAW.

LONDON:
BUTTERWORTHS, 7, FLEET STREET,
Law Publishers to the Queen's most excellent Majesty.
MEREDITH & RAY, MANCHESTER. T. & T. CLARK, EDINBURGH. SMITH & SON, GLASGOW.
HODGES, FOSTER & CO., DUBLIN. GEORGE ROBERTSON, MELBOURNE.
1875.

LONDON:
PRINTED BY C. ROWORTH AND SONS,
NEWTON STREET, HIGH HOLBORN.

This Work

IS

MOST RESPECTFULLY DEDICATED

•
TO

THE HONORABLE

SIR WILLIAM ROBERT GROVE, D.C.L., F.R.S.,

ONE OF THE JUDGES OF

Her Majesty's Court of Common Pleas.

PREFACE.

THIS is essentially a book of reference. Its object is to supply a reliable and exhaustive summary of the reported Patent Law Cases decided in English Courts of Law and Equity. No opinion is expressed upon the Cases digested, and no attempt is made to reconcile conflicting decisions. All that the book contains rests upon the authority of the Judges. The classification adopted is that which naturally suggests itself from the practical working of Patent Law rights, and the chronological arrangement of the Cases gives a complete history of legal decision on the several points of Law and Practice under which they are arranged. This is the Author's justification for retaining some few Overruled Cases, and for introducing several decisions upon the same point where they are of different dates. Cases which bear only on the present system of pleading, and upon the repeal of Letters Patent by *scire facias*, have been omitted, as reform in both modes of procedure appears to be imminent. Should the Patents for Inventions Bill, 1875, become law, it will be added as an Appendix to this Digest.

1, BRICK COURT, TEMPLE,
June, 1875.

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ERRATA.

- Page 34, par. 65, *for* "2 Com. B.," *read* "20 Com. B."
- " 60, last line, *for* "1 C. & F.," *read* "9 C. & F."
- " 78, " *for* "H. & M.," *read* "M. & H."
- " 84, " *for* "1 Ell. & Ell. 900," *read* "1 Ell. & Ell. 1008."
- " 149, *for* "longness of title," *read* "largeness of title."
- " 182, par. 403, *for* "10 L. J., Ex. 20," *read* "10 L. J., Ex. 493."
- " 242, line 7, *for* "8 Jur.," *read* "6 Jur."
- " 250, par. 581, *for* "*R. v. Wheeler*," *read* "*R. v. Mill*."
- " 334, line 5, *for* "10 C. B.," *read* "10 B. & C."

DIGEST OF PATENT CASES.

SUBJECT MATTER OF LETTERS PATENT.

Manufacture.

1. DARCY v. ALLIN. [1602]

“Where any man, by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm, that in such cases the king may grant to him a monopoly patent, for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not.” (*Noy’s R.* 182; 1 *Web. P. C.* 6.)

2. THE CLOTHWORKERS OF IPSWICH. [1615]

“If a man hath brought in a new invention, and a new trade within the kingdom in peril of his life, and consumption of his estate or stock, or if a man hath made a new discovery of anything; in such cases the king, of his grace and favour, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or traffic for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it; but when the patent is expired, the king cannot make a new grant thereof. For when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such

should be forbidden to use it." (*Godbolt's R.* 252; 1 *Roll. R.* 4.)

3. MITCHELL *v.* REYNOLDS. [1713]

"The grant of the sole use of a trade is void, but a grant of a *trade newly invented*, and for a time, is good; for the public has an advantage in the invention of a useful trade, which, after a limited time, is to be public; and the inventor's industry is sufficiently encouraged by the sole use of it secured to him by charter for such a time; but a second grant would be void, even in this case; and the statute 21 Jac. 1, c. 3, limits the time for which such grant may be made to fourteen years." (19 *Mod. R.* 130; 1 *P. Wms.* 181.)

4. BOULTON *v.* BULL. [1795]

A patent was granted to Watt for a new invented method of lessening the consumption of steam and fuel in fire engines. The validity of the patent was called in question. Mr. Justice Heath, speaking of the word "manufacture" in 21 Jac. 1, c. 3; s. 6, said: "What then falls within the scope of the proviso? Such manufactures as are reducible to two classes. The first class includes machinery, the second substances (such as medicines) formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form. In the first class the machine, and in the second the substance produced, is the subject of the patent. I approve of the term manufacture in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso that it was introduced for the benefit of trade. That which is the subject of a patent, ought to be specified, and it ought to be that which is vendible, otherwise it cannot be a manufacture." (2 *H. Bl.* 482.) Chief Justice Eyre said, when referring to the same subject, "It was admitted in the argument at the bar, that the word 'manufacture' in the statute was of extensive signification, that it applied not only to things made, but to the practice of making; to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this

admission. Under things made, we may class, in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects: for a new piece of mechanism is certainly a thing made. Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art producing effects useful to the public. When the effect produced is some new substance or composition of things, it should seem that the privilege of the sole working or making, ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. . . . When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced.” (*Ib.* 493).

5. HORNBLOWER *v.* BOULTON. [1799]

Kenyon, C. J.: “I have no doubt in saying, that this (Watt’s patent) is a patent for a manufacture, which I understand to be something made by the hands of man.” (8 *T. Rep.* 99; *Dav. P. C.* 225.)

6. REX *v.* WHEELER. Sci. Fac. [1819]

Abbott, C. J., delivering the judgment of the Court of King’s Bench, said: “It is well known that the granting of monopolies was restrained by the statute 21 Jac. 1, c. 3, to the sole working or making of any manner of new manufactures, and to the true and first inventor of such manufactures. Now the word ‘manufactures’ has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed, either in the making of some previously known article, or in some other

useful purpose, as a stocking-frame, or a steam-engine for raising water from mines. Or it may, perhaps, extend also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word manufactures. Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." Supposing a new process to be the lawful subject of a patent, the word "method" may be properly used as synonymous with process. (2 *B. & Ald.* 349; 1 *Carp. P. C.* 397.)

7. MINTER v. WELLS. [1834]

The patentee claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair, as above described." Held, that the patent was good, as the claim was, not for a principle, but for the application of a principle so as to produce a specified effect in a specified manner. (5 *Tyr.* 163; 1 *C., M. & R.* 505; 1 *Web. P. C.* 134; 1 *Carp. P. C.* 639.)

8. CORNISH v. KEENE. [1837]

The patent was "for an improvement or improvements in the making or manufacturing of elastic goods or fabrics applicable to various useful purposes." The patentee, in his specification, said: "The third object is to produce cloth from cotton, flax, or other suitable material, not capable of felting, in which shall be interwoven elastic cords or strands of india-rubber, coated or wound round with a filamentous material." To produce such a cloth, the patentee introduced into the fabric threads or strands of indiarubber, which had been previously covered by winding filaments tightly round them; they were

then applied as warp or weft, or as both, according to the direction of the elasticity required. The strands of indiarubber were, in the first instance, stretched to their utmost tension, and rendered non-elastic; and being in that state introduced in the fabric, they acquired their elasticity by the application of heat after the fabric was made. Tindal, C. J., in delivering the judgment of the Court of Common Pleas, said: "Now the first objection made to the patent so described is, that the invention is not the subject matter of a patent; that it is neither a new manufacture, nor an improvement of any old manufacture, but is merely the application of a known material in a known manner, to a purpose known before. The question, therefore, as to this point is, does it come under the description of 'any manner of new manufacture,' which are the terms employed in the statute of James? That it is a manufacture, can admit of no doubt; it is a vendible article, produced by the art and hand of man, and of all the instances that would occur to the mind when inquiring into the meaning of the terms employed in the statute, perhaps the very readiest would be that of some fabric or texture of cloth. Whether it is new or not, or whether it is an improvement of an old manufacture, was one of the questions for the jury, upon the evidence before them; but that it came within the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. The materials indeed are old, and have been used before; but the combination is alleged to be, and if the jury are right in their finding, is, new; and the result or production is equally so. The use of elastic threads or strands of indiarubber, previously covered by filaments wound round them, was known before; the use of yarns of cotton, or other non-elastic material, was also known before; but the placing them alternately side by side together as a warp, and combining them by the means of a weft when in extreme tension, and deprived of their elasticity, appears to be new, and the result, viz., a cloth in which the non-elastic threads form a limit, up to which the elastic threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken, appears a production altogether new. It is a manufacture at once ingenious

and simple." (3 *Bing. N. C.* 570 ; 6 *L. J., C. P.* 225 ; 4 *Scott*, 337 ; 2 *Hodges*, 281 ; 1 *Web. P. C.* 513 ; 2 *Carp. P. C.* 371.)

9. MORGAN *v.* SEAWARD. [1837]

Parke, B., in delivering the judgment of the court, said : " The word ' manufacture ' in the statute (21 Jac. 1, c. 3, s. 6) must be construed in one of two ways : it may mean the machine when completed, or the mode of constructing the machine." (2 *M. & W.* 558 ; 1 *Jur.* 528 ; 1 *Web. P. C.* 193 ; 2 *Carp. P. C.* 100.)

10. NEILSON *v.* HARFORD. [1841]

Patent for an invention " for the improved application of air to produce heat in fires, forges, and furnaces, where bellows and other blowing apparatus are required." The patentee, in his specification, described his invention thus :—" A blast or current of air must be produced by bellows or other blowing apparatus in the ordinary way, to which mode of producing the blast or current of air this patent is not intended to extend. The blast or current of air so produced, is to be passed from the bellows or blowing apparatus into an air vessel or receptacle made sufficiently strong to endure the blast, and through or from that vessel or receptacle by means of a tube, pipe, or aperture, into the fire, forge, or furnace. The air vessel or receptacle must be air tight, or nearly so, except the apertures for the admission or emission of the air ; and at the commencement and during the continuance of the blast, it must be kept artificially heated to a considerable temperature." Parke, B., in delivering the judgment of the court, said : " It is very difficult to distinguish it (the patentee's specification) from the specification of a patent for a principle, and this, at first, created in the minds of some of the court much difficulty ; but, after full consideration, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if, the principle being well known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces ; and his invention then consists in this—the interposing a receptacle for heated air

between the blowing apparatus and the furnace. In this receptacle he directs the air to be heated by the application of heat externally to the receptacle, and thus he accomplishes the object of applying the blast, which before was of cold air, in a heated state to the furnace." (8 *M. & W.* 806; 11 *L. J.*, *Ex.* 20; 1 *Web. P. C.* 331.)

11. WALTON *v.* BATEMAN. N. P. [1842]

Action for the infringement of a patent for "improvements in cards for carding wool, cotton, silk, and other fibrous substances, and for raising the pile of woollen and other cloth." After describing the manner in which the invention was to be carried out, the patentee continued: "And I do hereby confine my claim of invention to the application and adaptation of caoutchouc or indiarubber as the fillet or sheet, or medium in which the dents or teeth are to be set together in the manufacture of cards, and thereby obtaining a superior elasticity and durability to cards as above described." Cresswell, J., in summing up to the jury, said: "there is sufficient of a new manufacture in this case to justify and maintain the patent that has been granted. I think that there is a new principle developed, carried out, and embodied in the mode of using that principle." (1 *Web. P. C.* 613.)

12. CRANE *v.* PRICE. [1842]

Patent for "an improvement in the manufacture of iron." The invention consisted in the application of anthracite, or stone coal, combined with a hot air blast, in the smelting or manufacture of iron from ironstone, mine, or ore. The patentee in his claim said: "I do not claim the using of a hot air blast separately in the smelting and manufacture of iron as of my invention, when uncombined with the application of anthracite, or stone coal, and culm; nor do I claim the application of anthracite, or stone coal, in the manufacture or smelting of iron, when uncombined with the using of hot air blast. But what I do claim as my invention is, the application of anthracite, or stone coal, and culm, combined with the using of hot

air blast in the smelting and manufacture of iron, from iron-stone, mine, or ore, as above described." The application of a hot blast to the smelting of iron had previously been patented by Neilson. Tindal, C. J., in delivering the judgment of the court said, the question is, "whether, admitting the using of the hot air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite, or stone coal, to have been known before in the manufacture of iron with cold blast, but that the combination of the two together (the hot blast and the anthracite) were not known to be combined before in the manufacture of iron, whether such combination can be the subject of a patent.

"We are of opinion, that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public, than that produced before by the old method, that such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent. Such an assumed state of facts falls clearly within the principle exemplified by Abbott, C. J., where he is determining what is or what is not the subject of a patent, namely, it may, perhaps, extend to a new process to be carried on by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or a better or more useful kind. And it falls, also, within the doctrine laid down by Lord Eldon, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or even for a new method of applying such materials. But the specification must clearly express that it is in respect of such new combination or application.

"There are numerous instances of patents which have been granted, where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public. It will be sufficient to refer to a few instances, some of which patents have failed on other grounds,

but none on the ground that the invention itself was not the subject of a patent.

“ We may first instance Hall’s patent, for applying the flame of gas to singe off the superfluous fibres of lace, where a flame of oil had been used before for that same purpose. Derosne’s patent, in which the invention consisted in filtering the syrup of sugar through a filter, to act with animal charcoal, and charcoal from bituminous schistus, where charcoal had been used before in the filtering of almost every other liquor except the syrup of sugar. Hill’s patent, above referred to, for improvements in the smelting and working of iron; there the invention consisted only in the use and application of the slags or cinders thrown off by the operation of smelting, which had been previously considered useless for the production of good and serviceable metal, by the admixture of mine rubbish. Again, Daniell’s patent was taken out for improvements in dressing woollen cloth, where the invention consisted in immersing a roll of cloth, manufactured in the usual manner, into hot water.

“ It was objected, in the course of the argument, that the quality or degree of invention was so small, that it could not become the subject-matter of a patent; and that a person who could procure a licence to use the hot air blast under Neilson’s patent, had a full right to apply that blast to coal of any nature whatever, whether bituminous or stone coal. But we think, if it were necessary to consider the labour, pains, and expense, incurred by the plaintiff, in bringing his discovery to perfection, that there is evidence in this cause, that the expense was considerable, and the experiments numerous. But in point of law, the labour of thought, or experiments, and the expenditure of money, are not the essential grounds of consideration on which the question, whether the invention is or is not the subject-matter of a patent, ought to depend. For if the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery.” Referring to the validity of a patent for an improvement on a prior patent, his lordship said, the defendants contend “ that the

taking out of a patent for an invention, which invention cannot be used or enjoyed by the public except by means of the former invention of another person, which former invention is itself the subject-matter of a patent still in force, is void by law. Undoubtedly, if the second patent claims, as part of the invention described in it, that which had been the subject-matter of a patent then in force, it would be void, on the double ground that it claimed that which was not new (which indeed would equally be the case if the former patent had expired), and also that it would be an infringement of, and inconsistent with, a former grant of the king still in force, which latter consideration alone would make a new grant void. But in this case there is an express disclaimer of any part of the invention extending to the use of the hot air blast which was covered by Neilson's patent, the specification describing, that the application of the hot air blast was well understood and extensively applied in many places where ordinary fuel is employed. The validity, therefore, of the plaintiff's patent cannot be impeached on either of the grounds above adverted to Now it is further argued, that in point of law, no patent can be taken out which includes the subject-matter of a patent still running or in force. No authority was cited to support this proposition. . . . And upon reason and principle there appears to be no objection. The new patent, after the expiration of the old one, will be free from every objection, and whilst the former exists, the new patent can be legally used by the public by procuring a licence from Neilson, or by purchasing the apparatus from him or some of his agents; and the probability of the refusal of a licence to anyone applying for it, is so extremely remote, that it cannot enter into consideration as a ground of legal objection." The patent was held to be good. See also **85**. (4 *M. & G.* 580; 5 *Scott, N. R.* 338; 12 *L. J., C. P.* 81; 1 *Web. P. C.* 393; 2 *Carp. P. C.* 669.)

13. STEAD v. WILLIAMS. N. P. [1843]

Cresswell, J., stated it as his opinion that there might be a valid patent for a method of paving with wood. (2 *Web. P. C.* 134.)

14. HEATH v. UNWIN. N. P. [1844]

The plaintiff obtained a patent for certain improvements in the manufacture of iron and steel. The specification described the invention as consisting in "the use of carburet of manganese in any process whereby iron is converted into cast steel," and directed the unfused carburet of manganese to be put into the pot containing the steel in a fused state. The patentee claimed as his invention "the use of carburet of manganese in any process for the conversion of iron into steel." The defendant manufactured cast steel by placing oxide of manganese and carbonaceous matter into the pot at the same moment as the steel. They produced the same effect upon the steel as the carburet of manganese, but at a cheaper rate. This method of producing the effect was not known at the time of taking out the patent.

Abinger, C. B.: "The materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the said composition is a new discovery or invention, and not within the letters patent." (2 *Web. P. C.* 217.)

Parke, B., in the course of his answer to the question proposed by the House of Lords, said that the defendant in this case might have taken out a patent for this new mode of working. (25 *L. J., C. P.* 20.)

15. BENTLEY v. FLEMING. N. P. [1844]

A machine does not cease to be the subject of a patent, merely because of the length of time during which the inventor may keep it by him, after it has been made a complete workable machine. (1 *C. & K.* 587.)

STEVENS v. KEATING. N. P. [1847] See 47.

16. THE ELECTRIC TELEGRAPH COMPANY v. BRETT. [1851]

Patent "for improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through *metallic circuits*." Subsequently to the patent, it was discovered that the return current could be conducted

back to the battery through the earth as effectually as through a continuous metallic circuit, and this was the method used by the defendants. The defendants contended that the patent would protect the improvements of the patentee only when such improvements were applied to circuits that were metallic throughout, and therefore that they were entitled to employ the patentees' improvements. Cresswell, J., delivering the judgment of the court, said: "It appears to us reasonable to hold, that a claim for a patent for improvements in the mode of doing something by a known process, is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to the improvements claimed and their application." One of the claims of the patentee was an improvement "whereby a set of combined conducting wires, as aforesaid, having a voltaic battery and a set of buttons or finger keys, and also a dial with magnetic needles for giving signals, as well as an apparatus for sounding alarums at each end of the set, may also have duplicates of such dials, with needles and apparatus for alarums at intermediate places between the two ends; all such duplicates operating simultaneously with each other, and with the two end dials and alarums, to give like signals, and to sound like alarums." The jury found "that the sending of signals to intermediate stations was new to the plaintiffs." The defendants contended that this was a claim to the invention of a principle, and therefore that it was not the subject-matter of a patent. Cresswell, J., said: "We think that the patentees not only communicated the idea or principle that duplicate signals might be given, but showed how it might be done, *i. e.*, by duplicate apparatus at each station, and that this is a fit subject of a patent. It was, indeed, contended that it was obvious and self-evident that a circuit having a distant coil could have intermediate ones also, which would operate in the same manner; but it appears to us, that though it might be probable *à priori* that such would be the case, it was matter of experiment that it could practically be done, and that the

invention of the patentees, though simple, was one for which a patent] might be granted." (10 *Com. B.* 838; 20 *L. J.*, *C. P.* 123; 15 *Jur.* 579.)

17. *NEWTON v. VAUCHER.* [1852]

The defendant had obtained a patent for an improvement in packing hydraulic and other machines, by means of a lining of soft metal, the effect of which was to make certain parts of the machine air and fluid tight. Subsequently to this the plaintiff discovered that soft metal had the effect of diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact of machines in rapid motion, and subject to pressure. And he accordingly obtained a patent "for certain improvements in the construction of boxes for the axles or axle-trees of locomotive engines, &c., and also for improvements in oiling or lubricating the same." The plaintiff claimed, as his invention, the making or constructing the boxes, within which the journals or axles of machinery are to run, or within which the rods of slides, &c., are to slide, by providing them with rims or fillets along their edges, &c., and the lining such boxes with soft metal. Held, that the plaintiff's application of the soft metal differed essentially from that of the defendant, and that the plaintiff's patent was new. (6 *Exch.* 859; 21 *L. J.*, *Exch.* 305.) Parke, B., said: "Upon looking at his (the plaintiff's) specification, which embodies a new principle in a new machine, it differs materially from the defendant's, which is for the purpose merely of packing; for in the plaintiff's invention it is essential that there should be not only the intervention of soft metal, but that there should also be a hard rim covered in part with that soft metal, or some other means to prevent the soft metal from expanding, and getting out of its place. But any other hard rim, covered with soft metal, or substances covered with soft metal, are part of that machine. That is no part of the defendant's invention. Therefore, I think the discovery of the person under whom the plaintiff claims, is not merely a discovery of a new principle, but a new principle embodied in a new machine. Then, that being so, if the plaintiff claims a patent for that new principle embodied in a new machine, and that only for the purpose of

diminishing friction, and the application of it is only to cases where there is pressure as well as motion, that patent is perfectly good." (6 *Exch.* 865.)

18. BUSH v. FOX. [1854]

Coleridge, J.: "Manufacture includes both process and result." (*Macrory's P. C.* 176.)

19. HARWOOD v. GREAT NORTHERN RAILWAY COMPANY.
[1860]

Blackburn, J.: "The word 'manufacture' extends not only to principles that may be supposed to be patented, but to the modes of applying those principles, in practical use, in the result." (29 *L. J., Q. B.* 202.)

20. HILLS v. LONDON GASLIGHT CO. [1860]

Before the date of the plaintiff's patent, it was known that hydrated oxides of iron would absorb sulphuretted hydrogen; but it was not known that they could be practically used in the purification of coal-gas from sulphuretted hydrogen:—Held, that a patent might be had for applying hydrated oxides to absorb sulphuretted hydrogen from coal-gas.

It was also known that sulphuret of iron, produced by the action of sulphuretted hydrogen upon hydrated oxide of iron, would be re-oxidized by being exposed to the action of atmospheric air. But it was not known that when the sulphuret was produced by exposure of hydrated oxide of iron to the action of sulphuretted hydrogen, mixed with coal-gas, the re-oxidation of the iron might not be prevented by cyanogen, compounds of ammonia, and tarry matter which would be mixed with it:—Held, that a patent might be had for re-oxidizing the iron by exposure to the air after it had been used in the purification of coal-gas. (5 *H. & N.* 312; 29 *L. J., Ex.* 409.)

21. MORTON v. MIDDLETON. [1863]

Action for the infringement of a patent for improvements in the construction of pillars, &c., applicable to the construction of gate-posts, &c.

Lord President: "Although the object of other pillars that have been used may have been the same as the object contemplated by this one, yet, if the invention here in a great and

material degree attains that object better, then we must hold that there is novelty in it, and that it might be protected by a patent." (1 *Cr. S.*, 3rd Series, 722.)

22. RALSTON v. SMITH. H. L. [1865]

It is not every useful discovery that can be made the subject of a patent, but the words "new manufacture," in 21 Jac. 1, c. 3, will comprehend not only a production, but a means of production. It will comprehend a new machine, or a new combination of machinery, a new process, or an improvement of an old process. (11 *H. L. Cas.* 223; 13 *L. T. Rep.*, N. S. 1; 35 *L. J.*, C. P. 49; 20 *C. B.*, N. S. 28.)

23. CANNINGTON v. NUTTALL. H. L. [1871]

The appellants were the assignees of a patent for "improvements in the manufacture of glass." Before the date of the patent, glass was melted in furnaces of peculiar construction. On each side of the fire, sieges or benches were constructed, upon which were placed a number of earthenware pots. These pots, in which the glass was melted, were large and cumbrous, and their manufacture was costly; moreover they were very liable to crack, so that their suppression was always regarded as a great desideratum by glass makers. The patentee in his amended specification thus describes his invention: "My improvements relate to the melting or fusing furnaces or kilns used in glass making, and have reference to the suppression of the fire clay pots or crucibles hitherto in use, and to placing the materials to be fused or melted within the furnace itself, the usual inner form of the lower part of which is modified by doing away with the sieges or banks and the general levelling of the bottom, to which, separately, I make no claim; but according to my invention the lateral sides are constructed of a hollow form in such wise that a current of refrigerating or cooling air may be made to circulate around and prevent any excessive heating of the sides, which are to retain or inclose the materials in fusion." All the principles upon which the patentee's method was based were well known, but their combination was both new and useful. Held, that the combination was the subject-matter of a valid patent. (*L. Rep.*, 5 *H. L.* 205; 40 *L. J.*, Ch.

739.) Lord Westbury: "Now, the only thing that appears to have been regarded by the patentee, Mr. Pocheron, as a new discovery, was the application of the external air to the sides of the tank. My lords, it was a discovery certainly, but it was a thing for which, independently of the other apparatus, probably no patent could have been obtained. I may construct an apparatus, and may, in point of fact, make the merit and benefit of that apparatus depend upon the application of some dynamic force which is perfectly well known, but my invention consists in the construction of the apparatus in such a manner as to bring some natural agency or natural power to bear upon and effect the object which I desire to effect, and that I do by means of an apparatus constructed so as to bring into action that dynamic power. If, for example, I avail myself of all the well-known expansive force of steam in order to effect a new object or a more beneficial result, and I introduce that by means of an apparatus constructed for the purpose of bringing this well-known expansive power into utility for my particular purpose, I have no right of invention in the discovery of that expansive power. My invention consists in the arrangement of the apparatus, in order to receive that ordinary and well-known dynamic agent, and make it a fit instrument for effecting a particular result. Now here the refrigerating effect of the air upon the sides of the tank was not a thing for which a patent could be obtained; but an apparatus so constructed as to bring into operation that particular property of the external atmospheric air, so as to produce a most useful effect, constitutes an invention to which the merit attaches of novelty, and for which a patent may be taken out." (*L. Rep.*, 5 *H. L.* 225.)

Combination.

24. BOULTON v. BULL. [1795]

Buller, J., said: "Mechanical and chemical discoveries all come within the description of manufactures; and it is no objection to either of them that the articles of which they are composed were known and were in use before, provided the compound article, which is the subject of the invention, is new." (2 *H. Bl.* 487.)

25. HUDDART v. GRIMSHAW. N. P. [1803]

Lord Ellenborough: "I suppose it will not now be disputed that a new combination of old materials, so as to produce a new effect, may be the subject of a patent." (*Dav. P. C.* 267.)

26. HILL v. THOMPSON. Ch. [1817]

Lord Eldon: "There may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. (1 *Web. P. C.* 237.)

27. BRUNTON v. HAWKES. [1821]

A machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good subject-matter for a patent. *See* 117. (4 *B. & Ald.* 550.)

28. LEWIS v. DAVIS. N. P. [1829]

The shearing of cloth from list to list by shears, and the shearing it from end to end by means of rotary cutters were known and in use before the date of the patent. The patentee constructed a machine to shear from list to list by means of rotary cutters, and this was held to be a new manufacture within the statute of James, and a sufficient invention to sustain a patent. (3 *Car. & P.* 502; 1 *Web. P. C.* 488; 1 *Carp. P. C.* 471.)

29. SAUNDERS v. ASTON. [1832]

Patent for "certain improvements in constructing or making buttons." The specification stated the improvements to consist in the substitution of a flexible material for metal shanks on buttons. It then described the modes in which this material might be fixed to the button. Several of these modes were old, but one method which consisted in the use of a metal collet or ring with teeth was new. Neither the construction of the button nor the application of a flexible shank was new. Littledale, J., agreeing with the rest of the court, said: "Neither the button nor the flexible shaft was new, and they did not, by merely being put together, constitute such an invention as could support this patent. It is contended that the operation of the

collet, under the present patent, is new; but that is not stated in the specification as the object of the invention, and it is in fact only one mode of carrying it into effect; it appears on the plaintiff's case that there were other ways of producing the same result." (3 *B. & Ad.* 881; 1 *L. J., K. B.* 265; 1 *Carp. P. C.* 510.)

CORNISH *v.* KEENE. [1837] See 8.

30. CARPENTER *v.* SMITH. N. P. [1841]

There may be a valid patent for a *new* and *improved* combination of mechanical parts which are already known in combination. (1 *Web. P. C.* 538.)

CRANE *v.* PRICE. [1842] See 12.

31. ALLEN *v.* RAWSON. [1845]

Where the use of soap and water in the process of felting, instead of acidulated water, was known, and the use of rollers was also known, it was held that a patent for the application of soap and water in combination with rollers, was a good subject-matter for a patent. (1 *C. B.* 551.)

NEWTON *v.* THE GRAND JUNCTION RAILWAY COMPANY. [1846] See 112.

32. BOVILL *v.* KEYWORTH. [1857]

The plaintiff's invention consisted in exhausting the air from the cases of millstones, combined with the application of a blast to the grinding surfaces. The patentee specifically disclaimed the precise details of carrying out his invention as described in his specification. It was proved by the defendants that both the blast and the exhaust had previously been used separately in working mills. The court held, that "the whole of the plaintiff's process, if the combination be new, is certainly the subject of a patent." (7 *E. & B.* 725; 3 *Jur., N. S.* 817.)

33. LISTER *v.* LEATHER. [1858]

Lord Campbell, C. J., in delivering the judgment of the Court of Queen's Bench, said: "If the combination, the subject of the patent, was new and useful, though each of the parts

which entered into it were old, still the combination might be the subject of a valid patent A patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has been often decided A valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, without any express claim of particular parts, and notwithstanding that parts of the combination are old." (8 *E. & B.* 1004; affirmed in Exchequer Chamber, 8 *E. & B.* 1031; 27 *L. J., Q. B.* 295; 4 *Jur., N. S.* 947.)

34. MORTON v. MIDDLETON. [1863]

Lord President: "There can be no doubt as to the general law, that there may be a new arrangement and combination of things that were formerly in use, but which are to be so arranged in a novel way as to produce either a new effect or a better effect than before." (1 *Cr. S., 3rd Series*, 721.)

WILLIS v. DAVISON. [1863] See 90.

NEWALL v. ELLIOTT. [1864] See 57.

35. FOXWELL v. BOSTOCK. [1864]

Lord Westbury said: "If a combination of machinery for effecting certain results has previously existed, and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented." (12 *W. R.* 725.)

36. DANGERFIELD v. JONES. [1865]

Patent for "an improved mode of, and apparatus for, bending wood for the handles of walking sticks, umbrella and parasol sticks, and other purposes." The patentee, in his specification, said, that after softening the end of the stick which is to be bent, by placing it in moist sand, with the application of heat when necessary, it is to be held securely in the jaws of a clamp or vice, and the extremity of the stick then drawn round or bent

over a tube or hollow mandrel, provided with an annular half-round recess. Inside this tube or hollow mandrel a gas jet or burner is introduced for imparting heat to the tube or mandrel, which heat is transmitted to the stick from its being drawn in close contact therewith. The stick is kept in this position by means of a band of steel, which is bent over the stick to retain it in a bent position. The patentee claimed "the application of a flame of gas or other combustible fluid or liquid as described, for softening the fibres of the wood while being bent in combination with a clamping apparatus for securing the wood in its bent form until the fibres are set, so that the hook may remain permanently as herein set forth." Held, that this was a proper subject for a patent. Vice-Chancellor Wood, in the course of his judgment, said: "If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the court sees that that which has been invented is new, desirable, and for the public benefit." (13 *L. T. Rep.*, N. S. 142.)

RALSTON *v.* SMITH. H. L. [1865] See 92.

PARKES *v.* STEVENS. Ch. [1869] See 94.

37. WRIGHT *v.* HITCHCOCK. [1870]

The plaintiff obtained a patent "for the invention of improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." His specification described the invention as relating to a peculiar manufacture of frills or ruffles, and a peculiar kind of mechanism to be applied to a sewing machine for producing the same, by which the fabric was folded, or crimped by a reciprocating knife, and the folds stitched by the sewing machine, so as to be kept permanently in their place. The specification claimed: first, the general construction, arrangement, and combination of machinery, apparatus or means for producing crimped or plaited frills or trimmings in a sewing machine, as hereinbefore described; secondly, the application and use of a reciprocating knife for crimping fabrics in a sewing machine, substantially as herein-

before described." Anterior to the date of the patent, frills or ruffles were made by hand, the materials being folded by a knife, and then sewn. The court held the plaintiff's invention to be a good subject-matter of a patent. Martin, B., said: "The statute enables the crown to grant patents for the sole working and making of any manner of new manufacture. It seems to me that this was 'a manner of new manufacture,' and, therefore, was a good subject for a patent." (*L. Rep.*, 5 *Ex.* 37; 39 *L. J.*, *Ex.* 97.)

CANNINGTON *v.* NUTTALL. H. L. [1871] See 23.

38. MURRAY *v.* CLAYTON. [1872]

Sir James Bacon, V.-C., in the course of his judgment in this case, said: "A combination of things not in themselves new, but which combination is perfectly new in the form in which the inventor has cast it, and producing new and more beneficial results, may be the subject of a patent. (*Huddart v. Grimshaw*, *Web. P. C.* 85.) But I am aware of no case in which it has been held that the mere arrangement of common elementary mechanical materials, and the construction by means of such arrangement of a machine which produces no other result than that which had been previously accomplished by other mechanical arrangements and construction, would support a patent. If it were so, there would be no protection to the public or to earlier patents against the ingenuity of any artisan who might have the skill to arrange the old mechanism in a new shape, and thereby to appropriate to himself the fruits of previous inventors in the proper sense of that term, so that the privilege and reward which the law only concedes to art and wit and invention might be bestowed upon mere skill in handicraft." (*L. R.*, 7 *Ch.* 577.)

The Vice-Chancellor's judgment was reversed on appeal.

Sir W. M. James, L. J., commenting upon the above passage, said: "I find it very difficult to reconcile this proposition with what has been said by many judges in many cases, and more particularly in the case of *Crane v. Price*. Now, no doubt *Crane v. Price* has been questioned, and if I may be permitted to say so, with all respect to the very powerful

tribunal which decided that case, I have never been satisfied with the decision. That, however, was simply because I could not see how the word ‘combination’ could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I nor, so far as I am aware, any other judge has ever questioned the principles upon which that case was decided. . . . That being so, I cannot concur with the Vice-Chancellor in saying that the patent of the plaintiff was to be invalidated upon the principle which he has laid down, because, if the evidence is to be believed, what the plaintiff has done is, that he has produced a thing in a more expeditious manner, in a more economical manner, and of a better quality.” (*L. R.*, 7 *Ch.* 584; 20 *W. R.* 650.)

Process.

39. HORNBLOWER v. BOULTON. [1799]

A patent was granted for a “method of lessening the consumption of steam and fuel in fire-engines.” The specification stated that the “method consisted of the following principles” (describing the mode in which those principles were applied to the purposes of the invention):—Held, that the invention was the subject of a patent. (8 *T. Rep.* 95; *Dav. P. C.* 221; 1 *Carp. P. C.* 156.)

Grose, J.: “I am inclined to think that a patent cannot be granted for a mere principle; but I think that, although in words the privilege granted is to exercise a method of making or doing anything, yet if that thing is to be made or done by a manufacture, and the mode of making that manufacture is described, it then becomes in effect (by whatever name it may be called) not a patent for a mere principle, but for a manufacture for the thing so made, and not merely for the principle upon which it is made.” (8 *T. Rep.* 105.)

Lawrence, J., said: “Engine and method mean the same thing, and may be the subject of a patent. ‘Method,’ properly speaking, is only placing several things and performing several

operations in the most convenient order; but it may signify a contrivance or device; so may an engine, and there I think it may answer the word 'method.' So 'principle' may mean a mere elementary truth, but it may also mean constituent parts; and in effect the specification is this: 'the contrivance by which I lessen the consumption of steam consists in the following principles—that is, constituent or elementary parts; a steam vessel, in which the powers of steam are to operate, to be kept as hot as the steam by a case; a distinct vessel to condense the steam; and pumps to draw off such vapour as is likely to impede the motion of the fire-engine,' &c. That is the description of the thing when put into different language." (*Ib.* 106.)

40. HUDDART v. GRIMSHAW. N. P. [1803]

There may be several patents granted for several methods of obtaining the same object, provided the methods of obtaining that object are not identical. (1 *Web. P. C.* 92.)

R. v. WHEELER. [1819] See 6.

41. HALL v. JARVIS. N. P. [1822]

The patent was granted for a "method of improving every kind of lace," &c. The invention consisted in causing lace to pass through a flame of gas, in order to singe off the projecting fibres, and the specification described the means by which the invention was to be performed. The patentee claimed the application of the flame of inflammable gas to the purposes described in the specification. It was proved that before the date of the patent, muslin had been passed over rollers of heated iron, and that mits and stockings had been passed through oil and alcohol flames for a similar purpose. It was objected that the mere doing that with the flame of gas which had long before been done by means of other kinds of flame, was not such an invention as to constitute the subject-matter of a patent. The patent was, however, held to be good. (1 *Web. P. C.* 100; 1 *Carp. P. C.* 423.)

42. JONES v. PEARCE. N. P. [1832]

The plaintiff's patent was for "a certain improvement or

improvements on wheels for carriages." The patentee, in his specification, said, "I hereby claim as my invention, and declare that my improvement or improvements on wheels for carriages consist in substituting suspending rods made of iron or other suitable metal in lieu of spokes, by which suspending rods I hang or suspend the weight or load from that part of the wheel which happens to be uppermost, and prevent any support being given to the said weight or load by the rods which happen to be immediately under the axletree." At the trial the defendant's counsel contended that the specification did not confine the claim to any particular mode of constructing wheels on the suspension principle, but expressly claimed the invention of the principle itself. Patteson, J., was of opinion that, on the specification taken as a whole, the claim was for the invention of a method of making wheels on the principle of suspension, which method was described in the specification. (1 *Web. P. C.* 122; 1 *Carp. P. C.* 524.)

43. RUSSELL v. COWLEY. [1835]

Before the patent, for the infringement of which the plaintiff sued, iron tubes were made by drawing them through rollers, a mandrel being placed inside the tube so as to form an internal support. The patent in question was granted for a process of manufacturing iron tubes by drawing them through fixed dies or holes *without the use of a mandrel*. The tubes made by this process were of greater length, were more uniform, and could be manufactured at a cheaper rate than by the old process. The court held this to be a good subject-matter for a patent. (1 *C., M. & R.* 864; 1 *Web. P. C.* 463; 1 *Carp. P. C.* 557; 16 *Rep. Arts., N. S.* 116.) Lyndhurst, C. B., said: "Although that seems to be a very simple invention, it has been productive of great advantages; inasmuch as it has enabled the manufacturers to construct pipes for gas and other purposes very correctly, and also of lengths much beyond what could be done previously to this discovery. I think, therefore, in fact, practically, it is a new invention, and an invention of great importance." (1 *Web. P. C.* 467.)

44. WALTON v. POTTER. N. P. [1841]

Tindal, C. J.: "There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose." (1 *Web. P. C.* 590.)

45. GIBSON v. BRAND. [1842]

Tindal, C. J.: "The patent is taken out 'for a new or improved process or manufacture of silk; and silk in combination with certain other fibrous substances;' taken out, therefore, strictly for a process. On the present occasion it is not necessary to go into the question (upon the view I take of this specification), whether a patent can be granted for a process, in the strict and proper sense of that term, or not. Undoubtedly there is a very strong reason to suppose, if the specification is carefully and properly prepared, so as to point out, with great distinctness and minuteness, what the process is, that such a patent may be good in law." (1 *Web. P. C.* 633.)

Erskine, J.: "Although it may be true, that a party may have a patent for an improved process, under circumstances which would show that the improvement in the process really amounted to a new invention, and a new manufacture, within the terms of the act of parliament, I think the evidence in this case does not show, that here there has been such an improvement." (*Ib.* 638.)

46. HELLIWELL v. DEARMAN. [About 1842]

The object of the plaintiff's invention was the rendering fabrics waterproof, but at the same time leaving such fabrics pervious to air. Before the plaintiff's patent a solution of alum and soap was made, and the fabric to be rendered waterproof was immersed therein. By this means a waterproof surface

was produced on the fabric, but it was not of a lasting nature: it wore off. According to the plaintiff's invention, the fabric was immersed first in a mixture of a solution of alum with some carbonate of lime, and then in a solution of soap. The effect was, that by the first immersion every fibre became impregnated with the alum, the sulphuric acid of the alum being neutralized by the carbonate of lime, and by the second immersion the oily quality rendering it repellant of water was given to every fibre, so that every fibre was rendered waterproof instead of the surface only; but the whole fabric continued pervious to air. (1 *Web. P. C.* 401.)

HEATH *v.* UNWIN. N. P. [1844] See 14.

47. STEVENS *v.* KEATING. N. P. [1847]

Pollock, C. B.: "The word 'manufacture' is introduced, and all patents must be for a manufacture. The real invention may be not so much for the thing when produced, as for the mode in which it is produced; and its novelty may consist, not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and therefore, although the language of the act has been said to apply only to manufactures and not to processes, when you come to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because, though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture. Therefore, although I think this is a patent for the process rather than the product, I think it may be patent for the product." (2 *Web. P. C.* 182.)

STEINER *v.* HEALD. [1851] See 76.

48. WALLINGTON *v.* DALE. [1852]

Previous to the plaintiff's patent being granted, gelatine was obtained by submitting large pieces of hides to the action of caustic alkali, or by reducing them to pulp in a paper machine, and employing blood to purify the product. The invention claimed consisted in cutting the hides into shavings, thin slices,

or films, whereby the use of blood in the process of purification became unnecessary. Held, that the invention was the subject-matter of a patent. (7 *Exch.* 888; 23 *L. J.*, *Ex.* 49.)

CROSSLEY *v.* POTTER. N. P. [1853] See 100.

49. BOOTH *v.* KENNARD. [1856]

Patent for “improvements in the manufacture of gas.” The patentee, in his specification, said: “Hitherto in manufacturing gas from oils, oily or resinous matter, it has been usual to go through the costly process of obtaining the oils, &c., from seeds and other substances, and to use the same in a fluid or semifluid state Now, my invention consists in the direct use of seeds, leaves, flowers, branches, nuts, fruits, and other substances, and matters containing oil or oily or resinous matter, or other matter useful in the manufacture of vegetable gas. . . . I claim for making gas direct from seeds and matters herein named, instead of making it from oils, resins, and gums, previously extracted from such substances.” Held, that assuming the invention to be new, it was a good subject-matter for a patent. (1 *Hurl. & N.* 527; 26 *L. J.*, *Ex.* 23; 3 *Jur.*, *N. S.* 21.) The patent was afterwards set aside for want of novelty. (2 *Hurl. & N.* 84; 26 *L. J.*, *Ex.* 305.)

50. BEWLEY *v.* HANCOCK. [1856]

Lord Cranworth: “A discovery that the mixture of two or more simple substances, in certain definite proportions, will form a compound substance valuable for medical or other qualities, would afford a good ground for a patent. A discovery of some machinery, whereby such a mixture may be more quickly or more effectually accomplished, might be the foundation of another patent.” (6 *De G.*, *M. & G.* 402.)

51. BOVILL *v.* PIMM. [1856]

Where the subject of an invention is not new, any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may

apparently be described by the same general phrase. (11 *Exch.* 739.)

52. BOVILL v. KEYWORTH. [1857]

If the specification of a patent does not point out the mode by which a patented process is to be performed, so as to accomplish the object in view, it will be a statement of principle only, and the patent will be invalid. (7 *E. & B.* 735.)

53. HIGGS v. GODWIN. [1858]

The invention for which the patent was granted was "treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes." In the specification the patentee said: "For the purpose of precipitating the animal and vegetable matter contained in the sewage water, I prefer to employ hydrate of lime, commonly termed 'slacked lime.' . . . What I claim of my invention is, the precipitation of animal and vegetable matter from sewage water by means of the chemical agent hereinbefore described." Lord Campbell, C. J., said: "It seems to me that the invention of the plaintiff is a subject for a patent, as the invention was for producing an article of commercial profit." (*El. Bl. & El.* 529; 5 *Jur.*, N. S. 97; 27 *L. J.*, Q. B. 421.)

54. HILLS v. LONDON GAS LIGHT COMPANY. [1860]

An invention consisted in the purification of coal gas by employing the hydrated oxides of iron to remove the sulphuretted hydrogen from the gas. On an action for the infringement of a patent for this invention, it was contended by the defendants that this was not the subject of a patent. Baron Bramwell, delivering the judgment of the court, said: "If a man were to say 'I claim the use of hydrated oxide of iron for the purification of coal gas,' without saying how it is to be applied, it is possible the objection might be well founded; but here the plaintiff says, 'I claim it in the manufacture of gas in the way I have described,' and he shows how it may be used. Therefore this objection fails." (5 *Hurl. & N.* 312; 29 *L. J.*, *Ex.* 409.)

55. YOUNG v. FERNIE. [1864]

Vice-Chancellor Sir John Stuart said: "What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for useful and economical purposes with an article which was previously little more than the ornament of a museum. It has been established to my satisfaction, by the evidence in this cause, that the plaintiff Young is an inventor of this class, and that his patent is entitled to the protection of the law. I find that he has ascertained, by a course of laborious experiments, a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and process, and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained, which was necessary for the useful application of the chemical discovery of paraffine, and paraffine oils. This brings it within the principle stated by the Lord Chancellor in the late case of *Hills v. Evans*. The manufacture, with the materials and process indicated by him, according to the sense in which I understand the word 'manufacture' to be used in the statute, was a new manufacture, not in use at the date of his patent." (4 *Giff.* 611; 10 *Jur.*, N. S. 936; 12 *W. R.* 903; 10 *L. T. Rep.*, N. S. 865.)

56. CURTIS v. PLATT. [1864]

Where an invention consists of the discovery of particular means for attaining a result, which result is already perfectly well known, the invention is only for the means; and the invention of one set of particular means does not interfere with the invention of another set of means to the same end, provided that the two sets of means are distinct, and the latter does not involve a colourable imitation of the former, or an incorporation of the former, with additions. (11 *L. T. Rep.*, N. S. 245.)

57. NEWALL v. ELLIOTT. [1864]

The plaintiff obtained a patent for "improvements in apparatus employed in laying down submarine electric telegraph wires," which he effected by a combination of a wire or cable

round a cone of supports, placed cylindrically outside the coil, and the use of rings in combination with them. Held, to be a good subject for a patent. (10 *Jur.*, *N. S.* 954; 13 *W. R.* 11; 10 *L. T. Rep.*, *N. S.* 792.)

Bramwell, B. said: "Two other matters remain. One is, the point that was pressed by Mr. Cleasby, but which I confess I have considerable difficulty in understanding, that this is not the subject of a patent, because the thing is not prepared and vendible—because, for the convenience of buyer and seller, instead of being ready made and afterwards fitted up in the ship, it is fitted into the ship by the owner of the ship, or the user of the ship, when he uses it. I confess I am unable to understand that. It seems to me to be an argument equally good to say that you could not have a patent for a smoke-jack, because the size of the smoke-jack depends upon the size of the chimney, and because it is more convenient that it should be put up by a country smith." (10 *Jur.*, *N. S.* 959.)

58. SIMPSON v. HOLLIDAY. H. L. [1866]

Patent for "improvements in the preparation of red and purple dyes." The specification thus declares the nature of the invention: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time; or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour." The patentee claimed "the manufacture or preparation of red and purple dyes, by treating aniline dyes with arsenic acid, as hereinbefore described." Chelmsford, L. C., said: "There is nothing upon the face of the specification to show that the invention described is not in every part of it the subject of a patent." (*L. R.*, 1 *H. L.* 315; 35 *L. J.*, *Ch.* 811.)

CANNINGTON v. NUTTALL. H. L. [1871] See 116.

Addition to a known Machine or Process.

59. MORRIS v. BRAMSON. N. P. [1776]

An addition made to an old machine is a good subject-matter for a patent. If it were the law that there could be no patent

for an addition, it would go to repeal almost every patent that was ever granted. (*Bull. N. P.* 76 ; 1 *Carp. P. C.* 30 ; 1 *Web. P. C.* 51.) .

60. R. v. ARKWRIGHT. Sci. Fac. [1785]

Buller, J., in addressing the jury, said : “ In the case of an invention, many parts of a machine may have been known before, yet if there be anything material and new, which is an improvement of the trade, that will be sufficient to support a patent ; but whether it must be for the new addition only, or for the whole machine, would be another question.” (1 *Web. P. C.* 71.)

61. BOULTON v. BULL. [1795]

Buller, J., said : “ That a patent for an addition or improvement may be maintained, is a point which has never been directly decided ; and *Bircot's case*, 3 Inst. 184, is an express authority against it, which case was decided in the Exchequer Chamber. What were the particular facts of that case we are not informed, and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was to put but a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put, was old. But in truth, arts and sciences at that period were at so low an ebb, in comparison with that point to which they have been since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times, whenever the point has arisen, the inclination of the court has been in favour of the patent for the improvement, and the parties have acquiesced, where the objection might have been brought directly before the court. In *Morris v. Branson*, which was tried at the sittings after Easter term 1776, the patent was for making oilet holes, or net-work in silk, thread, cotton or worsted ; and the defendant objected that it was not a new invention, it being only an addition to the old stocking-frame. Lord Mansfield said, ‘ After one of the former trials on this patent, I received a very sensible letter from one of the gentlemen who was upon

the jury, on the subject whether on principles of public policy, there could be a patent for an addition only. I paid great attention to it, and mentioned it to all the judges. If the general point of law, viz., that there can be no patent for an addition, be with the defendant, that is open upon the record, and he may move in arrest of judgment. But that objection would go to repeal almost every patent that was ever granted.' There was a verdict for the plaintiff, with 500*l.* damages, and no motion was made in arrest of judgment. Though his lordship did not mention what were the opinions of the judges, or give any direct opinion himself, yet we may safely collect that he thought, on great consideration, the patent was good, and the defendant's counsel, though they had made the objection at the trial, did not afterwards persist in it. Since that time, it has been the generally received opinion in Westminster Hall, that a patent for an addition is good. But then it must be for the addition only, and not for the old machine too. In *Jessop's case*, as quoted by my brother Adair, the patent was held to be void because it extended to the whole watch, and the invention was of a particular movement only." (2 *H. Bl.* 489.)

62. *HORNBLOWER v. BOULTON.* [1799]

Grosé, J.: "A doubt is entertained, whether there can be a patent for an addition to an old manufacture. This doubt rests altogether upon *Bircott's case*, 3 *Inst.* 184; and if that were to be considered as law at this day, it would set aside many patents for very ingenious inventions, in cases where the additions to manufactures before existing are much more valuable than the original manufactures themselves. I shall content myself with referring to what Lord Chief Justice Eyre said in this cause, in the Court of Common Pleas, in answer to this passage, and to the case of *Morris v. Branson*, cited by my Brother Buller upon the same point. If indeed a patent could not be granted for an addition, it would be depriving the public of one of the best benefits of the statute of James. Lord Coke's opinion, therefore, seems to have been formed without due consideration; and modern experience shows that it is not well founded." (8 *T. Rep.* 104; *Dav. P. C.* 233.)

63. EX PARTE FOX. [1812]

The petitioners having applied for a patent in respect of certain improvements in steam-engines, a caveat was entered under an existing patent, from which it was alleged the new patent was borrowed, and with which it would interfere. The affidavit of an engineer was put in, stating that they were not the same, nor in any respect resembling each other.

Lord Chancellor Eldon said: "If the petitioners have invented certain improvements upon an engine for which a patent has been granted, and those improvements could not be used without the original engine, at the end of fourteen years the petitioners could make use of a patent taken out under their improvements, though before that period expired they would have no right to make use of the other's *substratum*. At the end of that time, the public has a choice between the patents. My present opinion is, that this patent must go." Patent granted. (1 *V. & B.* 67; 1 *Web. P. C.* 431.)

64. LISTER v. LEATHER. [1857]

Lord Campbell, C. J., said: "The second argument was that, if a subsequent patent for a combination includes a part of an invention already protected by patent, it infringes on the property of another, and so is a violation of his right, and ought to be held illegal on account of his interest. The answer is that the patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, without licence, would be an infringement; but, with licence, that also would be lawful, as is in constant experience. Indeed the objection was carried to the extent that a patent for an improvement on a patent invention of the same patentee would be void; but this rests only on the assumption that the improvement cannot be distinguished from the invention on which it is made. The assertion, that all patents for improvements on existing patents must be void, is obviously untenable." (8 *El. & B.* 1017.)

65. RALSTON v. SMITH. H. L. [1865]

The word "manufacturer" comprehends a new process or an improvement of an old process. (11 *H. L. Cas.* 223; 2 *Com. B.*, *N. S.* 28; 35 *L. J.*, *C. P.* 49; 13 *L. T. Rep.*, *N. S.* 1.)

66. FOX v. DELLESTABLE. [1866]

Malins, V.-C.: "No doubt a man may make an invention which is partly covered by an existing patent, but he cannot use it without the licence of the patentee. He may wait for the expiration of the patent, and take out one himself if his invention be novel, and that patent will be valid." (15 *W. R.* 195.)

*Application of a known Machine, Process or Material
to a New Purpose.*

67. HARTLEY'S CASE.

A method of disposing plates of iron so as to produce a useful effect, viz., to secure buildings from fire, is a good subject-matter. (2 *H. Bl.* 493.)

68. MACINTOSH v. EVERINGTON.

A claim for the application of Indiarubber, in a state of solution, as a cement between two fabrics to make a waterproof covering is good, notwithstanding the application of other substances, and of Indiarubber in other states, to the same purpose. (6 *Rep. Arts.* *N. S.* 317, 365.)

69. BRUNTON v. HAWKES. [1821]

Patent for improvements in ships' anchors, &c. Abbott, C. J., in speaking of the anchor, says: "Formerly three pieces were united together; the plaintiff unites only two; and, if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent." (4 *B. & Ald.* 550.)

HALL v. JARVIS. N. P. [1822] See 41.

70. LOSH v. HAGUE. N. P. [1838]

There is a material difference between applying a new contrivance to an old object, and an old contrivance to a new object. (1 *Web. P. C.* 207.)

71. KAY v. MARSHALL. H. L. [1841]

Lord Cottenham, L.C., said, in the House of Lords: "If he (the patentee) has discovered any means of using the machine, which the world had not known before the benefit of, that he has a right to secure to himself by means of a patent; but if this mode (described in the specification) of using the spinning machine was known before, then the plaintiff cannot deprive them of having the benefit of that which they enjoyed before." (2 *Web. P. C.* 82.)

72. WALTON v. POTTER. [1841]

The adaptation of a substance of known properties to a particular purpose may be the subject of a patent.

An invention of improvements in cards for carding wool, cotton, silk and other fibrous substances, and for raising the pile of woollen and other cloths by the application and adaptation of caoutchouc or Indiarubber, as a substitute for the fillets or sheets of leather, is patentable.

Coltman, J., said: "Upon the best consideration I can give to the subject, it appears to me that it (the plaintiff's invention) is a very useful application and adaptation of a substance, the properties and qualities of which for the purpose had never been known before, and therefore that it was properly the subject of a patent." (4 *Scott's N. C.* 91; 3 *M. & G.* 411; 1 *Web. P. C.* 597.)

73. MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent, granted to the plaintiff in 1832, for "an improved manufacture of metal plates for sheathing the bottoms of ships or other such vessels." The defendants pleaded (*inter alia*) want of novelty in the invention. Tindal, C. J., in directing the jury upon this point, said: "I look upon the (plaintiff's) invention to consist in this,

that he has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing, by reason and by means of its oxydating just in sufficient quantity; that is, not too much, so as to wear away and impair the sheathing, and render the vessel unsafe, but enough at the same time to keep, by its wearing, the bottom of the vessel clean from those impurities which before attached to it. That I consider to be the meaning of the patent, and the object with which it was taken out. And I cannot think, as at present advised, that if it was shown (as possibly it may be), that sheets had been made of metal before, in the same proportions which he has pointed out; that if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground; that is the opinion which I form upon it. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal, as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined, that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, that such application has been considered as the ground, and a proper ground, of a patent; and therefore, when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose.” (2 *Web. P. C.* 103.)

74. POW v. TAUNTON. [1845]

Patent for the invention of a nipping lever for causing the rotation of wheels, shafts or cylinders, under certain circumstances. The specification claimed as the invention “the nipping lever, with its tusk and sliding box, applied to a rimmed wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together with any shaft, cylinder, or other suitable machinery which may be attached

thereto." The nipping lever was not new, but the application of it by means of the sliding box was new.

Denman, C. J., said: "As the plaintiff did not claim the invention of the nipping lever, but only the application of it to a subject-matter, to which it had not been applied before, it was contended, for the defendant, that the mere application of a known instrument to a new purpose will not support a patent, unless the means or method of the application is also new. The application of a nipping lever to the surface of a wheel, for the purpose of making it revolve, may be new, but the mere novelty of the application is not enough; it must also appear that the means, essential for carrying the application into effect, are new also. In the present case, the means for applying the old invention to the new purpose are the sliding boxes; and, if they are essential to the application, and novel as means for the purpose, the patent may be supported." (9 *Jur.* 1056.)

75. REG. v. CUTLER. N. P. [1847]

Scire facias to repeal letters patent granted to the defendant for "Improvements in the construction of the tubular flues of steam boilers." The specification described two methods of welding iron tubes, and a method of making iron tubes coated with copper, brass, &c. The patentee after claiming the two methods, described in the specification, of welding iron tubes, and disclaiming the method of coating iron tubes with copper, &c., proceeded thus: "Thirdly: I claim the application of either iron or steel tubes, when coated with copper, brass, or other alloys of copper, in the construction of tubular flues for steam boilers. And, fourthly: I claim, in the construction of tubular flues of steam boilers, the application of welded iron or steel tubes, which have been drawn through a circular hole or die, or between rollers, and which have been drawn over a mandrel." Among other suggestions of grounds for the repeal of the patent, it was contended for the Crown that the supposed invention described in these claims, was not a principle of working or making any manner of new manufacture. Lord Denman, C. J., said: "With regard to the third and fourth

claims, in which the defendant Cutler claims the application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that might have been a new discovery, and a proper subject for a patent ; but I think Lord Abinger's illustration is a striking one, and applicable to the present case. 'It is like sweeping a carpet of a new manufacture with an old broom.' If he had introduced a new article which required the application of a new principle to the production of it, it might have formed a subject of a patent ; but the mere application of a thing which existed before does not appear to me to be a subject for a patent. And, in general terms, I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article or to the mode of applying it for attaining that result, forms no ground for a patent. It appears from the specification, and indeed it is admitted by the defendants, that the coated tubes mentioned in the specification are not new ; and I think, therefore, that the third part of the invention which is claimed in this specification cannot be made the subject of a patent. It seems to me, also, that the same objection applies to the fourth part—nothing more is claimed than the mere application of the tubes." At a new trial, which was granted on another point, Wightman, J., said to the jury : "the third and fourth claims raise no question at all for your consideration ; but questions of law, whether that which was claimed was a manufacture within the meaning of the statute, or was not a claim for any particular process or manufacture, but for an application of certain matters. Now, I entertain a strong opinion on this question, as to whether a mere application can be made the subject of a patent ; for when once you have got a material, you may apply it as you may think fit." (*Macrory, P. C.* 124 ; 3 *C. & K.* 215 ; 14 *Q. B.* 372, *n.*)

76. STEINER *v.* HEALD. [1851]

Prior to the date of the plaintiff's patent, granted to him in 1843, madder dye had been obtained from fresh madder by the

application of hot water, but there still remained in the dye-vats a residuum, called "spent madder," which was known to contain some colouring matter, but which had never been extracted from it, and the "spent madder" was consequently thrown away as useless. Some time prior to the plaintiff's patent a process was discovered, which, by the application of hot water and acid to fresh madder, produced a dye called garancine, which possessed different properties to the old madder dye. This process extracted the whole colouring matter from the fresh madder. The plaintiff, by his patent, claimed the application of this process to "spent madder," whereby he obtained garancine. And the "spent madder" thereby became of much value: Held, that, as "spent madder" might be in its nature and properties the same as or different from "fresh madder," it did not follow, as matter of law, that the plaintiff's patent was void; but that it was a question of fact for the jury, whether the plaintiff's invention was a new manufacture of garancine. (6 *Exch.* 607; 17 *Jur.* 875; 20 *L. J., Exch.* 410.)

77. BUSH v. FOX. H. L. [1852—1856]

Patent for "Improvements in the means of, and in the apparatus for, building and working under water." The patentee, in his specification, says: "My invention relates to means and apparatus for working under water, in order to produce excavations and building foundations of lighthouses, piers, jetties, and other structures under water." And the patentee continued: "What I claim is, the mode of constructing the interior of a caisson, in such manner that the workpeople may be supplied with compressed air, and be able to raise the materials excavated, and to make or construct foundations and buildings, as above described." At the trial of an action for an alleged infringement, the defendants pleaded (*inter alia*) "that the invention was not an invention of a certain manner of new manufacture, as alleged in the declaration." It was then proved that the apparatus described in a prior patent was the same in all material respects as the plaintiff's caisson, the mode of working was the same in both cases, and they differed only in their application, the prior patent being for excavating and sinking

shafts, &c., on land, the plaintiff's for sinking, excavating, and constructing foundations under water. Pollock, C.B., in directing the jury, said: "I am of opinion, upon the evidence as it now stands, 'that the said supposed invention in the declaration mentioned was not an invention of a certain manner of new manufacture in manner and form as the plaintiff has alleged.' I think that an invention must be a production of something that can be used or sold or made use of for some purpose, or some method which results in something of the same sort. And I think that a man cannot, if he has applied—supposing this to be a new application—an old invention, or part of an old invention, to a new purpose, obtain a patent for such an application. Now, if the construction of this caisson, or pile, or whatever it is to be called, is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture; and the application is such an operation (if so it can be called) that nothing new which results from it can, I think, be the subject of a patent. . . . I think if one man invents a new mode of looking at the moon, somebody else cannot take out a patent for using the same mode to look at the sun, nor for any mere application of it to a different purpose. If a man were to take out a patent for a telescope, to be used to make observations on land, I do not think any one could say, 'I will take out another patent for that telescope, to be used for making observations on the sea.' I therefore direct you, that, in point of law, in my judgment, the supposed invention was not an invention of any manner of new manufacture in manner and form as the plaintiff has alleged." (*Macrory's P. C.* 164.) This ruling was affirmed in the Exchequer Chamber. Maule, J., said: "Assuming that the machine itself is old, the learned Judge held that a mere application is not a new manufacture, and, therefore, not the subject of a patent; and my present opinion is, that, on the evidence, he was right in so directing the jury." (*Macrory's P. C.* 166; 23 *L. J.*, *Ex.* 257. Affirmed in the House of Lords, 5 *H. L. Cas.* 707; 25 *L. J.*, *Ex.* 251; 2 *Jur.*, *N. S.* 1029; *Macrory's P. C.* 178.)

78. TETLEY v. EASTON. [1857]

The discovery that a particular advantage may be attained by the use of a machine known before, in a manner known before, is not an invention or application which can be made the subject of a patent. (2 *Com. B.*, *N. S.* 706 ; 26 *L. J.*, *C. P.* 269.)

79. THE PATENT BOTTLE ENVELOPE COMPANY v. SEYMER.
[1858]

Infringement of a patent for “improvements in the manufacture of cases or envelopes for covering bottles.” The invention consisted in an arrangement of apparatus by which lengths of rush, straw, or other suitable material, may be tied together so as to form cases or covers to protect bottles from breakage when packed. For this purpose the plaintiff employed moulds or mandrels, corresponding in form to the bottle for which the case or cover is intended, over which he tied the lengths of rush, &c. After describing the manner of performing his invention, the patentee claimed “the combination of mechanism and the making of envelopes for bottles, as herein described.” The defendants also worked a patent for “improvements in the manufacture of cases or packings for bottles or jars,” in which they employed a similar mould or mandrel, and this was the infringement complained of by the plaintiffs. Willes, J., delivering the judgment of the Court of Common Pleas, said: “The fact that the model or mandrel constitutes part only of the plaintiff’s process does not of itself affect the question. The infringement of any part of a patent process is actionable, if that part is of itself new and useful, so as that it might be the subject-matter of a patent, and is used by the infringer to affect the object, or part of the object, proposed by the patentee. The question, therefore, is whether the plaintiffs could have taken out a patent simply for applying a model or mandrel in the form of a bottle, or, indeed, a bottle itself, in making envelopes for bottles. We are of opinion that they could not. The use of a model or mandrel, for producing given forms of pliable materials, was admitted at the trial, and, indeed, without such admission, is well known to have been for ages common

and usual in various arts. Such use was part of common knowledge, and a model or mandrel for purposes similar to that of this patent was an ordinary and well-known tool. It is merely in respect of the sort of material to which it is applied, and the form of the utensil produced by it, that the plaintiff's application of the model possesses any novelty. The application of a well-known tool to work previously untried materials, or to produce new forms, is not, in our opinion, the subject-matter of a patent. The observations of the court in giving judgment in the recent case of *Telley v. Easton* sustains this proposition. Indeed, to hold the contrary might tend to produce oppressive monopolies in the application of old and well-known implements to new materials, without any further novelty or merit than the discovery of the material, or the form into which it is to be worked. Such a discovery is not, in our opinion, one of a new 'manufacture' within the statute of James; and a patent for it alone cannot be maintained." (5 *Com. B.*, *N. S.* 164; 28 *L. J.*, *C. P.* 22; 5 *Jur.*, *N. S.* 174.)

80. BROOK v. ASTON. [1859]

A patent was obtained in 1856 for "An improvement in finishing yarns of wool or hair, and in the finishing of woven fabrics, or piece goods." The specification stated the improvement to consist of causing yarns of wool or hair, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers, by which such yarns will be burnished or polished on all sides; and in subjecting woven fabrics or piece goods of cotton, linen, silk, wool, hair or other fabrics to a similar process. The separate parts, as well as the exact details of machinery employed, were disclaimed, the patentee claiming as his invention merely the application of the above process to the yarns and fabrics specified. The defendants at the trial proved that a patent had been obtained in 1853 for the same improvement in finishing cotton and linen yarns by a similar process similarly applied. Held, that the plaintiff's patent was bad, as the mere application of known machinery by the same means to some new substance is not the subject of a patent. (8 *El. & Bl.* 478; 27 *L. J.*,

Q. B. 145 ; 4 *Jur.*, *N. S.* 279.) This judgment was affirmed in the Exchequer Chamber. Cockburn, C. J., said: "It seems to me that the material to which the process under the respective patents are to be applied are of so similar a nature, that where a patent is taken out for a process as to one, another patent cannot be taken out for applying the same process to the other." Martin, B., said: "The question is, whether another person can take the same machinery as was patented in 1853 for linen and cotton yarn, and obtain a patent for the application of it to woollen and thread. I quite concur in the judgment of the Court of Common Pleas in *The Patent Bottle Envelope Company v. Seymer*, that the application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes in fact a tool. I am therefore of opinion that the application of this machinery to woollen yarns is not the subject of a patent." (28 *L. J.*, *Q. B.* 175 ; 5 *Jur.*, *N. S.* 1025.)

81. *MACKELCAN v. RENNIE.* [1862]

The plaintiff's patent was for "Improvements in floating docks." It was proved at the trial that the construction of the floating docks was not new. The plaintiff then said that his invention consisted, not in the construction of floating docks, but in the application of iron, in the place of wood, to their manufacture. The court, having determined that this claim was not borne out by the specification, continued; "We think it right to add, that it must not be inferred that the court entertains an opinion that the alleged invention, even if it were appropriately claimed, could properly be the subject of letters-patent. It is unnecessary on this occasion to give any opinion upon that point; but we wish not to be supposed to sanction such a notion." (13 *Com. B.*, *N. S.* 52.)

82. *THOMPSON v. JAMES.* Ch. [1863]

Hoops of whalebone, cane, and other substances, suspended from the waist and forming a petticoat, had long since been used by ladies. The plaintiffs took out a patent for using, for the same purpose, hoops made of steel watch springs. The

Master of the Rolls said: "If the plaintiffs' claim is simply to use steel springs in a position where formerly whalebone was used, that does not appear to me to be the subject of a patent; there is no invention, and nothing that can properly be called an invention in that, and nothing which can properly form the subject of a patent. . . . To constitute the subject of a patent there must be some real novelty in the invention, either by a new combination of old existing materials, or else by the discovery of something that did not exist before." (32 *Beav.* 570.)

83. *PENN v. BIBBY*; *PENN v. JACK*. [1866]

The plaintiff's patent was granted for an improvement in the bearings and bushes for the shafts of screw and submerged propellers. The specification described the invention as follows: "The inner surfaces of these bearings are grooved to receive fillets of wood, which project to some extent beyond the inner surfaces of the metal bearings, so as to prevent the shaft coming into contact with the metal of the bearings, and these spaces admit of the water flowing freely between the shaft and the inner surfaces of the metal bearings." At the end of the specification the patentee said: "What I claim is the employing of wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers as herein described." It was objected that this was not the subject-matter of a patent, because the alleged invention was merely a new application of an old and well-known thing. The only examples of old use alleged by the defendants were in grindstones and water-wheels. The Lord Chancellor said: "It is very difficult to extract any principle from the various decisions on the subject which can be applied with certainty to every case; nor indeed is it easy to reconcile them with each other. The criterion given by Lord Campbell in *Brook v. Aston* has been frequently cited (as it was in the present argument), that 'a patent may be valid for the application of an old invention to a new purpose; but to make it valid there must be some novelty in the application.' I cannot help thinking that there must be some inaccuracy in the report of his lordship's words; because, according

to the proposition as he states it, if the invention is applied to a new purpose, there must be some novelty in the application. Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or, at least, of a rule, for judging in these cases, in *Harwood v. The Great Northern Railway Company*; there he says, ‘Although the authorities establish the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purposes, or to purposes so nearly cognate and similar as that the application of it in the one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, whether the said amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is sufficiently meritorious to be deserving of a patent.’ In every case of this description, one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study.” Applying this test to the present case, his lordship held, that the patented invention was not merely an application of an old thing to a new purpose, but that it was a sufficient invention to support a patent. (*L. Rep.*, 2 Ch. 127; 36 *L. J.*, Ch. 455; 15 *W. R.* 208; 15 *L. T. Rep.*, N. S. 399.)

84. WHITE *v.* TOMS. Ch. [1867]

Ladies’ mourning bonnet and hat falls having previously been made with the ornamental folds on the outside only, so that when turned up a “wrong side” was exposed to view, the plaintiff introduced and patented an improved mode of making them with the folds of the inner side also, so as to form both sides alike, but there was no novelty in the process of manufacture. Malins, V.-C., held, that this was not a subject for a patent, for “where there is merely an improvement in the mode of manufacture and no invention, that is not a proper subject for a patent.” And again, “the inclination of modern times is to restrict rather than enlarge the operation of patent laws; and the right has been so much abused, that it has become abso-

lutely necessary to put some restraint on the inconvenience which the public and the trade have suffered by the number of existing patents; so that the protection of those laws shall only be given to those who really invent something that is for the public benefit." (37 *L. J.*, *Ch.* 204; 17 *L. T. Rep.*, *N. S.* 348.)

85. *RUSHTON v. CRAWLEY.* Ch. [1870]

The plaintiff obtained a patent for the use of animal fibre, by preference Russian wool, or wool of a coarse texture, in the manufacture of artificial hair to be made up as ladies' head-dresses, and for upholstery, and other like purposes. Upon bill filed to restrain an infringement of the patent, Vice-Chancellor Sir R. Malins said: "It is a gross violation of the privilege conferred upon inventors for a person to take out a patent for a known article which has been used for years, because he finds he can produce a thing cheaper or better by a new material, or to suppose that directly he uses the new material it can be a subject for a patent. Suppose anyone should discover some other well-known material for making these things, such as paper, is he to take out a patent for it? And afterwards someone else should find out they could be made of straw, is he also to have a patent? So far as my opinion goes, and I desire it to be distinctly understood, the use of a new material to produce a known article is not the subject of a patent, but there must be some invention, something really new, something more valuable to the public than the simple use of a new material to produce a known article. I do not think it is necessary to go through the various authorities which were cited. The case of *Crane v. Price* was a patent for the use of anthracite coal. The patent was established, but it is now generally considered that such a case would not succeed in the present day. The case of *Brook v. Aston* is conclusive against the plaintiff. That was a patent for simply using some machinery for wool which had been previously used for linen, yarn, or cotton. That, therefore, was using the same thing for a new material; this is using a new material for an old thing, according to the statement of the

plaintiff. But it turns out from the evidence that it is not a new material, but a perfectly old material. Assuming, however, that it was new, and that wool had never been used before for making these articles, upon that assumption, in my opinion, the patent would be wholly void." (*L. Rep.*, 10 *Eq.* 522.)

*Application of a known Machine, Process or Material
to an Analogous Purpose.*

86. LOSH v. HAGUE. N. P. [1838]

The application of a well-known thing to an operation analogous to that for which it has already been used is not the subject of a patent. (1 *Web. P. C.* 208.)

87. KAY v. MARSHALL. [1839—1848]

Patent for "a new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances, by power." The specification states the invention to consist of "new machinery for macerating flax and other similar fibrous substances previous to drawing and spinning it, which is called the preparing it; and also for improved machinery for spinning the same after having been so prepared." The machinery for macerating flax, &c., was held to be new, and a proper subject for a patent. The second part of the invention consisted in placing the drawing rollers only two and a half inches from the retaining rollers. It was proved that before the date of the patent flax and other fibrous substances were spun with machines by which the reach was varied according to the staple or fibre of the article to be spun, and that that had been a fundamental principle of dry spinning. Cotton had also been spun at a short reach. The use of moisture in spinning flax had been adopted under a prior patent, though in a manner different from that proposed by the plaintiff. The question before the court therefore was, whether the application of the short reach to the spinning of flax, when in a state of maceration, was a proper subject for a patent. Tindal, C. J., held, that it was not, being merely

“ the application of a piece of machinery already known and in use, to the new macerated state of the flax. . . . Suppose a patent to have been first obtained for some entirely new method, either chemical or mechanical, of reducing the fibres of flax to a short staple, we think that a second patent could not be taken out for an improved mode of machinery in spinning flax, which consisted of nothing more than the spinning of the short staple of flax by a spinning machine with a reach of a given length, not less than that already in use for the spinning of cotton; the effect of which would be, to prevent the first patentee from working his invention with the old machine at the proper reach. If a patent taken out for that object separately would be invalid, so also a patent taken out for an invention consisting of two distinct parts, one of which is that precise object, would be void also.” (5 *Bing. N. C.* 492; 7 *Scott*, 548; 8 *L. J., C. P.* 261; 2 *Web. P. C.* 71. Judgment affirmed in the House of Lords, 8 *C. & F.* 245; *West*, 682; 5 *Jur.* 1028; 2 *Web. P. C.* 79.

STEINER *v.* HEALD. [1851] See 76.

88. HORTON *v.* MABON. [1862]

The plaintiff in his patent claimed the application of double-angle iron to the construction of the troughs of the hydraulic joints of telescope gasholders. Before the date of the patent these troughs were constructed of two long pieces of single angle iron, which were attached to a sheet of iron of equal length by means of a double row of rivets. The jury found, first, that a trough of double-angle iron had not been applied to the purpose of gasholders before the date of the patent. Secondly, that double-angle iron was a known article of commerce, of a variety of sizes, and applied to a variety of purposes in the form in which the plaintiff claimed to use it. Erle, C. J. : “ The only novelty consists in the application of a known instrument to a purpose analogous to that to which it has been already applied; and, in my opinion, that is not the subject of a patent.” Willes, J. : “ I am of the same opinion. I do not deny that a new combination of old materials producing a new effect may

be the subject of a patent, but there must be some invention. Here all that was done was the application of an old idea to the subject of telescopic gasholders. That is no invention at all. The invention consists in the idea, and the mode in which the idea is made of practical utility. But the merit of that invention belongs to the person who first moulded iron in one piece into the form of double-angle iron, and applied it to such purposes as this." (31 *L. J.*, *C. P.* 255 ; 12 *Com. B.*, *N. S.* 437 ; 10 *W. R.* 582 ; 6 *L. T. Rep.*, *N. S.* 289 : affirmed on appeal, 16 *Com. B.*, *N. S.* 141 ; 12 *W. R.* 491 ; 9 *L. T. Rep.*, *N. S.* 815.)

89. ORMSON v. CLARKE. [1862]

The patent was for an improvement in the manufacture of cast tubular boilers for the heating of horticultural buildings. Boilers of the same *form* had been made previously to the plaintiff's patent, the several parts being cast separately and afterwards fixed together. The plaintiff's improvement consisted in casting the boiler in one piece; there was no claim as to the *mode* of casting. The court held, upon the authority of *Harwood v. The Great Northern Railway Company*, and *Horton v. Mabon*, that this was not the subject of a patent, being a mere application of the well-known process of casting to an article previously well known. (32 *L. J.*, *C. P.* 8 ; 13 *Com. B.*, *N. S.* 337 ; 9 *Jur.*, *N. S.* 749 ; 11 *W. R.* 118 ; 7 *L. T. Rep.*, *N. S.* 361 : affirmed in the Exchequer Chamber, 32 *L. J.*, *C. P.* 291 ; 14 *Com. B.*, *N. S.* 475 ; 10 *Jur.*, *N. S.* 128 ; 11 *W. R.* 787.)

90. WILLIS v. DAVISON. [1863]

The pneumatic lever (a kind of bellows) was used in organs before 1851 ; the compensating valve was used in the pedal bellows of organs before 1851, for the purpose of easing their working, but had never been applied to the pneumatic lever : the plaintiff, in 1851, took out a patent for the application of the compensating valve to the pneumatic lever, for the purpose of easing the working of the latter :—Held, that plaintiff's con-

trivance was not such a new invention as was capable of becoming the subject of a patent. (1 *N. R.* 234.)

91. HARWOOD v. THE GREAT NORTHERN RAILWAY COMPANY. [1860—1865]

The plaintiffs were the executors of Wild, to whom a patent had been granted for “improvements in fishes and fish-joints for connecting the rails of railways.” In securing the joints of rails it was usual, before the date of Wild’s patent, to attach a piece of iron, called a fish, to each side of the rail, by means of bolts and nuts. The patentee in his specification, said: “My invention consists in forming a recess or groove in one or both sides of each fish, so as to reduce the quantity of metal at that part, and to be adapted to receive the square heads of the bolts, which are thus prevented from turning round when the nuts are being screwed on.” And again, “The groove renders the fish lighter for equal strength, or stronger for an equal weight of metal, than a fish which is made of equal thickness throughout.” The defendants proved at the trial that channelled plates of iron, with square-headed bolts and screws, had previously been used for the purpose of fastening timbers together, when placed vertically upon one another, and when placed horizontally side by side. In one case of a bridge, a channelled plate with bolts had been used for the purpose of fishing a scarf joint where the ends of two timbers met together. Held, at *Nisi Prius*, that the invention was a good subject-matter for a patent. Affirmed in the Court of Queen’s Bench: (29 *L. J.*, *Q. B.* 193; 6 *Jur.*, *N. S.* 993.) On appeal to the Exchequer Chamber it was held, that the use of grooves in pieces of iron for holding materials together by means of bolts and nuts was old, and that the supposed invention was a mere application of that old contrivance, in an old way, to an analogous subject, without any novelty or invention in the mode of application. (31 *L. J.*, *Q. B.* 198; 8 *Jur.*, *N. S.* 1126. Judgment affirmed in House of Lords, 11 *H. L. Cas.* 654; 35 *L. J.*, *Q. B.* 27; 12 *L. T. Rep.*, *N. S.* 771.) In the House of Lords, in answer to the Lord Chancellor, Blackburn, J., delivering the opinion of Mr. Justice Shee and himself, after reading sect. 6 of the Statute

of Monopolies; said: "In order to bring the subject-matter of a patent within this exception there must be invention so applied as to produce a practical result. And we quite agree with the Court of Exchequer Chamber, that a *mere* application of an old contrivance in the old way to an analogous subject, *without any novelty or invention* in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent. There are many decisions to that effect, which were referred to at your Lordship's bar; and, if the matter were now for the first time to be decided on the construction of the statute, without reference to the case, we should think, on principle, that such should be the conclusion of the court. But then, in every case, arises a question of fact, whether the contrivance before in use was so similar to that which the patentee claims, that there is no invention in the differences, if any, between the old contrivance, and that for which the patentee claims a monopoly; and if there be none, there arises a further question of fact, viz., whether the purpose to which the contrivance was before applied and the new purpose are so analogous or cognate, that there is no discovery or invention in the new application; whether, in short, it is a *mere* application or not? For, if there is invention or discovery producing a practical benefit, as in the case of *Crane v. Price*, it is the valid subject of a patent. And we think it always must be a question of degree; a question of, more or less, whether the analogy or cognateness of the purposes is so close as to prevent there being an invention in the application. Mr. Grove, in his very able argument, contended, we believe correctly enough, 'that if there was any real invention, though a slight one, producing a practical beneficial result, the patent was good.' But the question still remains, was there such an amount of cognateness in the purposes that there was no real invention or discovery?" (35 *L.J., Q.B.* 33.) Applying this reasoning to the present case, the plaintiffs' patent was held valid. It was proved by the evidence that the main strain which a fish, employed for fishing rails, has to sustain, is in a vertical plane, that is, in its own plane. Such a strain is principally borne by the upper and under parts of such a plate, so that the iron in the centre of the plate is more or less superfluous. The

plaintiffs' testator's invention consisted in removing this superfluous portion, thus producing a groove to hold the bolt heads, and, at the same time, economising the material employed, without diminution of strength. The channelled iron employed prior to the patent in fishing the scarf joint of a bridge, was placed horizontally, although it had to sustain a vertical strain ; in the other cases in which channelled iron was employed the iron was flat, lateral wings being added, and was placed horizontally to resist flexure transverse to the plane of the plate. This, it was held, did not anticipate the plaintiffs' invention. Channell, B., delivered the opinion also of Keating, J., and Pigott, B., said : " The question is, whether the patentee has, by using the groove in the fish, invented a new manufacture, or has merely transferred a well-known thing to an analogous subject. Now, in our opinion, the law is correctly laid down in the judgment of the Court of Exchequer Chamber, to the effect that 'a mere application of an old contrivance, in the old way, to an analogous subject, without any novelty in the mode of applying such old contrivance to the new purpose, does not make a valid subject-matter of a patent.' Therefore, the point for consideration is thus reduced to this, whether the fishing of the rails, meeting butt-end to butt-end, with iron plates bolted together, and the strengthening of solid timbers by iron plates, also bolted to the timbers, as above stated, are analogous subjects? It seems to us that they are analogous But it was argued at the bar of your Lordships' House that there was invention at all events in this—that, whereas the grooved iron, as used in the bridges, had been applied for the purpose of binding together pieces of material laid upon one another horizontally, the grooved iron in fishing the rails was applied laterally, binding together the material, and that its great merit consisted in its performing the novel function of resisting the vertical pressure to which it was exposed, and did so by means of a plate equally strong, but rendered lighter than that previously in use by the removal of that portion of the plate which was useless in resisting such pressure. We do not find that any allusion to such an invention, as that now suggested, was made either at *Nisi Prius*, or in any of the judgments in the Court of Queen's

Bench supporting, or in that of the Exchequer Chamber invalidating, the patent right; nor do we think, looking to the terms of the specification, that Wild ever intended to claim, or did claim any such. . . . There is no novelty or invention to support the patent." (35 *L. J., Q. B.* 35.) The Lord Chancellor, in delivering the judgment of the House of Lords, said: "The question is, whether there can be any invention of the plaintiff in having taken that thing, which was a fish for a bridge, and having applied it as a fish to a railway. Upon that I think the law is well and rightly settled, for there would be no end to the interferences with trade, and with the liberty of any mechanical contrivance being adopted, if every slight difference in the application of a well-known thing were held to constitute a patent. . . . No sounder or more wholesome doctrine, I think, was ever established than that which was established by the decisions which are referred to in the opinions of the four learned judges, who concur in the second opinion delivered to your Lordships, namely, that you cannot have a patent for a well-known mechanical contrivance merely because it is applied in a manner or to a purpose which is analogous to the manner or to the purpose in 'or to which' it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied." (35 *L. J., Q. B.* 38.)

92. RALSTON v. SMITH. H. L. [1865]

The discovery of one particular use of a known machine, although more advantageous than that formerly known, is not the subject of a patent.

Before the date of the plaintiff's patent, a roller and a bowl were employed for calendering and for embossing woven goods. In the process of calendering the cloth was passed between a roller and a bowl; the roller was smooth, and the surface velocity of the roller and the bowl was unequal. In embossing, the cloth passed between a roller which had

the pattern to be transmitted to the cloth engraved upon it, and a bowl, the two moving with equal surface velocity. The object of the calendering was to produce a gloss upon the cloth. The plaintiff obtained a patent for "Improvements in embossing and finishing woven fabrics and in the machinery or apparatus employed therein." This title was subsequently amended, so as to be in these words, "Improvements in embossing and finishing woven fabrics." The specification enrolled by the plaintiff alleged the invention to consist in the use of rollers having any design grooved, fluted, engraved, milled, or otherwise indented upon them. A disclaimer was afterwards filed, and stated that the effect desired could only be produced by the use of a certain species of roller not particularly described in the specification, namely, a roller having *circular* grooves round its surface; and the use of all other rollers was disclaimed. The amended claim was for "the employment of grooved, fluted, or indented rollers of hard metal, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing or friction upon the fabric submitted to their action, and thereby produce an indefinite variety of pattern, as well as a bright finish or lustre," &c. The Lord Chancellor: "I should have thought that the patentee might have maintained a patent for a new combination if he had put his invention upon this ground, that he was the first person who discovered that the circular grooved roller would answer by one process the double purpose of calendering and imprinting the fabric; and that he was the first person who had constructed a machine that was capable, without injury to fabric, of effecting together both those operations. If, therefore, the original title had remained, and had not been studiously disclaimed, I myself should have thought it very difficult to resist the conclusion that the patent was capable of being supported as a new manufacture, under this view, that it really did describe, for the first time, a new combination of machinery. Your Lordships are well aware that by the large interpretation given to the word 'manufacture,' it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition to the thing produced, it will comprehend a new machine, or a new combi-

nation of machinery; it will comprehend a new process, or an improvement of an old process. But if we look at this patent, and inquire whether there is an improvement in embossing or finishing woven fabrics contained in this amended specification, I am bound to say, that, having regard to existing knowledge at the time, I think there is no such improvement as amounts to a new manufacture, because this mode of producing a brilliant gloss upon the surface was perfectly well known; the operation of the differential velocity was also perfectly well known; that the same thing had been thought of for the purpose of producing a pattern was also perfectly well known. Therefore, that woven fabrics might be finished according to one or the other of those two processes was perfectly well known. I cannot, therefore, having regard to the reduced specification which the patentee has now made to constitute the description of his invention, say that there is any new process entitling it to the denomination of a 'new manufacture.'" Lord Cranworth: "I quite agree with what was said by Mr. Grove, and it could not possibly be disputed by any gentleman at the bar, that it is not every useful discovery that can be made the subject of a patent, but you must show that the discovery can be brought within a fair extension of the words, 'a new manufacture.' Now how is this possible to be called 'a new manufacture?' I, as a manufacturer, have my roller, which I am in the habit of rolling upon a bowl (if that is the proper expression); the fabric passing between the two at equal velocities. Then I can impress my pattern upon it. I have my roller without any pattern engraved upon it; I can impress that at an unequal velocity, and it will calender. But I do not do them both at the same time, because I suppose that in so doing I shall tear my fabric; and I rightly so suppose, until the plaintiff makes the discovery that there is one particular sort of pattern which may be produced without tearing the fabric. Now that is a very useful discovery; but it would be strange to say that that is a new manufacture, and that, therefore, I am to be deprived of the most useful way of using my roller. There is nothing new in the invention, except that I now know what I did not know before, that by a particular use of it I shall obtain a result which I did not know before that I

could obtain." (11 *H. L. Cas.* 223; 20 *Com. B., N. S.* 28; 13 *L. T. Rep., N. S.* 1; 35 *L. J., C. P.* 49.)

93. JORDAN v. MOORE. [1866]

The plaintiff obtained a patent for "certain improvements in the construction of ships and other vessels navigating on water." The first and most important claim in the specification was "for the combination of an iron frame, with an external covering of timber planking for the sides, bilges, and bottoms." The court construed this claim to be a claim for planking with timber *any* iron frame of a ship. Byles, J., delivering the judgment of the Court, said: "Iron and wood being both of them materials long used for the construction of the frame and coating of vessels, can the application of wooden planking to the iron frame of a vessel (without any peculiarity in the nature of that planking) be the subject of a patent? We think it cannot. It is not only the substitution of one well-known and analogous material for another, that is, wood for iron, to effect the same purpose on an iron vessel, but it is the application of the same old invention, namely, planking with timber which was formerly done on a wooden frame to an analogous purpose, or rather the same purpose, on an iron frame. In this view of the case the recent decision of the Exchequer Chamber, and of the House of Lords, in *Harwood v. The Great Northern Railway Company*, appears to us to be in point, and decisive for the defendant." (*L. Rep.*, 1 *C. P.* 624; 12 *Jur., N. S.* 766; 35 *L. J., C. P.* 268; 14 *W. R.* 769.)

94. PARKES v. STEVENS. Ch. [1869]

James, V.-C., said: "I am clearly of opinion that there can be no patent right in the substitution of a slide for a hinge, whether applied to the door of a house, the door of a carriage, or the door of a lamp or lantern, whether large or small, suspended or not suspended. It was hardly contended before me that the introduction of the door alone would have been sufficient to sustain a patent; but it was contended that because it was, as alleged, a novel part of a novel combination and arrangement, it was so protected. To say that a patent for an entire

combination is a valid patent for a part, when that part would not of itself be patentable, is, in my judgment, a *reductio ad absurdum* of the supposed principle of *Lister v. Leather*." (*L. R.*, 8 *Eq.* 367; 38 *L. J.*, *Ch.* 631.)

Judgment affirmed on appeal.—Hatherley, L. C., held, that the adaptation of a sliding door to a spherical lamp, sliding doors having previously been applied to cylindrical lamps and to other glazed surfaces, cannot of itself be the subject of a patent. (*L. R.*, 5 *Ch.* 36; 18 *W. R.* 233; 22 *L. T. Rep.*, *N. S.* 635.)

Principle.

95. BOULTON v. BULL. [1795]

Rooke, J.: "The term 'principle' is equivocal; it may denote either the radical elementary truths of a science, or those consequential axioms which are founded on radical truths, but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles." (2 *H. Bl.* 479.) Heath, J.: "The Marquis of Worcester discovered, in the last century, the expansive force of steam, and first applied it to machinery. As the original inventor he was clearly entitled to a patent. Would the patent have been good applied to all machinery, or to the machines which he had discovered? The patent decides the question. It must be for the vendible matter, and not for the principle. Another objection may be urged against the patent, upon the application of the principle to an old machine, which is, that whatever machinery may be hereafter invented would be an infringement of the patent, if it be founded on the same principle. If this were so it would reverse the clearest positions of law respecting patents for machinery, by which it has been always holden, that the organisation of a machine may be the subject of a patent, but principles cannot. . . . Indeed it seems impossible to specify a principle, and its application to all cases, which furnishes an argument that it cannot be the subject of a patent." (*Ib.* 483.) Mr. Justice Buller: "The very statement of what a principle is, proves it not to be a ground for a patent. It is the first ground and rule for arts and sciences, or in other

words, the elements and rudiments of them. A patent must be for some new production from those elements, and not for the elements themselves." (*Ib.* 485.) Chief Justice Eyre: "Undoubtedly there can be no patent for a mere principle, but for a principle so far embodied and connected with corporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent" (*Ib.* 496). (2 *H. Bl.* 463; 1 *Carp. P. C.* 117; *Dav. P. C.* 162.)

96. HORNBLOWER v. BOULTON. [1799]

Grose, J.: "Having very much turned the question in my mind, and weighed and considered again and again the words of the statute specifying what patents the Crown may grant, upon which alone I conceive the question must ultimately depend, I am not prepared to say that a patent for a mere principle was intended to be comprehended within those words." (8 *T. Rep.* 101.) Lawrence, J.: "'Principle' may mean a mere elementary truth, but it may also mean constituent parts." See also 39. (*Ib.* 106.)

JONES v. PEARCE. N. P. [1832] See 42.

97. JUPE v. PRATT. [1837]

Alderson, B., said: "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention." (1 *Web. P. C.* 146.)

98. NEILSON v. HARFORD. [1841]

Alderson, B.: "I take the distinction between a patent for

a principle and a patent which can be supported, is, that you must have an embodiment of the principle in some practical mode described in the specification of carrying the principle into actual effect, and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect." (1 *Web. P. C.* 342.) "There is no difference between (claiming) a principle to be carried into effect in any way you will, and claiming the principle itself." (*Ib.* 355.)

99. THE HOUSEHILL COMPANY v. NEILSON. [1843]

Lord Justice Clerk Hope: "A patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature, or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business, and arts, and utilities of life. The mere discovery of such a principle is not an invention, in the patent law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry, or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a great, general, and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained. (1 *Web. P. C.* 683.) . . . It would be very strange and unjust to refuse the same legal effect, when the inventor has the additional merit of discovering the principle as well as its application to a practical object. The instant that the principle, although discovered for the first time, is stated, in actual application to, and as the agent of, producing a certain specified effect, it is no longer an abstract principle; it is then clothed with the language of practical application, and receives the impress of tangible direction to the actual business of human life." . . . A claim for all

modes of applying the principle to the purpose specified, according to or within a general statement of the object to be attained, and of the use to be made of the agent to be so applied, is no objection whatever to the patent. That the application or use of the agent for the purpose specified, may be carried out in a great variety of ways, only shows the beauty, and simplicity, and comprehensiveness of the invention. But the scientific and general utility of the proposed application of the principle, if directed to a specified purpose, is not an objection to its becoming the subject of a patent. That the proposed application may be very generally adopted in a great variety of ways, is the merit of the invention, not a legal objection to the patent. (*Ib.* 684.) . . . I state to you the law to be, that you may obtain a patent for a mode of carrying a principle into effect ; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of apparatus, is essential, in order to obtain benefit from the principle, then you may take your patent for the mode of carrying it into effect, and are not under the necessity of describing and confining yourself to one form of apparatus. If that were necessary, you see what would be the result ? Why, that a patent could hardly ever be obtained for any mode of carrying a newly-discovered principle into practical results, though the most valuable of all discoveries. For the best form and shape or modification of apparatus cannot, in matters of such vast range, and requiring observation on such a great scale, be attained at once ; and so the thing would become known, and so the right lost, long before all the various kinds of apparatus could be tried. Hence you may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will, more or less, produce the benefit, and you are not tied down to any form" (*Ib.* 685). (1 *Web. P. C.* 673 ; 1 *C. & F.* 788.)

ELECTRIC TELEGRAPH COMPANY *v.* BRETT. [1851] See
16, *per* Cresswell, J.

100. CROSSLEY v. POTTER. N. P. [1853]

The title was for "certain improvements in weaving figured fabrics." The patentee in his specification says: "My improvements in weaving figured fabrics apply to those particular kinds of fabric which have a terry or raised looped surface, such as coach lace, Brussels carpeting, velvets, and other woven goods having terry or raised surfaces, either plain or figured." The evidence went to show that without additional parts, which were not mentioned, the machine described in the specification was capable of making coach lace, but not of making either carpet or velvet goods. Pollock, C. B., in directing the jury, said: "The truth appears to me to be this, that the patent is very much like what has often been attempted, viz., to take out a patent for a principle, which the law will not allow. Any man who takes out a patent must take it for a manufacture. It is very true that patents are continually taken out for what are called 'methods,' or 'processes;' but the real object of the patent, the real end that is secured by the statute, the matter that is alone mentioned in it capable of being made the subject of a patent, is a new manufacture; and everybody who takes out a patent under the name of a process, really takes it out for that which is the result of the process, for the thing that is manufactured, or the process by which it is produced. There is a sort of struggle apparently between lawyers and patent agents. The patent agent is constantly endeavouring to get a patent for a principle; the lawyer is interposing and saying, 'you cannot do that.' It is a matter of clear and distinct law that you cannot have a patent for a principle. Whatever principle you have invented or applied, you must have it embodied in some machine or manufacture distinctly, in order that other ingenious and enterprising members of the community may distinctly know what it is they are prohibited from doing." (*Macrory's P. C.* 240.)

NOVELTY OF INVENTION.

Novelty Generally.

101. HASTINGS' PATENT. [1567]

A patent was granted to Mr. Hastings "in consideration that he brought in the skill of making frisadoes, as they were made in Harlem and Amsterdam, beyond the seas, *being not used in England*, that therefore he should have the sole trade of the making and selling thereof for divers years, charging all other subjects not to make any frisadoes in England during that time, by pain to forfeit the same frisadoes by them made, and to forfeit also 100*l.*, the one moiety thereof to the Queen's Majesty, the other to Mr. Hastings." This patent being infringed by certain clothiers, Mr. Hastings "exhibited his English bill in the Exchequer Chamber against them; where, upon the examination of the clause, it appeared that the same clothiers did make baies very like to Mr. Hastings' frisadoes, and that they used to make them before Mr. Hastings' patent; for which cause they were neither punished, nor restrained from making their baies like to his frisadoes." (*Noy, R.* 182; 1 *Webb. P. C.* 6.)

102. MATTHEY'S PATENT. [Eliz.]

By this patent "it was granted unto him the sole making of knives with bone hafts and plates of lattin, because, as the patent suggested, he brought the first use thereof from beyond seas. Yet nevertheless, when the wardens of the Company of Cutlers did show before some of the council and some learned in the law, that they did use to make knives before, though not with such hafts, that such a light difference or invention should

be no cause to restrain them, whereupon he could never have benefit of this patent, although he laboured very greatly therein." (*Noy, R.* 178; 1 *Web. P. C.* 6.)

103. HUMPHREY'S PATENT.

A patent was granted to Humphrey "for the sole and only use of a sieve or instrument for melting of lead, supposing that it was of his own invention, and therefore prohibited all others to use the same for a time. And because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber, by English bill. In which court the question was, whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendiff, in the west country, which if it were there before used, then the court were of opinion that he should not have the sole use thereof." (*Noy, R.* 183; 1 *Web. P. C.* 7.)

104. DARCY v. ALLIN. [1602]

"Where any man doth bring any *new* trade into the realm, or any engine tending to the furtherance of a trade, *that never was used before*, the king may grant to him a monopoly patent." (*Noy, R.* 182; 1 *Web. P. C.* 6.)

MITCHELL v. REYNOLDS. [1713] See 3.

105. LIARDET v. JOHNSON. N. P. [1778]

The general question is, whether the invention was known and in use before the patent. (*Bull, N. P.* 76; 1 *Web. P. C.* 53; 1 *Carp. P. C.* 35.)

106. R. v. ARKWRIGHT. N. P. [1785]

Scire facias to repeal letters patent granted to the defendant. The specification described various parts of machinery, but no complete machine, and the defendant did not point out what parts were new. Buller, J., left the following questions to the jury:—"First, whether this invention is new? secondly, if it be new, whether it was invented by the defendant?" After commenting upon the evidence, his lordship said: "Thus the

case stands as to the several component parts of this machine; and if, upon them, you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant, upon either of these points the prosecutor is entitled to your verdict." (*Dav. P. C.* 61; 1 *Web. P. C.* 64; 1 *Carp. P. C.* 53.)

107. HUDDARD *v.* GRIMSHAW. N. P. [1803]

Action for the infringement of a patent for a new mode of making cables and other cordage. Ellenborough, C. J., in addressing the jury, said: "In inventions of this sort, and every other through the medium of mechanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common elementary materials to work with in machinery, but it is the adaptation of those materials to the execution of any particular purpose, that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end, and beneficial to the public, it is that species of invention, which, protected by the king's patent, ought to continue to the person the sole right of vending; but if, prior to the time of his obtaining a patent, any part of that which is of the substance of the invention has been communicated to the public in the shape of a specification of any other patent, or is a part of the service of the country so as to be a known thing, in that case he cannot claim the benefit of his patent." . . . If, in his specification, the patentee "appropriates more than his own, he cannot avail himself of the benefit of it. I don't mean if he states a bobbin which was in common use before, but if he states any particular thing before in common use, applied in a new manner to the production, and effecting a new end, that is part of the substance of the invention. And if he states that which of itself is not new, but old and known to the world, though it was unnecessary for him to do so, having done so, he has overstepped his right, and has included in his invention that which is not his invention; in that respect his patent would be void." (*Dav. P. C.* 278; 1 *Web. P. C.* 86; 1 *Carp. P. C.* 225.)

108. MANTON v. MANTON. N. P. [1815]

Action for the infringement of two patents, one for a hammer upon an improved construction, for the locks of fire-arms; the other, for "an improvement in double-barrelled guns." Gibbs, C. J., in directing the jury, said: "In order to support a right to the exclusive enjoyment of any invention, it is necessary that the party who takes out the patent should show that the invention is new, that it was unknown to the trade and to the world before, that it is not only new, but that it is useful to the public; and it is necessary likewise that he should show that he has accurately explained the nature of his invention in his specification, separating that which is new from that which is old. (*Dav. P. C.* 343.) . . . If any one man made these locks, and was in possession of the secret of making them upon the same principle as Joseph Manton's locks, there would be an end of the patent." (*Ib.* 353.)

109. R. v. CUTLER. Sci. fas. [1816]

Scire facias to repeal the defendant's patent for "improvements in firegrates or stoves." The specification, after describing the stove, claimed as the invention, the construction of stoves in such manner as that the fuel necessary to supply the fire shall be introduced from beneath, either in a perpendicular, or in an oblique direction. Ellenborough, C. J., was of opinion that the evidence showed grates to have been constructed, prior to the patent, on a principle identical with that described in the specification; that the patentee, by his claim, had confined himself to that principle, which was not new, and that, therefore, the patent could not be supported, although the application of the principle, as described in the specification, was new. (1 *Stark.* 354; 1 *Web. P. C.* 76; 1 *Carp. P. C.* 351.)

110. HILL v. THOMPSON. [1818]

Dallas, J., in delivering the judgment of the Court of Common Pleas, said: "This, like every other patent, must undoubtedly stand on the ground of improvement, or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the

discovery of something altogether new; and the patent must distinguish and adapt itself accordingly. If the patent be taken out for discovery, when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void. . . . If the discovery claimed were known and made use of before, the patent is at an end. Now, with reference to this particular case, it may be proper shortly to consider, what novelty and discovery are deemed to be; and when I say novelty and discovery, I mean to distinguish between those terms; for it is not enough to have discovered what was unknown to others before, if the discovery be confined to the knowledge of the party having made it; but it must have been communicated, more or less, or it must have been more or less made use of, so as to constitute discovery, as applied to subjects of this sort. The case of *Dollond* has been mentioned at the bar, as also Tennant's patent for bleaching liquor, and they stand so contrasted as to illustrate the distinction to which I allude." (2 *B. Moo.* 451; 8 *Taunt.* 394; 1 *Web. P. C.* 244.)

111. HULLET v. HAGUE. [1831]

When the object of two patents is the same, but the mode of effecting that object, which is the thing claimed, is different, the prior patent does not affect the novelty of the subsequent one.

A patent was taken out for improvements in evaporating sugar, &c. The specification was as follows:—"My invention consists in a method or apparatus as hereinafter described, by which I am enabled to evaporate liquids and solutions at a low temperature, &c. And my said invention and improvement consists in forcing, by means of bellows, or any other blowing apparatus, atmospheric or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation; and this I do by means of pipes, whose extremities reach nearly (or within such distance as may be found most suitable under peculiar circumstances) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, *the other extremities of such pipes being connected with larger pipes*, which communicate with the bellows or other blowing apparatus which forces the air into them." The lesser pipes

were to be equally distributed, and their lower ends on a level with each other. It was further declared, that the form of the apparatus might be varied, provided the essential properties were maintained:—Held, that taking the whole of the specification together, it appeared that the invention consisted of the particular method or process of forcing, by means of bellows, &c., air through the liquid subjected to evaporation, viz., *by pipes connected with larger pipes, and placed as mentioned in the specification*; and, therefore, that it was not void because another patent had been before granted to other persons for effecting the same object, by a coil of pipes (lying at the bottom of the vessel), perforated with small holes, or by a shallow cullender placed at the bottom of the vessel. (2 B. & Ad. 370.)

112. NEWTON v. THE GRAND JUNCTION RAILWAY COMPANY.
[1846]

Pollock, C. B.: “In order to ascertain the novelty, you take the entire invention, and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent.” Alderson, B.: “In considering whether the invention is new, the proper mode is to take the specification altogether, and see whether the matter claimed as a *whole* is new. Now, the whole which may be new as claimed, may consist in some degree of old parts, and in some degree of new parts. The question of novelty, however, will depend on whether the whole taken altogether is new, though it may in part consist of old parts, provided the patentee does not claim the old parts, but only the combination of them and the new.” (5 Exch. 334; 20 L. J., Exch. 429.)

GAMBLE v. KURTZ. [1846] See 459.

113. NEWTON v. VAUCHER. [1852]

The defendant in 1839 obtained a patent for an improvement in packing hydraulic and other machines by means of a lining of soft metal, the effect of which was to make certain parts of the machines air and fluid tight. Subsequently to this the plaintiffs discovered that the same soft metal had the effect of

diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact of machines in rapid motion and subject to pressure; and he embodied the application of that discovery to machines in a patent, dated 1843. Held, that as the plaintiff's application of the soft metal differed essentially from that of the defendant, the plaintiff's patent was new. (6 *Ex. Rep.* 859; 21 *L. J.*, *Ex.* 305.)

BETTS *v.* MENZIES. [1858—62] See 162.

114. DAW *v.* ELEY. Ch. [1865]

The antecedent existence of an invention which was so far similar, that, if subsequent in date to the patent, it would have been held a colourable and clumsy imitation for the purpose of effecting the same result, did not invalidate the patent by anticipation. (*L. Rep.*, 3 *Eq.* 496; 14 *W. R.* 126; 13 *L. T. Rep.*, *N. S.* 399.)

BETTS *v.* NEILSON: BETTS *v.* DE VITRE. [1868] See 168.

115. PARKES *v.* STEVENS. Ch. [1869]

When, in a patent for an entire combination, the novelty of any individual part of the combination has to be determined, it is best done by asking whether, upon the evidence, it could by itself have been the subject of a valid patent. (*L. Rep.*, 5 *Ch.* 38; 18 *W. R.* 234; 22 *L. T. Rep.*, *N. S.* 639.)

116. CANNINGTON *v.* NUTTALL. H. L. [1871]

The Lord Chancellor, moving the judgment of the House of Lords, said: "I take it that the test of novelty is this: Is the product which is the result of the apparatus for which an inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view." (*L. Rep.*, 5 *H. L.* 216.) His Lordship considered the following direction to a jury to be correct: "If a person takes well-known processes from a great number of sources and a great many inventions, and adapts them altogether to a perfectly new combination, for a perfectly

new purpose, their previous use is not an anticipation of the patent." (*lb.* 222.) (*L. Rep.*, 5 *H. L.* 205; 40 *L. J.*, *Eq.* 739.)

117. MURRAY v. CLAYTON. Ch. [1872]

Sir W. M. James, L. J., in the course of his judgment in this case, said: "I am not aware of any principle or authority upon which the exhibition of a useless machine which turns out a failure can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines." (*L. Rep.*, 7 *Ch.* 581; 20 *W. R.* 650.)

Want of Novelty in a Part of an Invention.

118. BRAMAH v. HARDCASTLE. N. P. [1789]

The patent was for a water-closet upon a new construction. It was objected that the patent, being taken for the whole water-closet, the arrangement of some of the parts only being new, was void. Kenyon, J., said: "Unlearned men look at the specification, and suppose everything new that is there. If the whole be not new, it is hanging terrors over them." The question for the jury is, whether the principle of the invention, and the means employed to effect the object to be obtained, are new; whether the shape is new or not is immaterial. (*Holroyd*, 81; 1 *Carp. P. C.* 168.)

119. HILL v. THOMPSON. [1818]

Dallas, J.: "If any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." (2 *B. Moo.* 457; 8 *Taunt.* 401; 1 *Web. P. C.* 249.)

120. BRUNTON v. HAWKES. [1821].

Patent for "certain improvements in the construction, making, or manufacturing of ships' anchors, and windlasses, and chain cables or mooring." It was proved at Nisi Prius, that the mode of manufacturing anchors described in the plaintiff's

specification had never been applied before to ships' anchors; but had been applied to the adze-anchor, and the mushroom-anchor. These anchors are used only for the purpose of mooring floating lights or vessels intended to be stationary, and are never taken on board. The jury having found a verdict for the plaintiff, the defendant obtained a rule *nisi* for a new trial, which the court afterwards made absolute. In his judgment, *Abbott*, C. J., said: "I feel myself compelled to say, that I think so much of the plaintiff's invention, as respects the anchor, is not new, and that the whole patent is, therefore, void. The mode of joining the shank to the flukes of the anchor is to put the end of the shank, which is in the form of a solid cylinder, through the hollow and conical aperture, and it is then made to fill up the hollow, and to unite itself with it. Now that is precisely the mode by which the shank of the mushroom-anchor is united to the mushroom top by which the shank of the adze-anchor is united to its other parts. It is indeed the mode by which the different parts of the common hammer, and pickaxe also, are united together. Now, a patent for a machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good, because there is a novelty in the combination. But here the case is perfectly different; formerly, three pieces were united together; the plaintiff only unites two; and, if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent; but, unfortunately, the mode was well known, and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose. It seems to me, therefore, that there is no novelty in that part of the patent as affects the anchor, and, if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. Then, if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part, as to the mooring chain? As at present advised, I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the

form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of the things is not new, the question arises, whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The king could not, in consideration of a new invention in one article, grant a patent for that article and another. The question then is, whether, if a party applies for a patent, reciting that he has discovered improvements in three things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me, that the case of *Hill v. Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question. (4 B. & Ald. 549.) . . . The consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention." (*Ib.* 552.) (4 B. & Ald. 541; 1 Carp. P. C. 405.)

121. LEWIS v. MARLING. [1829]

Parke, J.: "The objection to the patent, as explained by the specification, may be thus stated. The patent is for several things, one of which, then supposed to be useful, is now found not to be so; but there is no case deciding that a patent is on that ground void, although cases have gone the length of deciding, that if a patent be granted for three things, and one of them be not new, it fails *in toto*." (10 B. & C. 27; 5 M. & R. 70; 4 C. & P. 58; 1 Web. P. C. 497.)

122. KAY v. MARSHALL. [1839]

Tindal, C. J.: "If part of what is claimed is not properly the subject of a patent, or not new, the whole must be void." (5 Bing. N. C. 501; 7 Scott, 561.)

123. GIBSON v. BRAND. [1842]

Held, that, inasmuch as the patentees claimed eight several heads of invention, in order to support their patent they were bound to show that each of the parts was new. And that, if the patent be for a new or improved process, and the jury find the process not to be new but improved, *semble* that the patent is invalid. (4 *M. & G.* 179; 4 *Scott, N. R.* 844; 1 *Web. P. C.* 631.)

124. MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent for “an improved manufacture of metal plates for sheathing the bottoms of ships.” The patentee declared the nature of his invention to consist “in making the said plates for sheathing of an alloy of zinc and copper, in such proportions and of such qualities as, while it enables the manufacturer to roll the said compound metal into plates or sheets less difficult to work, &c., renders the said sheathing less liable to oxydation,” &c. The plaintiff claimed “the manufacture of metal plates or sheets for the purpose aforesaid, of an alloy of copper and zinc in such proportions as will enable the manufacturer to roll the said alloy while at a red heat, into sheets fit for the sheathing of ships,” &c.

Tindal, C. J., said to the jury: “The only further objection is, that hot rolling is made an essential part of the plaintiff’s invention, and is not new, inasmuch as that is pointed out in Collins’s specification, and has also been carried into practice—that that renders the patent void. I cannot understand that if the invention consists of various parts—that is, of the compound of the plates, and he states, as he goes along, that it is an advantage that it will roll hot—and the subject of it is, that it shall make an alloy for sheathing—the rolling of it hot, that being known before, will invalidate the patent.” (2 *Web. P. C.* 112.)

125. TEMPLETON v. MACFARLANE. H. L. [1848]

A patent was taken out for “a new and improved mode of manufacturing silk, cotton, linen, and woollen fabrics.” The

specification, and a disclaimer, set forth that the patentees claimed "the mode hereinbefore described of producing or preparing stripes of silk, cotton, woollen, or linen, or of a mixture of two or more of these materials, in such a manner that the weft, or lateral fibres of both cut edges of each stripe are all brought up on one side, and into close contact with each other, and the re-weaving of such stripes with the whole fur or pile uppermost, into the surfaces of carpets," &c. One of these processes was old. The judge directed the jury, that if one was new, the patent could be supported for the combination of them, and would only be invalid if there had been a public use of both before the date of the patent:—Held, that this direction was erroneous, and that the patent was void. (1 *H. L. Cas.* 595.)

126. M'CORMICK v. GRAY. [1861]

The specification of a patent reaping machine described the improvements as having for their object the holding of the straw in a favourable position while being cut, and the more conveniently arranging, collecting, and disposing of it when cut. Underneath a set of spear-head shaped fingers, placed at regular intervals apart from each other, was placed the cutting-blade, formed of a thin plate of steel, toothed upon its front edge and fitted into a groove, the blade having perfect freedom to slide from one side of the machine to the other. Wheel-gearing, being set in motion by the horse attached to the machine, caused a reel or gatherer to revolve, and so prevent the straws from being pressed forward when coming in contact with the cutting-blade, which had a rapid reciprocating motion imparted to it by the action of a crank and connecting-rod; the straws were thus speedily cut through, and fell backwards on the platform. The blade was represented by two figures, the one blade being straight in the cutting edge, while the other was zigzag or indented. "In every case, however, it has been found (the specification stated) to be of great advantage to have the cutting edge toothed somewhat similar to a sickle, and to have those teeth divided into sections corresponding to the number of fingers, each section having one half of the teeth inclined in one direction, and the other half having the teeth

inclined in the opposite direction." The inventor claimed "the construction of reaping machines according to the improvements before described; that is to say, the constructing and placing of holding-fingers, cutting-blades, and gathering-reels respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them, in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed." The published description of a previous patent machine stated it to be "for improvements in that kind of the machine in which the grain is cut by the serrated edge of a straight and vibrating cutter operated by a crank, the grain being sustained by fingers. The blade is serrated like a sickle, except that the angle of the teeth is reversed for every alternate tooth. . . . The fingers for supporting the grain are spear-formed." Held, (Bramwell, B., *dissentiente*), that in an action for an infringement of the subsequent patent, the defendant was, by reason of this prior publication, entitled to the verdict on the plea that the manufacture was not new. Held, by Bramwell, B., that in the absence of proof that the machine in its entirety was not new, the plaintiff was entitled to the verdict on that issue, notwithstanding the want of novelty in its separate parts. (7 *H. & N.* 25; 31 *L. J., Ex.* 42; 9 *W. R.* 809; 4 *L. T. Rep., N. S.* 832.)

Public Use.

TENNANT'S CASE. [1802] See 142.

127. LEWIS v. MARLING. [1829]

Action for the infringement of a patent for certain improvements on shearing machines. It was proved by the defendant, that the specification of a similar machine had previously been enrolled in America, that a model of an exactly similar machine had been exhibited to three or four persons in England, and that a manufacturer in England had commenced the construc-

tion of a machine from the American specification. This, however, was never completed, and it was proved by the plaintiffs that the same manufacturer had purchased the plaintiffs' machines. Tenterden, C. J., in summing up to the jury at Nisi Prius, said: "It is no doubt incumbent on the plaintiffs to show that their machine is new, but it is not necessary that they should have invented it from their own heads; it is sufficient that it should be new as to the general use and public exercise in this kingdom. If it were shown that the plaintiffs had borrowed from some one else, then, of course, their patent would fail. To show that the machine was not new, evidence is given that a model has been seen by three or four persons, and that the making of a similar machine was begun; but it appears to me, that the defendant has failed to prove that such a machine was generally known or generally used in England before the taking out of this patent by the plaintiffs." (4 C. & P. 55; 1 Web. P. C. 492; 1 Carp. P. C. 477.) On a motion, in the Court of King's Bench, for a new trial, Tenterden, C. J., said, that the evidence showed "that until the plaintiffs' invention came out, no machine was publicly known or used here for shearing from list to list. I told the jury that if it could be shown that the plaintiffs had seen the model or specification that might answer the claim of the invention, but there was no evidence of that kind, and I left it to them to say whether it had been in public use and operation before the granting of the patent." (10 B. & C. 26; 4 C. & P. 57; 5 M. & R. 69; 1 Web. P. C. 496; 1 Carp. P. C. 478).

JONES v. PEARCE. N. P. [1832] See 171.

128. MINTER v. MOWER. N. P. [1835]

Action for the infringement of a patent which claimed "the application of a self-adjusting leverage to the back or seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair, as above described." It was proved in evidence that a chair had been made by a person of the name of Brown before the date of the patent, which would have acted by a self-adjusting leverage if it

had not been encumbered by bad machinery. Lord Denman, C. J., said: “. . . I cannot conceive it would be very strong, even if he (Brown) had said he had discovered this principle of the self-adjusting leverage, when it does not appear he claimed it, took out any patent for it, or that his master did, or that there was any production of the article that could be beneficial to himself or Mr. Mower. It seems that is a very strong argument to show that in point of fact they had not made the discovery, at least how to make this principle available for general use.” (1 *Web. P. C.* 139.) “It seems to me, if that principle (self-adjustment) might have been deduced from the machinery of the chair that was made, but that it was so encumbered and connected with other machinery that nobody did make that discovery or even found out that they could have a chair with a self-adjusting leverage, by reason of that or any other defect in the chair actually made; I confess it seems to me that does not prevent this from being a new invention, when the plaintiff says, I have discovered, throwing aside everything but this self-adjusting leverage itself, that will produce an effect, which I think a very beneficial one.” (*Ib.* 140.)

129. CORNISH v. KEENE. N. P. [1835]

Tindal, C. J., said: “The main question is, whether the principal subject of the patent was or was not in use in England at the time of granting these letters patent. Was it or was it not, in the language of the act of parliament, such a manufacture (which has a very wide and extended meaning—you may call it almost invention), was it or was it not such an invention, at the time of making the letters patent, as was current in use. If (the invention) was at the time these letters patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly, so that any other person might have the means of acquiring the knowledge of it, as well as this person who obtained the patent, then the letters patent are void; on the other hand, if it were not known and used at the time in England, then, as far as this question is concerned, the letters patent will stand. . . . A man may make experiments in his own closet for the purpose of

improving any art or manufacture in public use ; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person, who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years ; and it will be no answer to him to say that another person before him made the same experiments, and, therefore, that he was not the first discoverer of it, because there may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent, and enjoy its benefits. That would be an extreme case on one side ; but, if the evidence that is brought in any case, when properly considered, classes itself under the description of experiment only, and unsuccessful experiment, that would be no answer to the validity of the patent. On the other hand, the use of an article may be so general as to be almost universal. In a case like that, you can hardly suppose that any one would incur the expense and trouble of taking out a patent. That would be a case where all mankind would say, ‘ You have no right to step in and take that which is in almost universal use, for that is, in fact, to create a monopoly to yourself in this article, without either giving the benefit to the world of the new discovery, or the personal right to the value of the patent, to which you would be entitled from your ingenuity, and from your application.’ Therefore, it must be between those two (if I may so call it) limits that cases will range themselves in evidence, and it must be for a jury to say, whether, supposing those points to be out of the question, in any particular case, evidence which has been brought before them convinces them to their understandings that the subject of the patent was in public use and operation at that time—at the time when the patent itself was granted by the Crown. If it was in public use and operation, then the patent is a void patent, and amounts to a monopoly, if it was not, the patent stands good.” (1 *Web. P. C.* 508.)

130. MORGAN v. SEAWARD. [1837]

Patent for "certain improvements in steam-engines, and in machinery for propelling vessels." The invention patented consisted (*inter alia*) in an improvement on paddle-wheels for propelling vessels, whereby the float-boards or paddles are made to enter and come out of the water in positions the best adapted for giving full effect to the power applied. It was proved at the trial that, before the date of the patent, Galloway, the patentee, ordered an engineer, under an injunction of secrecy, to make two pairs of paddle-wheels upon the principle of the patent. The wheels when completed were packed at the engineer's factory, and sold to, and exported by, the plaintiff, who was the assignee of the patent, and the managing director of a foreign company, by whom the paddle-wheels were used *abroad*. The plaintiff paid the engineer for the wheels. The question before the court was, whether the invention, at the date of the patent, was new in the legal sense of that word. Parke, B., delivering the judgment of the court, said:—"The words of the statute are, that grants are to be good 'of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others, at the time of the making of such letters patent and grants, did not use;' and the proviso in the patent in question, founded on the statute, is, that if the invention be not a new invention as to the public use and exercise thereof in England, the patent should be void. The word 'manufacture' in the statute must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself or any other person; nor indeed any use of the machine in a foreign country before the date of the patent. If the word 'manufacture' be construed to be the mode of constructing the machine, there has been no use or exercise of it in England in any sense which can be called public." (2 *M. & W.* 544; 1 *Web. P. C.* 187; *H. & M.* 55; 1 *Jur.* 527.)

GIBSON v. BRAND. N. P. [1841] See 235.

131. CARPENTER v. SMITH. [1842]

Action for the infringement of a patent for certain improvements in locks. It was proved that a lock, substantially the same as the plaintiff's, had been put upon a gate in a public place, and used by Mr. Davies for many years before the date of the patent. At Nisi Prius, Abinger, C. B., said: "I think what is meant by 'public use and exercise,' as has been held by my predecessors before (and I think one's own common sense leads one to adopt that definition), is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions, and apply them." (1 *Web. P. C.* 534.) The defendant subsequently moved for a new trial, on the ground of misdirection. The court, however, refused even a rule *nisi*, and held, that "the public use and exercise of an invention, means a use and exercise in public, not by the public." Alderson, B., during the course of the argument, held, that to invalidate a patent a prior public user need not continue up to the time of the taking out of the patent. (9 *M. & W.* 300; 1 *Web. P. C.* 540.)

132. WALTON v. BATEMAN. N. P. [1842]

Cresswell, J., said to the jury: "With respect to this not being a new invention, the nature of that objection is distinct and clear upon the face of it. It involves two questions for your consideration. First, was any article made before, answering the purposes and having the properties of that, which the plaintiff has made and claims as the patent? (1 *Web. P. C.* 616.) . . . Then even supposing that that article did embody the principle of the plaintiff's, so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be, whether that user is not to be considered rather in the nature

of an experiment than of any public use of the article, so as to deprive the plaintiff of the fruit of this discovery in respect of this manufacture." (*Ib.* 619.)

133. THE HOUSEHILL COMPANY v. NEILSON. H. L. [1843]

Lord Lyndhurst, L. C., said: "If it is proved distinctly that a machine of the same kind was in existence, and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary that it should come down to the time when the patent was granted. If it was discontinued, still that is sufficient evidence in support of the prior use so as to invalidate the letters patent. (1 *Web. P. C.* 709) If it is discontinued, provided it has been once in public use, and the recollection of it has not been altogether lost, if it has once been publicly used, it will be sufficient to invalidate the letters patent, although the use may be discontinued at the time when the letters patent were granted. I apprehend that is the law, and the known law upon the subject in this country. I never heard it before questioned, that the notorious public use of the invention before the granting of the letters patent, though it may have been discontinued, is sufficient to invalidate the letters patent. (*Ib.* 710.) It must not be understood that your lordships, in the judgment you are about to pronounce, have given any decision upon this state of facts, namely, if an invention had been formerly used and abandoned many years ago, and the whole thing had been lost sight of. That is a state of facts not now before us. Therefore, it must not be understood that we have pronounced any opinion whatever upon that state of things. It is possible that an invention may have existed fifty years ago, and may have been entirely lost sight of, and not known to the public. What the effect of this state of things might be it is not necessary for us to pronounce upon." (*Ib.* 717.)

134. STEAD v. WILLIAMS. N. P. [1843]

Action for the infringement of a patent "for making or paving public streets and highways, and public and private roads, courts and bridges with timber or wooden blocks." The

defendants proved that the porch of a private dwelling-house had been paved, prior to the date of the patent, in a manner similar to that described in the plaintiff's specification. Cresswell, J., told the jury that, if they thought this paving was essentially the same as that described in the plaintiff's specification, the patent would be, in point of law, invalid. "It was intended to be public, not to be made a matter of merchandise certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and continued to be used down to the time in question. Therefore, if you think that is the same thing in substance as that which the plaintiff claims, I think that it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference." (2 *Web. P. C.* 136.)

135. STEAD v. ANDERSON. N. P. [1846]

In this case, the facts, as regards user, were the same as in the case of *Stead v. Williams*. (See 134). Parke, B., in directing the jury, said: "As to the alleged user, the only question is, that a similar pavement had previously been laid down at Sir W. Worsley's. . . . If the mode of forming and laying the blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been a sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access." (2 *Web. P. C.* 149.)

136. HANCOCK v. SOMERVELL. N. P. [1851]

In directing the jury upon the issue of novelty, Williams, J., said: "The defendants say that the invention had been substantially published and was in use, not in secret use, but in public use in England before the date of the patent; and, if that is so, it would entitle the defendants no doubt to a verdict upon these novelty issues. Upon that part of the case the view that it seems to me ought to be taken by you is this: you will first consider whether the material was before the public,—it is not necessary it should be used by the public—if it is in public use, not in secret use. . . . If you should be of opinion the

material was so before the public, in public use, before the date of the patent, then the question would be this: it is said on behalf of the plaintiff—first of all denying that there is any evidence of the material having been at all in public use before the date of the patent, that even if it were so, that although the material was before the public, yet the invention was not—that the invention required to be discovered. On the other hand, on the part of the defendant, what is said is this: that the material being in public use, the ready means of the invention were also necessarily before the public; because it is said that the article presented in itself such means of knowledge to the public as to enable any one of ordinary competence to re-produce the article. And if you should come to the conclusion upon the facts that the material was in use before the date of the patent, then the question resolves itself into this: What is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that, notwithstanding it was so, the invention remained still a matter to be discovered, why then, in my opinion, the plaintiff's case would not be affected by the circumstance of the material being in public use. But if, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it necessary the use should be actually for sale; if it were in public use, it need not be sold,—it would be sufficient, for instance, if it were in use, handed about the country for the purpose of attracting customers); if you should think also that, the material being so in use, it was so palpable how you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it—if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have just been describing to you." (*Newton's London Journal*, vol. 39, p. 158.)

137. HEATH v. SMITH. [1854]

Action for the infringement of a patent for certain improvements in the manufacture of iron and steel. The defendant pleaded (*inter alia*) that the invention was not new, but had

been publicly and generally used in England before the date of the patent. It was proved at the trial that, before the date of the patent, five persons had used the process independently, three of them without concealment, and that all five had publicly and generally sold, for their own profit, the article thereby produced. Held, that, upon this evidence, the plea was proved. Lord Campbell, C. J., in the course of his judgment, said: "It is said that, according to judicial determinations, the user must be public. If we are to make this addition to the statute (21 *Jac.* 1, c. 3, s. 6), has there not been a public user within the meaning of the words? Can a patent be granted for a manufacture which other people have used, not indeed in the market-place, but without any concealment whatever? If this user without concealment does not constitute a public use, what does?" Erle, J., said: "If one party only had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." (3 *Ell. & Bl.* 256; 2 *Web. P. C.* 268; 2 *C. L. R.* 1584; 18 *Jur.* 601; 23 *L. J., Q. B.* 167.)

138. RE ADAMSON'S PATENT. Ch. [1856]

Adamson, whilst engaged in carrying into effect a contract for the erection of a pier, invented certain machinery, which he used on the works for several months before applying for a patent, during which time it was open to the inspection of the public. Held, that the invention had been dedicated to the public, and that he was not entitled to the patent. Lord Chancellor Cranworth, in his judgment, said: "In this case the petitioner, by his own showing, had publicly used the invention for four months, not for the purpose of testing it by experiments, but in carrying out a contract in which he was engaged, before he took any steps to obtain a patent for it. . . If the stage (the subject of the patent) had been raised simply for the purpose of testing the invention, though the inventor had been obliged to let it be seen by the public, the publicity so given to it would have formed no objection to the granting of the patent." (6 *De G. M. & G.* 420; 25 *L. J., Ch.* 456.)

139. BETTS *v.* MENZIES. [1858]

Action for the infringement of a patent for making capsules. It was proved that between the time of the application for, and the issuing of the letters patent, the plaintiff manufactured a quantity of the capsules, in the making of which he had discovered improvements. They were made by his own workmen, and were not sold before the patent was granted. The defendant having obtained a rule to set aside the verdict, it was held, that the manufacture of capsules by the plaintiff, prior to the grant, did not invalidate the patent. (1 *Ell. & Ell.* 990; 28 *L. J., Q. B.* 361; 5 *Jur., N. S.* 1164.) Lord Campbell, C. J., delivering judgment upon the point, said: "Under these circumstances," referring to the facts proved at the trial, "I am of opinion that the manufacturing of the capsules according to the new invention would not invalidate the patent. I quite agree that if you look at the section of the Statute of Monopolies which has been referred to (sect. 6), it abolishes monopolies altogether, and that there was no power in the Crown, after that statute passed, to grant monopolies, except with the conditions that are imposed by the reservation; but the reservation which must be relied upon here is this, 'which *others* at the time shall not use.' Now, others had not used this before the patent was granted. It was used only by the inventor, the patentee himself, and the use of it by the servants and mechanics whom he employed must be considered to have been his use, and therefore it was not used by others. But still, if it could be shown that the effect was really to extend the time of the monopoly, that would be fatal. But the defendant has entirely failed in showing that, because any person might have used this manufacture lawfully, until the patent was sealed, and the fourteen years had begun to run, there was a period of more than fourteen years, during which the monopoly existed. That period was not in the slightest degree exceeded, and no inconvenience or grievance is caused to any one individual nor to the country, by saying that this manufacture of the capsules according to the new process before the patent was sealed, shall not invalidate the patent." (1 *Ell. & Ell.* 990; 28 *L. J., Q. B.* 365; 5 *Jur., N. S.* 1065.)

140. HARWARD *v.* THE GREAT NORTHERN RAILWAY COMPANY. H. L. [1860—1865]

The plaintiffs were the executors of Wild, to whom a patent had been granted for "improvements in fishes and fish joints for connecting the rails of railways." The fishes were made of iron, with a groove on the outer surface, for the purpose of preventing the square heads of the bolts, passing through them and the rail, from turning round, and also for the purpose of procuring greater strength with an equal weight of metal than could have been obtained from a fish of the same thickness throughout. Before these letters patent had been granted, grooved iron plates, with bolts let into the groove, had been used for the purpose of fastening timbers placed vertically upon one another, or placed horizontally side by side. In one case of a bridge, a channelled plate with bolts had been used for the purpose of fishing a scarf joint where the ends of two timbers met together, but it had not been used with the view either of fixing the heads of the bolts, or with the view of obtaining greater strength with an equal weight of metal. The Court of Queen's Bench held, that this was not a prior use which would invalidate the patent. (29 *L. J.*, *Q. B.* 193; 6 *Jur.*, *N. S.* 993.) Cockburn, C. J., thus expressed himself upon this point: "Now the question is, whether the accidental use of a particular piece of machinery, forming part of, or the whole of, the mechanical contrivance, which may be applied afterwards to some ulterior purpose, without any intention of producing the result, is such an anticipation—such a user—of the invention, as shall prevent a patent. I entirely concur with what was thrown out in the course of the argument by my brother Blackburn—that it turns upon what is the meaning of the language to be found in the Statute of Monopolies; that a man shall not have a patent for that which others do use at the time he takes out his patent. What is the meaning of that? Surely it must be construed to mean, what others have invented and used for the purpose for which the man who afterwards comes forward as the inventor, and claims to have a patent, and obtains a patent, intends to use it." (29 *L. J.*, *Q. B.* 199.) Blackburn, J., in the course of his judgment, said: "I think

that when we go back to the Statute of Monopolies, and take the words of the section, we find that the prohibition is not to extend to the 'making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures which others at the time of making such letters patent and grants shall not use.' The word 'manufacture' has been frequently considered, and it extends not only to principles that may be supposed to be patented, but to the modes of applying those principles, in practical use, in the result. I do not repeat the cases which my brother Hill has already cited; but that is the sort of manufacture. But when you look at the 'use,' it must be that kind of use which a man has when he uses a manufacture. I cannot think that a man can use a manufacture in the sense in which the words must be understood in this act, and as they would be understood by any man using them, because accidentally, and without in the least degree intending it, he does that thing which, if it were habitually done on purpose, and for the purpose of trade, would be a manufacture. I cannot think there is a use, either public or private, in that sense, unless there be some knowledge and some intention. . . . I would not be understood to say, that I think it is at all essential for the public use of a manufacture that a man who really uses it intending to use it, should, at the time, have full knowledge of all the advantages that will arise from the user. I can easily imagine many cases in which he might use the thing as a manufacture, although there were many incidental advantages which he was not aware of, and that user might prevent another person from taking out another patent for those incidental advantages afterwards." (29 *L. J.*, *Q. B.* 202.) On appeal to the *Exchequer Chamber* it was held, that the patent was bad, as, even without reference to the case of the bridge, the use of grooves in pieces of iron for holding materials together by means of bolts and nuts, had been given to the world, together with all its advantages, before the date of the patent in question. Willes, J., who delivered the judgment of the court, said: "We by no means say that prior use of an invention is to be of no avail because the principle upon which it acts was either unknown or misapprehended." (31 *L. J.*,

Q. B. 198; 8 *Jur., N. S.* 1126.) This judgment was affirmed in the House of Lords, upon the general question of prior use, without reference to the special point raised by the judgments of the judges in the Court of Queen's Bench. (11 *H. L. Cas.* 654; 35 *L. J., Q. B.* 27; 12 *L. T. Rep., N. S.* 771.)

141. BETTS v. NEILSON: BETTS v. DE VITRE. Ch. [1868]

In order to establish the prior public use of a patented article, so as to invalidate the patent, it is not necessary to show that the article had been manufactured for sale. (*L. Rep.*, 3 Ch. 429; 37 *L. J., Eq.* 321; 18 *L. T. Rep., N. S.* 165.)

Secret Use.

DOLLOND'S PATENT. [1758] See 226.

142. TENNANT'S CASE. [1802]

Action for the infringement of a patent for a method of making a bleaching liquor. The general ignorance of bleachers with respect to such bleaching liquor, until after the date of the plaintiff's patent, was proved. On the part of the defendant it was established, that a bleacher had used the same means of preparing his bleaching liquor for five or six years anterior to the date of the plaintiff's patent, but that he had kept his method a secret from all but his two partners, and two servants employed in preparing it; and a chemist at Glasgow deposed, that he had suggested to the plaintiff a material part of the method which formed the subject of the patent. Ellenborough, C. J., nonsuited the plaintiff on two grounds—first, that the process had been used five or six years prior to the date of the patent; and secondly, that the plaintiff was not the inventor of an indispensable part of the process. (Cit. *Dav. P. C.* 429; 1 *Web. P. C.* 125; 1 *Carp. P. C.* 177.)

HILL v. THOMPSON. [1818] See 110.

CORNISH v. KEENE. [1835] N. P. See 129.

143. BENTLEY v. FLEMING. N. P. [1844]

If the inventor of a machine lend it to another in order to have its qualities tested, and that other use it for some weeks in a public workroom ; this is not giving the invention such publicity as to deprive the inventor of his right to obtain letters patent for it. (1 *C. & K.* 587.)

HEATH v. SMITH. [1854] See **137**, per Erle, J.

144. SMITH v. DAVIDSON. [1857]

Action for infringement. The jury found that the improvements used by the defenders, the same as those independently invented and patented by the pursuer, were invented by the defender Davidson before Nov. 14th, 1853, the date of the pursuer's provisional specification. That Davidson did not use his invention for the purposes of his trade before Nov. 14th, 1853 ; but that the machine invented by him was capable of being so used before that date. That Davidson used his invention for the purposes of his trade between November 14th, 1853, and February 1st, 1854.

Held, that neither the secret user before November 14th, nor the public user after, invalidated the pursuer's patent. The Lord President said : " In order to invalidate letters patent on the ground of previous use, it is necessary not only that the use shall have been prior to the date of the letters patent, but that it should be a public and not a secret use. Accordingly, in this case, the issue puts the question, ' Whether improvements substantially the same as those mentioned in the letters patent and specification, were known and used within the United Kingdom prior to the date of the said letters patent ? ' Now, ' known and used ' means known to the public, and openly used. The jury have by their verdict fixed the nature and extent of the use. They find that, prior to 14th November, 1853, the machine invented by Davidson was capable of being used for the purposes of his trade, but was not so used until after that date, and they have not found that it was used for any other purpose before that date, nor does it appear that it had been published or made known before that time. Indeed it appears from the evidence that Davidson at that time contemplated

applying for a patent, and, consistently with that, he could not do otherwise than avoid publication of his invention. His experiments were over, and the invention was complete and ready for publication and to be put in use, but it was not so published or used. In these circumstances, it cannot be held that, prior to the 14th November, the improvements patented by the pursuer were 'known and used' in the sense of the issue, or in any sense which could be held as invalidating the letters patent." (19 *C. S.* 691.)

145. HILLS v. LONDON GASLIGHT COMPANY. N. P. [1860]

Bramwell, B., at the trial at Nisi Prius, said to the jury: "If a person has invented anything which is the subject of a patent and has kept it to himself, or communicated it privately to one or two, in fact, has not made it public knowledge, if anyone else discovers that invention, it is new, that is to say, new in the sense that the first invention has not been published." And again: "If a man practises his invention privately, or by way of experiment only, such a practising would not be a publication of the invention, so as to prevent a person subsequently finding it out from being the inventor of new matter, the subject of a patent." (5 *H. & N.* 336.)

146. POUPARD v. FARDELL. Ch. [1869]

A patent for improvements will not be bad on the ground of prior user, though the use of an article of the same kind be proved, with appendages exactly answering the words of the specification, if the appendages to the article previously used had a different object to that of the patented improvements, and did not produce the same effects. (18 *W. R.* 127.)

Publication in a Book or Specification.

147. R. v. ARKWRIGHT. *Scire facias.* [1785]

Buller, J., said: "It is admitted that (this) is not a new discovery, for Emmerson's book was produced, which was printed a third time in 1773, and that is precisely the same as this. (1 *Web. P. C.* 72.)

HUDDARD *v.* GRIMSHAW. N. P. [1803] See 107.

148. HILL *v.* THOMPSON. [1818]

Held, that a book printed and published, prior to the grant of the patent, which in substance informed the public of what the specification of the patent professed to inform them, completely negatived the novelty of the alleged invention. (2 *B. Mo.* 424; 8 *Taunt.* 375; 1 *Web. P. C.* 239.)

149. CORNISH *v.* KEENE. [1835]

The defendants put in evidence the specification of a prior patent obtained by the plaintiff, which, the defendants alleged, described the invention for which the patent in question was granted. Tindal, C. J., in addressing the jury, said: "Undoubtedly, if you could show under the hand of the plaintiff, or anybody's hand, that the secret had been publicly communicated to the world which was intended to be covered by the subsequent patent, there is an end of that patent; if the world at large had been informed by the specification of the colour, fabric and manufacture, which is intended to be effected by the subsequent patent, the subsequent patent must fall to the ground, otherwise a man would have nothing to do but to take out patent after patent when the former has nearly expired, and so afterwards procure to himself an unlimited privilege." (1 *Web. P. C.* 510.) On a motion for a new trial in the Court of Common Pleas it was held, that a patent will not be set aside for want of novelty by proof that *after* the date of the patent, although *before* the date of the *specification*, the invention was described or mentioned in the specification of some prior patent. (3 *Bing. N. C.* 570; 4 *Scott*, 337; 2 *Hodg.* 281; 1 *Web. P. C.* 512; 2 *Carp. P. C.* 371.)

150. HEURTILOUP'S PATENT. [1836]

It would seem that the deposit of a foreign work in the British Museum, which work contained the specification of a French patent for an invention, in great part the same as that for which a patent had subsequently been obtained in England, was sufficient to vitiate the latter patent on the ground of want of novelty. (1 *Web. P. C.* 553.)

151. MORGAN v. SEAWARD. [1837]

Alderson, B., referring to the case of Dollond's patent, cited in *Boulton v. Bull*, said: "If Dr. Hall had published his discoveries in a book, I apprehend that would have put an end to Dollond's patent." (2 *M. & W.* 554; 1 *Web. P. C.* 190.)

152. THE HOUSEHILL COMPANY v. NEILSON. H. L. [1843]

Lord Lyndhurst said: "If the machine is published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed works, without reference to what has been done."

Lord Brougham: "It negatives being the true and first inventor, which is as good as negating the non-user. The book that is generally referred to is, the 'Repertory of Arts and Sciences.' It must not be a foreign book, but published in England." (1 *Web. P. C.* 718 *n.*)

153. JONES v. BERGER. [1843]

Maule, J.: "I think it is an objection to the patent, and not evidence simply of an objection, that there has been a previous patent and a specification enrolled, and therefore published being enrolled, containing the invention." (1 *Web. P. C.* 550; 6 *Scott, N. R.* 219.)

154. MUNTZ v. FOSTER. Ch. [1843]

The novelty of a patent is not impeached by a similar process, described in a previous specification, which will not, when carried out, produce the patented article. (2 *Web. P. C.* 94.)

155. MUNTZ v. FOSTER. N. P. [1844]

If a patentee has had his mind furnished with the material of his invention by a prior specification, and has merely put it into a *more detailed shape*, it would neither be a new invention, nor would he be the first and true inventor. (2 *Web. P. C.* 107.)

156. STEAD v. WILLIAMS. [1844]

Action for the infringement of a patent granted to the plaintiff

for "making or paving public streets and highways, and public and private roads, courts and bridges, with timber or wooden blocks." Cresswell, J., in summing up to the jury, said: "If you should be of opinion that the plaintiff in this case was not the inventor of this mode of wood paving within this country, he is not entitled to a verdict upon that issue. If he derived the information from a foreign country, that would leave him still the true inventor within this country, provided he did not derive his information from any person here. But if he derived the information which he has given to the public, either from books or from oral communication in this country, then he is not the true inventor, and is not entitled to the patent. . . . But then the defendants do not bring home to the plaintiff the fact of his having seen any of those publications (publications put in evidence by the defendants, and said to disclose the plaintiff's invention); and it is for you to judge, upon the whole of the matter, whether you think that he had seen these publications, and had derived his information from the stock of knowledge previously given to the public of this country, or whether he derived it from some persons residing abroad, and, therefore, having a source of information which is considered as equivalent to his own invention. It does not deprive a person of a right to a patent, that another person has the same thing in his head, even supposing he has heard it at the same time, providing he himself is an inventor; but if he is not an inventor, but a mere operative, carrying out that invention which another has published, then he is not entitled to the patent. Now, upon that subject, upon this part of the case, I must draw your attention to these communications, and you will have two questions to deliberate upon respecting them:—first, whether they came to the knowledge of the plaintiff; secondly, if they did, whether they disclosed that for which he claims a patent; for although he may have read those, if they do not disclose that which is the essential part of his patent, then it does not invade at all his privilege of having a patent right." Verdict for the plaintiff. (2 *Web. P. C.* 130.) A rule was subsequently obtained, and made absolute, for a new trial, on the ground of misdirection. The defendant's counsel contended that the mere fact of a prior publication is conclusive against the validity of

the patent, though the patentee might have no knowledge of the existence of such prior publication. The Court of Common Pleas held that, "If the invention has already been made public in England, by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository, where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia, or other work in general circulation. The question will be, whether upon the whole evidence there has been such a publication as to make the description a part of the public stock of information." (8 *Scott, N. R.* 472; 7 *M. & Gr.* 842; 2 *Web. P. C.* 142; 8 *Jur.* 933; 13 *L. J., C. P.* 220.)

157. STEAD v. ANDERSON. [1847]

The first person who discloses an invention to the public is considered as the inventor. A knowledge and publication after the plaintiff's invention does not avoid a patent granted to the true and first inventor, who, having invented, obtained his patent before his invention was used. (16 *L. J., C. P.* 250; 2 *Web. P. C.* 151.)

158. DUBBS v. PENN. [1849]

A patent granted to A. for "improvements in the construction of racks and pulleys for window-blinds and other useful purposes," besides claiming a mode of making the frames, by constructing them in a particular manner of drawn open metal tubes, claimed a mode of fixing the pulley in the frame, by turning the knob of the spindle, upon which the pulley revolved, and thereby of screwing a piece of metal, made to slide within the frame, tight to the edge of the frame; by which means the

pulley spindle became firmly fixed to the frame. By a patent previously granted to B., the same object was effected by a similar method, but with the addition merely of a piece of thin metal, called an escutcheon, which worked outside the frame; but the specification stated, that the pulleys might be made without the escutcheon. Held, that the two patents were substantially the same as to one of the things claimed, and therefore that A.'s patent was void. (3 *Exch.* 427.)

159. IN RE LAMENAUDE'S PATENT. [1850]

Lord Brougham: "You may have a patent as the importer of a foreign invention, because that is the construction that the courts have put upon the statute that you are the *quasi* inventor, if you import it for the first time. But has it ever been said that such importation of a foreign invention is negatived by a book in this country stating the foreign invention? I am not aware that it has been held to negative the right of an importer of a foreign invention that a book had stated it before." (2 *Web. P. C.* 169.)

160. R. v. STEINER. *Scire facias*. [1851]

Lord Campbell, C. J., told the jury that if the improvement for which the patent was granted was contained in the specification of a prior patent, or was described in a book, published abroad but sold in England, the patent would be void. (40 *Newton's London Journal*, 71.)

161. BETTS v. MENZIES. Ch. [1857]

Sir W. P. Wood, V.-C., said: "I conceive that the law is, that where an ingenious person makes, for instance, an improvement in the glasses of a telescope, or the wheels of a carriage, for his own use, and which he uses accordingly, but without publishing it anywhere, or if, on the other hand, he publishes in a book his invention which he has so made and used for his own private accommodation, much more when he takes out a patent for it, there can be no case for a subsequent patentee. . . . I think that if a man sits down and takes out a patent from his own conjectures, without ever having tried the experiment set

forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless." (3 *Jur.*, N. S. 358.)

162. BETTS v. MENZIES. H. L. [1858—1862]

At the trial of an action for the infringement of a patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes," the defendant contended that the process which the plaintiff claimed as his invention was not new, as it had been discovered by one Dobbs, and by him disclosed to the world by two specifications, one of the date of 1804, and the other of 1820. Campbell, C. J., in summing up to the jury, said: "I ask you whether you think that a person of ordinary skill, reading Dobbs's specifications, and having no other information upon the subject, could at once proceed to make Betts's metal, not making experiments and getting out bit by bit, but whether it is stated enough to enable him at once to set down and make Betts's metal?" The Court of Queen's Bench held, that this was not the proper question to be left to the jury, for though a workman might not in that way be able to make Betts's metal, still Dobbs's specifications, or something done under them, might have disclosed some part of that which the plaintiff claimed. Rule absolute for a new trial. At the new trial a verdict was found for the plaintiff. The defendant having obtained a rule to set aside the verdict, it was held, that the plaintiff's patent was invalid, as it appeared, on a comparison of Betts's and Dobbs's specifications, that the former claimed that which had been already described by the latter. (1 *Ell. & Ell.* 990; 28 *L. J.*, Q. B. 361; 5 *Jur.*, N. S. 1164.)

On appeal to the Exchequer Chamber judgment affirmed; Williams and Willes, JJ., however, differed from the rest of the court, holding that the plaintiff's patent was good, and not invalidated by Dobbs's; since Dobbs's patent was practically incapable of being carried into effect. (1 *Ell. & Ell.* 1020; 30 *L. J.*, Q. B. 81; 6 *Jur.*, N. S. 1290.) On appeal to the House of Lords the patent was held good. Blackburn, J., in the course of his judgment, said: "It seems to me that, if Dobbs had made it part of the public knowledge how to produce

a new material, as a practical result, and Betts had afterwards claimed to have a patent for, amongst other things, producing that result, he would have claimed what was not new, but if Dobbs had not made it part of the public knowledge how to produce a result, then Betts would not have claimed anything already known." Pollock, C. B., said: "I now entirely agree with my brothers Williams and Willes in what they said in the Exchequer Chamber, that a patent and a specification which are worthless and produce nothing, cannot be considered as disclosing or anticipating anything, so as to be any impediment to a subsequent real practical discovery." Lord Chancellor Westbury, after stating the facts, said: "To defeat a new patent, it must be clear that the antecedent specification disclosed a practical mode of producing the result which was the object and effect of the subsequent discovery. A barren general description, therefore, though containing some suggestive information, or involving some speculative theory, could not be treated as avoiding, for want of novelty, a subsequent specification or invention, unless it was ascertained that the antecedent publication involved the same amount of useful information. As to the two specifications in this case, it was clear that the first was a mere general suggestion, the other a specific practical invention. The one might lead to the other; but the latter alone complied with the conditions under which protection was given by the patent law. Here there was nothing to show that Dobbs's patent was capable of a practical application; and on the principle contained in the answer of the judges, it was clear that the decision of the two courts below ought to be reversed. (10 *H. L. Cas.* 117; 31 *L. J., Q. B.* 233; 9 *Jur., N. S.* 29; 11 *W. R.* 1; 7 *L. T. Rep., N. S.* 110.)

163. *HILLS v. LONDON GASLIGHT COMPANY.* [1860]

The plaintiff in 1849 obtained a patent for the employment of the hydrated oxides of iron in purifying coal gas from sulphuretted hydrogen.

In 1840 one Croll took out a patent, in the specification of which, after speaking of the use of black oxide of magnesia for the purpose of removing the sulphuretted hydrogen, he said: "The same effect may be produced by the application of the

oxide of zinc, and the oxides of iron." The court construed this as a claim for the use of the hydrated and anhydrous oxides of iron. And, further, that as there are many oxides of iron, the hydrated and anhydrous, the natural and artificial, some of which will, and some will not answer the purpose, it is a matter of investigation and experiment to see which will. Upon this ground it was held that Croll had not anticipated the plaintiff. (5 *H. & N.* 312; 29 *L. J.*, *Ex.* 409.)

164. OXLEY v. HOLDEN. [1860]

A provisional specification was filed on the 17th of March, and afterwards abandoned by the inventor, who delivered another specification for the same invention on the 10th of April, in respect of which a patent was granted to him on the 12th of October, but dated as of the 10th of April. It was contended, that the filing by the plaintiff of the provisional specification of the 17th of March, and his afterwards allowing it to expire, was such a dedication to the public as prevented his obtaining a valid patent for the same invention on the subsequent application of the 10th of April. This objection was overruled, and Erle, C. J., in delivering the judgment of the Court of Common Pleas, said: "We are of opinion that a provisional specification abandoned does not become public by abandonment. The statute 15 & 16 Vict. c. 83, s. 29, authorizes the publication, but until that event it is not public. Furthermore, although the first provisional specification may afford an objection, either to receiving a second for the same invention, or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment making the patent void, if it is so granted; and, on the contrary, sect. 24 enacts, that the patent dated as of the day the provisional specification was delivered in shall be of the same force and validity as if it had been sealed on that day. This patent is dated as of the 10th of April; on that day the protection given under the specification of the 17th of March existed, and the patent is valid by the operation of this section." (30 *L. J.*, *C. P.* 68; 8 *Com. B. Rep.*, *N. S.* 666; 8 *W. R.* 626; 2 *J. T. Rep.*, *N. S.* 464.)

165. *HILLS v. EVANS.* Ch. [1862]

In giving judgment in this case, Lord Westbury, L. C., said: "The antecedent statement must (in order to invalidate a subsequent patent) be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments, and gaining further information before the invention can be made useful. . . . The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore, much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore, and the refined and pure metal which is extracted from it." (31 *L. J.*, Ch. 463; 8 *Jur.*, N. S. 529; 6 *L. T. Rep.*, N. S. 93.)

166. *LANG v. GISBORNE.* Ch. [1862]

An invention was described in a book published in France, copies of which were sent to England, to a bookseller, for sale. Held, that this was a publication of the invention. The Master of the Rolls, in the course of his judgment, said: "In my opinion there are two modes by which an invention may be made public. One is by such user as would alone make it a part of the stock of public information, and the other is by the simple fact of what in law is called 'a publication.' I am of opinion, that the true result of the cases is this:—that the observations to be found in them as to the circumstances which make an invention become a part of the stock of public information,

apply to those cases where somebody has used the invention, not for the purpose of experiment, but for the purpose of really making use of it as a complete invention. . . . A publication takes place when the inventor of any new discovery, either by himself or by his agents, makes a written description of it, and prints it in a book, and sends it to a bookseller's to be published in this country. I am of opinion that it is not at all necessary to establish the fact that one volume of that book has been sold, for I think that as soon as an inventor informs the public of what his invention consists, and prints it in a book, which he sends to a publisher to sell, from the moment that the book is exposed for sale in the bookseller's shop, there becomes, in point of law, a complete publication of the invention. . . . There is no difference between a foreign inventor and an English one, if, when the inventor is a foreigner, he publishes the book in a foreign language, and sends it over to a bookseller in this country for the purpose of being sold." (31 *Beav.* 135; 31 *L. J.*, *Ch.* 770; 8 *Jur.*, *N. S.* 736; 10 *W. R.* 639; 6 *L. T. Rep.*, *N. S.* 772.)

167. *YOUNG v. FERNIE.* Ch. [1864]

Inventions in mechanics are as totally different from inventions in economical chemistry, as the laws and operations of mechanical powers differ from the laws of chemical affinities, and the result of analysis in the comparatively infant science of chemistry, with its boundless field of undiscovered laws and substances. Where, therefore, prior to the date of an inventor's patent, something necessary for the useful application of a chemical discovery, for manufacturing purposes, remained to be discovered, which the plaintiff's invention supplied, held, that the manufacture, with the materials and process in the specification, was a "new manufacture not in use" at the date of the patent. (4 *Giff.* 577; 10 *Jur.*, *N. S.* 926; 12 *W. R.* 901; 10 *L. T. Rep.*, *N. S.* 861.)

168. *BETTS v. NEILSON.* *BETTS v. DE VITRE.* Ch. [1868]

The specification of a patent may describe the process to be adopted so insufficiently as to invalidate the patent, and yet

disclose enough to show that what is claimed by a subsequent patent is not new. A prior publication will not invalidate a patent, unless it has imparted information so as to enable anyone working upon it to reckon with confidence on the result. (*L. R.*, 3 *Ch.* 429; 37 *L. J.*, *Eq.* 321; 18 *L. T. Rep.*, *N. S.* 165.)

169. NEILSON v. BETTS. H. L. [1871]

Per Lord Colonsay:—It is not enough that there has been, in a former patent, a general disclosure of the object to be attained, unless there is a specification clearly pointing out the mode of attaining it. (*L. R.*, 5 *H. L.* 2; 40 *L. J.*, *Eq.* 317; 19 *W. R.* 1121.)

Publication by Experiment.

170. BRAMAH v. HARDCASTLE. [1789]

The plaintiff had made two or three of his patent machines before the date of his patent, but it was admitted that circumstance would not of itself avoid the grant. (*Holroyd*, 81; 1 *Web. P. C.* 44, *n.*)

171. JONES v. PEARCE. N. P. [1832]

The plaintiff obtained a patent, dated 1826, for “an improved method of making carriage wheels.” The defendant proved that Mr. Strutt, in 1814, had wheels constructed upon the same principle as the patent, but differing from it in the details of construction. These wheels were used on a cart for a year, but subsequently getting out of order were laid aside. Patterson, J., referring to the novelty of the invention, said to the jury: “It is not necessary to show that it was actually in use at the moment of taking out the patent. The circumstance of ceasing to use it would not make it new. The question is, was there really an invention by Mr. Strutt in use, known to others? If you should think his was an abortive attempt, and a failure, or a mere experiment which did not answer, then it would not

invalidate the plaintiff's patent." (1 *Carp. P. C.* 529.) After summing up the evidence, his lordship continued: "But it is for you to say, if on the whole of this evidence, either on the one side or the other, it appeared this wheel constructed by Mr. Strutt's order in 1814, was a wheel on the same principles, and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that was used openly in public, so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent, undoubtedly then that would be a ground to say that the plaintiff's invention is not new, and if it is not new, of course his patent is bad, and he cannot recover in this action; but if, on the other hand, you are of opinion that Mr. Strutt's was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention, which came afterwards, was his own invention, and remedied the defects, if I may so say, although he knew nothing of Mr. Strutt's wheel, he remedied the defects of Mr. Strutt's wheel, then there is no reason for saying the plaintiff's patent is not good; it depends entirely upon what is your opinion upon the evidence with respect to that, because, supposing you are of opinion that it is a new invention of the plaintiff's, the patent is then good." (*Ib.* 530; 1 *Web. P. C.* 122.)

CORNISH *v.* KEENE. N. P. [1835] See 129.

172. GALLOWAY *v.* BLEADEN. N. P. [1839]

Tindal, C. J., thus laid down the law with regard to the novelty of an invention: "A mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments, that is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it, and having the benefit of it." (1 *Web. P. C.* 525.)

173. GIBSON v. BRAND. N. P. [1841]

Tindal, C. J.: "It would not be sufficient to destroy the patent to show, that learned persons in their studies had foreseen, or had found out this discovery, that is afterwards made public, or that a man in his private warehouse had by various experiments endeavoured to discover it and failed, and had given it up." (1 *Web. P. C.* 628.)

WALTON v. BATEMAN. N. P. [1842] See **132.**

174. THE HOUSEHILL COMPANY v. NEILSON. H. L. [1843]

Trials of an incomplete invention, by way of experiment, are not evidence of a prior use for the purpose of invalidating a patent. (9 *C. & F.* 788; 1 *Web. P. C.* 673.)

STEAD v. WILLIAMS. N. P. [1843] See **238.**

BENTLEY v. WILLIAMS. N. P. [1844] See **143.**

Re ADAMSON'S PATENT. Ch. [1856] See **138.**

175. *Re* NEWALL AND ELLIOT. [1858]

A necessary and unavoidable disclosure of an invention to others, if made in the course of mere experiments, is not such a publication as will avoid the subsequent grant of a patent, though the same disclosure, if made in the course of a profitable use of an invention *previously ascertained to be useful*, would be a publication; but an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, is not necessarily a publication, so as to constitute a gift of the invention to the world. (4 *C. B.*, *N. S.* 269; 4 *Jur.*, *N. S.* 562; 27 *L. J.*, *C. P.* 337.)

176. HILLS v. THE LONDON GASLIGHT COMPANY. [1860]

Action for the infringement of a patent, obtained in 1849, for the purification of coal gas by means of *hydrated* oxides of iron. In 1840, C. had obtained a patent for the purification of gas, and claimed the use of all oxides of iron for that purpose.

It was proved at the trial that the *hydrated* oxides alone would answer the purpose. In working for the purpose of completing the specification of his patent, C. had used oxides of iron for the purification of gas, and the gas purified by him to the extent of 20,000 feet a day, had for many days been mixed with the ordinary gas, and supplied to the public from the mains of a gas company. He had renovated the material by exposing it to heat on the top of some retort beds. The oxides were originally in a hydrated state, and the heat used by him while so working was not sufficient to render them anhydrous; but, not knowing the difference between hydrated and anhydrous oxides, and supposing that a better result would thereby be obtained, he directed in his specification that the material should be raised to a red heat, which would render the oxides anhydrous. The jury having found that what C. did was in the nature of an experiment, and was not a publication to the world, the court held that it did not invalidate the plaintiff's patent. Bramwell, B., in delivering the judgment of the court, said: "The word 'experiment' in the cases referred to has been used, not as the sole test upon a matter of this sort, but it has been used as indicating a class of practice. There is no particular virtue in the word 'experiment,' and it has been used for the purpose of showing that, if there has not been a user of an invention of a substantial character, but rather of an experimental character, or of a character analogous to an experiment, why then, although the thing has been done before, it does not preclude a person from taking out a patent for it; so that although what Croll did may not have been strictly in the nature of an experiment, being something more,—it may or may not have been so,—still the jury have so found it, and we cannot grant a new trial." (5 H. & N. 312; 29 L. J., Exch. 409.)

Publication by sale.

1777. WOOD v. ZIMMER. N. P. [1815]

Gibbs, C. J.: "The public sale of that, which is afterwards made the subject of a patent, though sold by the inventor only,

made the patent void." (1 *Holt, N. P. C.* 60; 1 *Web. P. C.* 44; 1 *Carp. P. C.* 294.)

178. MORGAN v. SEAWARD. [1835]

Parke, B. said: "It must be admitted, that if the patentee himself had, before his patent, constructed machines for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood v. Zimmer*, and appears to be founded on reason. For if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have practically a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference; nor that a single instance of such a sale as an article of commerce, to anyone who chose to buy, might not be deemed the commencement of such a practice, and a public use of the invention, so as to defeat the patent." (2 *M. & W.* 559; 1 *Jur.* 528; 1 *Web. P. C.* 194.)

179. LOSH v. HAGUE. N. P. [1838]

The publicly making and selling an article to one individual, though there be no demand or use for it by the public, will vitiate a subsequent patent. (1 *Web. P. C.* 205.)

180. GIBSON v. BRAND. [1841]

Tindal, C. J., said: "If you perceive on the evidence, that the thing which is now sought to be protected by the patent has been used, and for a considerable period, and used so far to the benefit of the public as to be sold to anybody that thought proper to purchase it of those who made it, then it becomes a material question, whether such mode of user is not in your judgment a public using of the article, of the process, or of the invention, before the letters patent were granted." (1 *Web. P. C.* 628.)

181. CARPENTER v. SMITH. N. P. [1841]

Action for the infringement of a patent for certain improvements in locks. It was proved that seven and a half dozen of the locks had been manufactured before the date of the patent, and exported to America. Abinger, C. B., said: "Here you have an article, manufactured by an English manufacturer, and sold, and, in my opinion, if it was sold even for the assumed purpose of being sent to America, I cannot but think that that would be destructive of the novelty of the plaintiff's invention. And here let me be clearly understood; I do not mean to say, that if a man in America employs an agent to see if he can get an article manufactured in England by a particular model, and chooses to take out a patent for it himself, but not with a view of making it public at all, I do not mean to say that that man is to be considered as not entitled to the invention afterwards, because he employs a workman to assist him in it, or, that if he had failed entirely, that some other man might make the invention in England; but where a model is sent to a workman, who sells seven and a half dozen, and sells them for a certain price, I must say I think the invention was used and publicly exercised." (1 *Web. P. C.* 536.)

182. HANCOCK v. SOMERVELL. N. P. [1851]

An invention may come into public use by being handed about the country for the purpose of attracting customers, although no actual sale has taken place. (*New. Lon. Jour.*, vol. 39, p. 158.)

183. MULLINS v. HART. N. P. [1852]

The prior deposit of articles, of novel manufacture, in a warehouse for sale, although no sale takes place, is a sufficient publication to defeat a patentee's claim to novelty in the invention of similar articles. (3 *Car. & K.* 297.)

HEATH v. SMITH. [1854] See 137.

184. HONIBALL v. BLOOMER. N. P. [1854]

If an article, subsequently patented, be, even in a single

instance, sold in the regular way of business, although it turns out a failure, the patent cannot be supported. (2 *Web. P. C.* 200.)

185. OXLEY v. HOLDEN. [1860]

The manufacture of a patent article for the purpose of sale, and offering it for sale, although no sale is actually effected, is a user of the invention. And *semble*, per Byles, J., that it is equally a user, though the article is made merely as a sample. (8 *C. B., N. S.* 666.)

HILLS v. THE LONDON GASLIGHT CO. [1860] See **176.**

BETTS v. NEILSON: BETTS v. DE VITRE. Ch. [1868] See **141.**

Question for the Jury.

BRAMAH v. HARDCASTLE. N. P. [1789] See **118.**

186. CORNISH v. KEEN. [1837]

Tindal, C. J., in delivering the judgment of the Court, said: "The question raised for the jury was this: whether the various instances brought forward by the defendants amounted to proof that before or at the time of taking out the patent, the manufacture was in public use in England; or whether it fell short of that point, and proved only that experiments had been made in various quarters and had been afterwards abandoned? This question is, from its nature, one of considerable delicacy; a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury." (1 *Web. P. C.* 519; 2 *Hodg.* 294; 3 *Bing. N. C.* 588.)

187. ELLIOTT v. ASTON. N. P. [1840]

The question of public use is for the jury; as, whether the instances adduced show a manufacture to have been in public use. (1 *Web. P. C.* 222.)

WALTON *v.* BATEMAN. N. P. [1842] See 132.

STEAD *v.* WILLIAMS. N. P. [1843] See 134.

188. MUNTZ *v.* FOSTER. N. P. [1844]

It is for the jury to say whether, on reading a prior specification and comparing it with the plaintiff's specification, the plaintiff has borrowed his invention from such prior specification. (2 *Web. P. C.* 107.)

189. SPENCER *v.* JACK. [1864]

In a suit for an injunction to restrain the infringement of a patent, the Court directed four issues to be tried at law, one amongst them being "whether the invention was a new manufacture." The judge at common law, in the course of the trial of the issues, expressed his opinion that a question of law would arise, whether there was upon the facts a sufficiency of invention to warrant the granting of a patent. The judge, nevertheless, went on with the trial, and put two questions to the jury:—"Is the invention new?" and, "Is it a substantial improvement?" The jury found for the plaintiff in the affirmative upon both issues. Upon the cause coming back to equity, the Master of the Rolls took up the point of law reserved, without considering the verdict of the jury, and, on the motion of the defendants, granted a new trial:—Held, on appeal, that the judge in equity ought to have considered the verdict of the jury, and that, had he done so, the only point of law remaining would have been this,—whether a combination of things previously well known, which combination could be rightfully denominated a substantial improvement, could be the subject of a patent?—the answer to which must have been in the affirmative. The order of the Master of the Rolls, directing a new trial, was consequently reversed. (11 *L. T. Rep.*, N. S. 242.)

UTILITY OF INVENTION.

Utility generally.

190. DARCY v. ALLIN. [1602]

“Where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine *tending to the furtherance of a trade* that never was used before: and that *for the good of the realm*: that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, *in consideration of the good that he doth bring by his invention to the commonwealth: otherwise not.*” (*Noy, R.* 182.)

191. EDGEBERRY v. STEPHENS. [1691]

The Act 21 Jac. I. intended to encourage new devices *useful* to the kingdom. (1 *Web. P. C.* 35; *Dav. P. C.* 36.)

192. REX v. ARKWRIGHT. *Scire facias.* [1785]

When an invention is proved to be new, the question of its materiality or *utility* arises. (*Dav. P. C.* 138; 1 *Web. P. C.* 72.)

193. TURNER v. WINTER. [1787]

Ashurst, J., said: “I think that, as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law, and would be a reason against it, were it not for *the advantage which the public derive* from the communication of the invention.” (*Dav. P. C.* 151; 1 *T. R.* 605; 1 *Web. P. C.* 80.)

194. BOULTON v. BULL. [1795]

Rooke, J., in the course of his judgment, said, that the public have a right to receive a *meritorious consideration* in

return for the protection which a patentee claims. (2 *H. Bl.* 478.) Buller, J., said: "The invention professes to lessen the consumption (of steam), and, to make the patent good, the method must be capable of lessening the consumption to such an extent as to make the invention *useful*. More precision is not necessary, and absolute precision is not practicable." (*Ib.* 498.)

195. HUDDART v. GRIMSHAW. N. P. [1803]

Ellenborough, C. J., told the jury that if an invention "be productive of a new end, and *beneficial to the public*, it is that species of invention which, protected by the king's patent, ought to continue to the person the sole right of vending." (1 *Web. P. C.* 86; *Dav. P. C.* 278.)

196. MANTON v. PARKER. N. P. [1814]

The patent was for "a hammer, on an improved construction, for the locks of all kinds of fowling-pieces and small arms." A material part of the invention consisted in a means of letting out the air from the barrel, and causing a communication between the powder in the pan and in the barrel, without, at the same time, letting out the powder. The witnesses for the defendant having proved that the powder passed through the same hole as the air, Thomson, C. B., held: "That the utility of the invention, and the purpose of the patent, wholly fail; for the purpose of the hole, as described in the specification, is to let the air pass through, and at the same time secure the powder from passing through; that of itself would be an answer to the action." (*Dav. P. C.* 327; 1 *Web. P. C.* 192, *n.*)

197. MANTON v. MANTON. N. P. [1815]

Gibbs, C. J., held that "in order to support a right to the exclusive enjoyment of any invention, it is necessary that the party who takes out the patent should show that the invention is new, that it was unknown to the trade and to the world before; that it is not only new, but that it is *useful to the public*." (*Dav. P. C.* 348.)

198. BOVILL v. MOORE. N. P. [1816]

Action for the infringement of a patent. Gibbs, C. J., "In point of law it is necessary that the plaintiff should prove that this is a new and *useful* invention, in order to entitle himself to the present action." (*Dav. P. C.* 399.)

199. HILL v. THOMPSON. [1817-8]

A patent can be supported only for an invention which is *useful*. (3 *Mer.* 629; *Web. P. C.* 237.) Dallas, J., delivering the judgment of the Court of Common Pleas, said: "If any part of an alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." (8 *Taun.* 401; 2 *B. Moore*, 457; *Web. P. C.* 249.)

200. LEWIS v. MARLING. [1829]

Parke, J., in the course of his judgment, said: "The prerogative of the crown as to granting patents was restrained by the statute 21 Jac. 1, c. 3, s. 6, to cases of grants 'to the true and first inventors of manufactures, which others at the time of granting the patent shall not use.' The condition therefore is, that the thing shall be new, *not that it shall be useful*; and although the question of its utility has been sometimes left to a jury, I think the condition imposed by the statute has been complied with when it has been proved to be new." (10 *B. & C.* 28; 4 *Car. & P.* 58; 1 *Web. P. C.* 497.)

201. LEWIS v. DAVIS. N. P. [1829]

A patent being for an improvement on a former patent, it is not material whether a machine made according to the first patent would be useful or not, if it be shown that a machine constructed according to the subsequent patent is useful. (3 *Car. & P.* 504; 1 *Web. P. C.* 489.)

202. MINTER v. WELLS. N. P. [1834]

Alderson, B.: "The plaintiff, in order to establish his right,

must show that the invention is new, and that it is *useful*.” (1 *Web. P. C.* 129.)

203. RUSSELL v. COWLEY. [1835]

Lyndhurst, C. J.: “The first question is, is this a new and *useful* invention?” (1 *Web. P. C.* 467.)

204. MORGAN v. SEAWARD. [1837]

In delivering the judgment of the Court, Parke, B., said: “A grant of a monopoly for an invention which is *altogether useless*, may well be considered as ‘mischievous to the State, to the hurt of trade, or generally inconvenient,’ within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by anyone during the continuance of the monopoly, without obliging the person making use of it to purchase a useless invention; and on a review of the cases, it may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question, whether the patent be void under the statute of monopolies.” (2 *M. & W.* 562; *Mur. & H.* 61; 1 *Jur.* 529; 1 *Web. P. C.* 197.)

205. Re CUTLER’S PATENT. Ch. [1839]

This was a petition to the Lord Chancellor, to affix the great seal to letters patent, obtained by Cutler, against which a caveat had been lodged. It was urged that Cutler’s invention was not useful, and that, therefore, the great seal ought not to be affixed to his letters patent. Lord Cottenham, L. C., referring to this objection, said: “It is not very easy sitting here to form any very conclusive opinion as to the usefulness, nor is it very necessary to inquire into that (particularly considering from whom the objection emanates), because if it be so perfectly useless as is represented, it will interfere with no man’s rights, and it will be a mere dead letter, which no man would wish to imitate if they had the right.” (1 *Web. P. C.* 426.)

206. CRANE v. PRICE. [1842]

Tindal, C. J. : “ If the invention be new and *useful to the public*, it is not material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery.” (4 *M. & G.* 605 ; 1 *Web. P. C.* 411.)

207. WALTON v. BATEMAN. N. P. [1842]

Cresswell, J. : “ Then, gentlemen, we come to another objection—I really do not know what plea it applies to—that the invention claimed by the patent is not of any public use or benefit. It is supposed that that may be a question under the ‘new manufacture.’ I entertain great doubts upon that, because a thing may be a new manufacture, and perhaps may not be of any public use or benefit.” (1 *Web. P. C.* 623.)

208. HOW v. TAUNTON. [1844]

Patent for the invention of a nipping lever, for causing the rotation of wheels, shafts, or cylinders, under certain circumstances. The specification claimed as the invention “the nipping lever, with its tusk and sliding-box, applied to a rimmed wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together with any shaft, cylinder, or other suitable machinery which may be attached thereto.” The nipping lever was not new ; but the application of it by means of the sliding-box was new : Held, that it must also appear that the use of sliding-box was essential to the invention. (9 *Jur.* 1056.)

209. SIMPSON v. HOLLIDAY. Ch. [1864]

It appears to be necessary that a patented invention should be useful, not only at the time the patent is granted, but also during the whole term of the grant. (20 *New. Lon. Jour., N. S.* 107, 120.)

*Degree of Utility.*HAWORTH *v.* HARDCASTLE. [1834] See 216.210. CORNISH *v.* KEENE. N. P. [1835]

Action for the infringement of a patent for “an improvement or improvements in the making or manufacturing of elastic goods or fabrics, applicable to various useful purposes.” Tindal, C. J. : “It is a circumstance in the case that it is found useful for surgical purposes. The patent, however, is not taken out for that purpose, and it would not be sufficient in order to maintain the patent, on the ground of its being an improvement, to show that it was an improvement in surgical cases for bandages only, because the patent is not only confined to that, but they must prove also that it is generally an improvement with respect to the general uses of that fabric or manufacture which was intended—that is, with respect to braces, garters, and other articles that are made of it. The evidence on the part of the plaintiffs states that it is cheaper, and cheapness is an improvement, and not to be laid aside and thought nothing of, and you are to consider it among other things ; but that is not the only thing to be considered, because they may have a thing too cheap to be useful, and you must see whether it combines with it the other property of utility which the former fabric, when used for the same purpose, possesses.” (1 *Web. P. C.* 506.)

211. MORGAN *v.* SEAWARD. N. P. [1836]

Action for infringement. Defendants denied the utility of the plaintiff's invention. Alderson, B., directing the jury upon this point, said : “It is not for you to consider to what extent the thing is useful. If it is a useful invention, then it is a subject to be protected by patent ; and if, on the other hand, it is of no use, then it is no subject to be protected by patent. The issue is, whether it is of any use at all.” (1 *Web. P. C.* 172.)

212. LOSH *v.* HAGUE. N. P. [1838]

Action for the infringement of a patent for “certain improvements in the construction of wheels for carriages to be used on

railways." Plea, *inter alia*, "that the said supposed improvements, &c. . . . are only trifling and insignificant alterations in the mode of making wheels before then known and in public use, and are not legal subjects for the grant of the said letters patent." Abinger, C. B., in directing the jury, said: "I observe one of the pleas states, that the improvements are something trifling and insignificant. If that is the improvement, you will consider whether it is worth a patent or not." (1 *Web. P. C.* 202.)

213. NEILSON v. HARFORD. N. P. [1841]

An invention to support a patent must be productive practically of some beneficial result, no matter how great, provided it is sufficient to make it worth while (the expense being taken into consideration) to adopt it. (1 *Web. P. C.* 314.)

214. TETLEY v. EASTON. N. P. [1852]

When a machine can do that which, apparently, no other machine can be got to do, it must be pronounced useful, even though its cost is very considerable. It is not necessary that a patent should be so useful as to exclude everything else; it is quite sufficient if on any occasion it is useful. (*Macr. P. C.* 63.)

Want of Utility in a Part of an Invention.

215. LEWIS v. MARLING. [1829]

Where a patentee of an improved machine claimed as his invention a part of it which turned out to be useless, it was held that this did not vitiate the patent, the specification not describing it as essential to the machine. Bayley, J., said: "If the party knew that it (the useless part of the machine) was unnecessary, the patent would be bad on the ground that this was a deception, but if he thought that it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection." (1 *Web. P. C.* 496.)

216. HAWORTH v. HARDCASTLE. [1834]

In an action for the infringement of a patent the jury found as follows: "The invention is new and useful upon the whole, . . . but they also find that the machine is not useful in some cases for taking off goods." Verdict for the plaintiff. The court subsequently refused to make absolute a rule *nisi* for a nonsuit, on the ground that the jury had, by their special finding, negatived the usefulness of the invention to the full extent of what the patent and specification had held out to the public. Tindal, C. J., delivering the judgment of the court, said: "The jury find 'the invention is new and useful upon the whole; . . . but they also find that the machine is not useful in some cases for taking off goods.' . . . But we think we are not warranted in drawing so strict a conclusion from this finding of the jury, as to hold that they have intended to negative, or that they have thereby negatived, that the machine was useful in the generality of the cases which occur for that purpose. After stating that the machine was useful on the whole, the expression, that 'in some cases it is not useful to take up the cloths,' appears to us to lead rather to the inference that in the generality of cases it is found useful. And if the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void. . . . We think that we should act with great hazard and precipitation if we were to hold that the plaintiff ought to be nonsuited, upon the ground that his machine was altogether useless for one of the purposes described in his specification." (1 *Web. P. C.* 483; 4 *M. & Sc.* 732; 1 *Bing. N. C.* 189.)

217. MORGAN v. SEAWARD. [1837]

Alderson, B., "We do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject which is, taken altogether, useful, though a part or parts may be useless, always supposing that such patent contains no false suggestion." (1 *Web. P. C.* 197.)

*Obstructing Patents.***218. CROSSLEY v. POTTER.** N. P. [1853]

Pollock, C. B., in addressing the jury, said: "A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind, and the introduction of other inventions adapted to the particular subject to which the invention may be applicable,—a patent which has for its object to snatch and grasp at everything in all directions, which may possibly come within the general language the patentee may choose to adopt in his specification,—a patent, the object of which is, not to benefit the world by its communication, but to obstruct by the very general character of the claims made for conferring peculiar privileges on the patentee;—such a patent as that, in my judgment, cannot be supported." (*Macr. P. C.* 245.)

*Question for the Jury.***219. HILL v. THOMPSON.** [1817]

The utility of an invention is a question for the jury. (3 *Mer.* 630; *Web. P. C.* 237.)

220. BLOXAM v. ELSEE. N. P. [1825]

Abbott, C. J., left it to the jury to say whether the invention was *useful*. (1 *C. & P.* 565.)

221. CORNISH v. KEENE. N. P. [1835]

The evidence respecting the utility of a patented article being conflicting, and the article itself being produced, it is for the jury to use their own judgment of the matter, and determine whether it is useful or not. (1 *Web. P. C.* 506.)

222. MORGAN v. SEAWARD. N. P. [1836]

The circumstance of an invention not getting into general use is a presumption against its utility. (1 *Web. P. C.* 186.) See also **211**.

LOSH *v.* HAGUE. N. P. [1838] See **212**.

223. NEILSON *v.* HARFORD. N. P. [1841]

It is not necessary that each part of an invention should have been actually tried and proved to answer ; the evidence of scientific persons, that it would answer, may be sufficient. (1 *Web. P. C.* 314, 316.)

224. MACNAMARA *v.* HULSE. N. P. [1842]

Where, in an action for infringing a patent for blocks for pavement, the plaintiff claimed as his invention that his blocks were bevelled both inwards and outwards on the same side, but the specification did not state at what angle the bevels should be made ; and one witness stated that the angle was material, but another witness stated that any angle would be of some benefit ; Lord Abinger, C. J., said : “ It will be for the jury to say whether any particular angle is essential, or whether any angle whatever is useful and beneficial.” (*C. & M.* 471.)

WHO MAY BE A PATENTEE.

First and True Inventor.

225. *EDGEBERRY v. STEPHENS.*

A grant of a monopoly may be to the first inventor, by the 21 Jac. 1; and, if the invention be new in England, a patent may be granted, though the thing was practised beyond sea before; for the statute speaks of new manufactures within this realm; so that, if it be new here, it is within the statute; for the act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing. (2 *Salk.* 447; *Comb.* 84; *Dav. P. C.* 36; 1 *Web. P. C.* 35; 1 *Carp. P. C.* 35.)

HUMPHREY'S PATENT. See 103.

226. *DOLLOND'S PATENT.* [1758]

Patent for a new method of making the object-glasses of refracting telescopes. Before the date of the patent Dr. Hall had made and used object-glasses, of a precisely similar construction in his own observatory, but had not made any publication of their mode of construction or use. Held, that this was not such a prior use as to invalidate the patent. (*Cit. in Boulton v. Bull*, 2 *H. Bl.* 469, 470, 487; *Dav. P. C.* 170, 171, 172, 199; 1 *Web. P. C.* 43; 1 *Carp. P. C.* 28.)

R. v. ARKWRIGHT. [1785] See 106.

TENNANT'S CASE. [1802] See 142.

227. *FORSYTH v. RIVIERE.* [1819]

If several persons simultaneously discover the same thing, the party first communicating it to the public, under the protection

of letters patent, becomes the legal inventor: (*Chitty's Prerog. Crown*, 182; 1 *Web. P. C.* 97; 1 *Carp. P. C.* 401.)

228. R. v. WHEELER. Sci. fac. [1819]

Abbott, C. J., delivering the judgment of the court, said: "If the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true, if it should happen that the patentee has invented some other matter or thing, of which, upon a due representation thereof, he might have been entitled to a grant of the exclusive use." (2 *B. & Ald.* 349.)

229. BARBER v. WALDUCK. N. P. [1823]

Action for the infringement of a patent for an improvement in making hats. One of the plaintiff's witnesses proved that he had made the improvement, which was the subject of the patent, while employed in their workshop. Holroyd, J., ordered a nonsuit. (*Cit.* 1 *C. & P.* 567; 1 *Carp. P. C.* 438.)

230. BLOXAM v. ELSEE. N. P. [1825]

Action for the infringement of a patent for "a machine for making paper in single sheets without seam or joinings." The principle of this invention consisted in receiving the pulp to be made into paper upon an endless wire web, stretched upon revolving cylinders, so that the paper was moved forward as fast as it was formed. The patentee discovered the principle of this invention, but the mechanical details necessary for carrying the invention into complete effect, were numerous and complicated, and therefore he engaged Mr. Donkin, an engineer, to give him his professional assistance, and several parts of the machine were suggested to the patentee by Mr. Donkin. It was objected by the defendants that the patentee, under these circumstances, could not be the inventor; but it was answered that Mr. Donkin was merely acting as the patentee's servant, and the objection was not sustained. (1 *C. & P.* 567; 1 *Web. P. C.* 132. n.; 1 *Carp. P. C.* 434.)

231. LEWIS v. MARLING. [1829]

Action for the infringement of a patent for certain improvements on shearing machines. It was proved by the defendant, that the specification of a similar machine had previously been enrolled in America, that a model of an exactly similar machine had been exhibited to three or four persons in England, and that a manufacturer in England had commenced the construction of a machine from the American specification. Bayley, J., said: "If it had been shown that the plaintiff had seen the model, and had borrowed from it, he would not have been the true inventor, and would, therefore, have misled the Crown; but if I made a discovery, and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery by his mind, unless it has become public. So, if I introduce a discovery, *bonâ fide* made, I may have a patent for it, though a person might have received privately a communication from abroad, which would have enabled him to have made the machine." (1 *Web. P. C.* 493.)

232. MINTER v. WELLS. N. P. [1834]

Action for the infringement of a patent for "improvements in the construction, making, or manufacturing of chairs." The patentee claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as above described." The defendants contended that the invention was made, not by the patentee, but by a person by the name of Sutton. Alderson, B., in summing up to the jury, said: "He (the patentee) claims under the patent, stating it in his petition to the Crown, that he is the true inventor of the machine in question; and if it could be shown that he was not the true inventor, but that some one else had invented it, the Crown is deceived in that suggestion, which was the foundation on which it granted the patent; and then the law is, that a patent obtained under such circumstances would be void, and no action could be maintained against a party for the infringement of the patent, by reason of the suggestion to the Crown

not being true. . . . The essence of the claim to invention, and undoubtedly his claim, is the application of a self-adjusting leverage to the chair, and if it could be shown that any self-adjusting leverage had been, before the plaintiff's patent, applied to a chair, the patent would be void, because the priority of the specification given to him would claim every species of the application of a self-adjusting leverage to the back and seat of a chair. . . . If Sutton suggested the principle to Mr. Minter, then he (Sutton) would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. Minter uses for the purpose of enabling him to carry his original conception into effect." (1 *Web. P. C.* 127; 1 *Carp. P. C.* 622.)

233. CORNISH v. KEENE. N. P. [1835]

Action for the infringement of a patent, which was held invalid for want of novelty. Tindal, C. J., in summing up to the jury, said: "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not, because these patents are granted as a reward, not only for the benefit that is conferred upon the public by the discovery, but also to the ingenuity of the first inventor; and, although it is proved that it is a new discovery so far as the world is concerned, yet if anybody is able to show that although that was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A. or B., or taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, it would become an important question whether he was the first and original inventor of it." (1 *Web. P. C.* 507.) See also 129.

234. LOSH v. HAGUE. N. P. [1838]

Abinger, C. B.: "If a man claims by his patent a number of things, as being the inventor of them, whether they consist of improvements or original inventions, and it turns out that some

of them be not original and not improvements, his patent is void." (1 *Web. P. C.* 203.)

235. GIBSON v. BRAND. N. P. [1841]

Tindal, C. J., in summing up to the jury in this case, said: "A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the Legislature never intended that a person who had taken all his knowledge from the art of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. There is some distinction, although perhaps not a very broad one, between the plea which alleges the plaintiffs were not the first and true inventors, and that on which I conceive the principal question between the parties will turn—the third in order, viz., whether the subject-matter of this patent was known in England at the time the letters patent were granted. It is quite clear, if on the evidence you have heard you are satisfied that this which is alleged to be a discovery by the plaintiffs had been publicly known and practised in England, there is an end to the validity of the patent." (1 *Web. P. C.* 628.)

236. WALTON v. POTTER. [1841]

Tindal, C. J.: "Though the matter may not have been used, the party is not entitled to his patent unless he is the first and true inventor; therefore, if the subject-matter of the patent has been discovered, has been published in a dictionary, for example, though it has not been reduced into practice, if a man merely adopts it, the merit is so small that his patent for it would be worth nothing." (1 *Web. P. C.* 592.)

237. WALTON v. BATEMAN. N. P. [1842]

Cresswell, J.: "The party obtaining the patent must be the true and first inventor in their country. If he import from a foreign country that 'which others at the time of the making of

such letters patent and grants did not use,' it will suffice." (1 *Web. P. C.* 615.)

238. STEAD v. WILLIAMS. N. P. [1843]

Cresswell, J., in directing the jury, said: "Then comes this question, that, long before the patent was granted, the invention was publicly known in this country. Now, as to its being publicly known in this country, I take it that there is a great difference between the knowledge of it as a thing that would answer, and was in use, and the knowledge of it as a mere experiment that had been found to be a failure and thrown aside. If you are dealing with an article of merchandise, or with an article of ordinary use—if a person has had a scheme in his head, and has carried it out, but, after a trial, has thrown it aside, and the thing is forgotten and gone by—then, another person re-introducing it, may, within the meaning of this Act, be the inventor and the first user of it, so as to justify a patent." (2 *Web. P. C.* 135.) *See also* 156.

239. MUNTZ v. FOSTER. N. P. [1844]

Tindal, C. J.: "First of all, it is said that the manufacture which is described in this patent is not a new one. In the next place it is said, even if it is a new one, that the plaintiff is not the true and first inventor. Now these two objections go very nearly to the same point; they are not precisely the same, there may be a difference between them, but it will be very much the same train of reasoning that will apply to the one as to the other. It may be very true that the manufacture might be a new manufacture, not known in this kingdom till the time of the patent, and yet it might also be true that Mr. Muntz might not be the first and true inventor; because, although a man may take it from an old book, or from some description that he has got elsewhere, where it has been worked, although not generally known, that secret which he then claims from the Crown the benefit of a patent for, as if he had been the inventor (and in that case he would not, as you perceive, on the supposition that I have made, be within the ordinary meaning of the words 'the

first and true inventor,' although no one knew it or used it at the moment)—yet, if he had taken it from Collins's specification, which is the only part of the evidence that will touch the plea: if he had taken from that the account of the process for making this new manufacture, of which he afterwards avails himself by laying his claim before the Crown; why, he would not be entitled to that benefit which the statute of James intended, namely, for the merit of having by experiment, or by imitation, or by his sagacity, made a discovery himself; but would only be clothing himself with a discovery which would be the result of another man's labour." (2 *Web. P. C.* 102.)

240. ALLEN v. RAWSON. [1845]

In this case, Tindal, C. J., said: "It would be difficult to define how far the suggestions of a workman, employed in the construction of a machine, are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But, when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." (1 *C. B.* 574.)

STEAD v. ANDERSON. [1847] See **157.**

241. NICKELS v. ROSS. [1849]

A party availing himself of information from abroad is an inventor within 21 Jac. 1, c. 3, s. 6. (8 *C. B.* 679.)

242. *In re* HONIBALL'S PATENT. [1855]

A first and original inventor means a person who could claim the merit of first invention, without reference to the user. (9 *Moo. P. C. C.* 378.)

HILLS v. LONDON GASLIGHT COMPANY. N. P. [1860]
See **145.**

In re HENRY'S APPLICATION. [1872] See **253.**

Importer of Foreign Invention.

HASTING'S PATENT. [1567] See 101.

MATTHEY'S PATENT. [Eliz.] See 102.

EDGEBERRY *v.* STEPHENS. See 225.

DARCY *v.* ALLIN. [1602] See 104.

WALTON *v.* BATEMAN. N. P. [1842] See 237.

STEAD *v.* WILLIAMS. [1844] See 156.

243. BEARD *v.* EGERTON. [1846]

A patent granted to a British subject, in his own name, for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent be in truth taken out, and held by the grantee, in trust for such foreigner. (3 *C. B.* 97.)

NICKELS *v.* ROSS. [1849] See 241.

In re LAMENAUDE'S PATENT [1850] See 159.

244. MILLIGAN *v.* MARSH. [1856]

When a patent is taken out as for an original invention, the subject of the patent, being in fact a communication from a British subject resident abroad, the patent is void. *Seemle*, that an agent in this country of an inventor abroad receiving a confidential communication of an invention, not in a practically useful state, may take out a patent for his own benefit, if he, pursuing the idea thus thrown out, discovers a practical way of carrying it into effect. (2 *Jur.*, N. S. 1083.)

RENARD *v.* LEVINSTEIN. [1864] See 446.

APPLICATION FOR LETTERS PATENT.

Concurrent Applicants.

245. *Ex parte* DYER. [1812]

Where there are concurrent applications for letters patent for the same object, he who obtains the great seal first, by getting quickest through the various stages, will have the sole right at law. (*Holroyd*, 59.)

246. CORNISH *v.* KEENE. N. P. [1835]

Tindal, C. J., "The first who comes to the Crown and takes out a patent is the man who has a right to clothe himself with the authority of the patent, and enjoy its benefits." (1 *Web. P. C.* 508.)

247. *In re* SIMPSON & ISAACS' PATENT. [1853]

Objections were filed to an application for a patent, and were overruled by the law officer of the Crown; he issued his warrant to seal, to which also objections were filed. On a petition by the patentees, the Court made an order to affix the great seal without sending the case back to the law officer.

The Lord Chancellor said: "I think that Lord Eldon was correct in *Dyer's case*. I shall follow the rule which he there laid down. In that case both parties invented the same thing at the same time, and the question was, who was to be preferred, the first who applied for, or the first who obtained, the patent? His lordship decided in favour of the latter. In that case the patentees first applied, and the Act means to put the order for protection granted at the time of the application on the same footing as the patent stood before; you are therefore the first entitled. I am of opinion, too, that you are entitled to have the patent sealed. No doubt, in advising the Crown to seal letters patent, I ran the risk of occasioning great injury to parties, by

driving them into litigation; but by the contrary course I run the risk of doing irreparable injury. In my opinion, the question is the same as if, under the old law, application were being made to me for letters patent to be granted at the time when the application for this patent was made. This application is rested on two grounds, first, that these patentees are not the true inventors; secondly, that the invention is not new. I am quite ready to say that I think there is strong evidence that it was not; but I shall not take upon myself so to decide. I think I am bound to decide myself, not whether they have made out that they are the true inventors, and that the invention is new, but whether such a *primâ facie* case has been made that I ought to put them into a position to litigate the question with the public." (21 *L. T. Rep.* 81.)

248. HEATH v. SMITH. [1854]

Campbell, C. J.: "When I was Attorney-General, and it appeared that there were two contemporaneous discoveries, I used to give a patent to the two jointly." Sir A. E. Cockburn, Attorney-General: "I have adopted the same practice, but I have found parties ordinarily unwilling to accept patents on such terms." (2 *Web. P. C.* 271.)

249. *In re* LOWE'S PATENT. [1856]

L. and W. were joint patentees of an invention for propelling vessels, and whilst engaged in making experiments with regard to it an accident happened, which appeared to have suggested to each an improvement upon the method previously adopted. They communicated their ideas to each other, but neither took any steps to secure the benefit of the invention for two years, when L. applied for a patent, against the sealing of which W. entered a caveat, on the ground that he (W.) was the first inventor. The evidence on this point being conflicting:—Held, that L., having first applied, was entitled to have his patent sealed, though possibly W. might be able to get it repealed upon *scire facias*. (25 *L. J., Ch.* 454.)

In re RUSSELL'S PATENT. [1857] See 314.

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250. *In re* BATES & REDGATE'S APPLICATION. [1869]

The existence of a prior provisional specification is not a ground, in the absence of fraud, on which the Attorney-General ought to refuse to allow a second provisional specification by another inventor to be filed; and, in the event of the later applicant for provisional protection being the first to obtain a grant of letters patent, his patent is a bar to the grant of letters patent for the same invention to the earlier applicant for such provisional protection. (*L. R.*, 4 *Ch.* 577; 38 *L. J.*, *Ch.* 501.)

251. *Ex parte* MANCEAUX. [1870]

Where the law officer has reported that part of an invention, for which a patent is sought, is identical with part of an invention which is the subject of an existing patent, a second patent will not, except under special circumstances, be granted for that part, although the validity of the first patent is disputed. (*L. R.*, 6 *Ch.* 272.)

252. *Ex parte* SCOTT & YOUNG. [1871]

When a servant filed a provisional specification for an invention, after which the master filed a provisional specification for a similar invention, and subsequently filed a complete specification and obtained letters patent:—Held, that, under the circumstances, which threw the gravest suspicion on the *bona fides* of the master, the great seal might be affixed to the letters patent for the servant's invention, and that the letters patent might bear the date of his provisional specification. (*L. R.*, 6 *Ch.* 274.)

253. *In re* HENRY'S APPLICATION FOR LETTERS PATENT: *Re* FARQUHARSON'S APPLICATION FOR LETTERS PATENT. [1872]

An applicant for a patent does not, by lodging a complete specification under the 9th section of the Patent Law Amendment Act of 1852, acquire the rights of a patentee so as, during the six months' protection, to prevent any other person who has previously obtained provisional protection for a similar invention from obtaining a patent. (*L. R.*, 8 *Ch.* 167; 42 *L. J.*, *Ch.* 363.)

Selborne, L. C. : “ I apprehend that it would be no answer to a *bonâ fide* applicant for a patent, who has himself, by his own ingenuity, made a useful invention, and has applied for a patent before anyone else claiming to have made the same invention—it would, I say, be no answer to him, assuming the absence of fraud or communication, to allege that experiments had been going on, or even drawings made, by another inventor, If he (the applicant for a patent) were the true inventor, the circumstance of something having taken place somewhere else, which was not disclosed to the world, and as to which no prior application was made, would be no answer to him, even if it were shown that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time.” (*L. R.*, 8 *Ch.* 170.)

In re GETHING. [1874] See 281.

In re HARRISON. [1874] See 282.

Grounds of Opposition.

254. *In re* FOX. [1812]

The owners of a patent opposed the grant of a patent for improvements therein, on the ground that the alleged invention was borrowed from their patent. The resemblance of the two inventions was denied. The Lord Chancellor sealed the patent. (1 *Web. P. C.* 431; 1 *V. & B.* 67.)

255. *In re* CUTLER. [1839]

Semble, the sealing of a patent will not be stopped merely on the ground of the alleged want of utility. 1st. Because the question cannot be successfully determined. 2nd. Because, if useless, the patent, when granted, would be of no value. (1 *Web. P. C.* 426.)

256. *In re* SAMUDA: *In re* GRIFFITHS. [1846]

Prior public user is a bar to the grant of letters patent for an invention, and when the law officers report that the invention has

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previously been published in *any part* of the United Kingdom, no patent for it can be granted. (Cited *Hindmarch*, p. 534.)

257. *In re* ADAMSON'S PATENT. [1856]

A contractor for certain works had, in the progress of his undertaking, invented an apparatus which could only be tested in a place available to the public. After having used the apparatus for four months in the progress of the work, he applied for a patent:—Held, that such a case amounted to a dedication to the public, and that the petitioner was not entitled to the patent. An experiment might have been made, and if made *bonâ fide* only for the purpose of testing the merits of the invention, it would not have been a dedication to the public. But when, as in this case, thousands of persons have the opportunity of seeing the apparatus at work for four months in the regular course of the undertaking, it is quite clear that no intention of applying for a patent originally existed. Under such circumstances, and after the lapse of such a time, there has been a dedication. (6 *De G., M. & G.* 420.)

258. *In re* TOLSON'S PATENT. [1856]

Letters patent sealed in a case where the evidence showed great similarity between the alleged invention and one for which a patent was already in force. (6 *De G., M. & G.* 422.)

259. *In re* RUSSELL'S PATENT. [1857]

In general, where there is a doubt as to the validity of the grounds of opposition to a patent, the proper course is to grant the letters patent, as an error in refusing them would be irremediable, while one in granting them would not. (2 *De G. & J.* 130.)

260. *In re* SPENCE'S PATENT. [1859]

Unless a patent is clearly bad, the Lord Chancellor will not refuse to seal it, as the effect of such refusal, if erroneous, would be irremediable, whereas the sealing a bad patent leaves every one at liberty to dispute it. (3 *De G. & J.* 523.)

261. NEWALL v. ELLIOTT. [1863]

The use of an invention before the public, only for ascertaining its practicability, is no dedication to the public, although used in carrying out a contract. (1 *H. & C.* 797; 9 *Jur.*, *N. S.* 359; 32 *L. J.*, *Exch.* 120; 11 *W. R.* 438; 7 *L. T. Rep.*, *N. S.* 753.)

262. *In re* TOLHAUSEN'S PATENT. [1866]

In a case where there was but one affidavit distinctly swearing to public use and sale of an alleged invention prior to the date of the application for a patent, the great seal was ordered to be affixed to the patent. (14 *W. R.* 551.)

263. *In re* VINCENT'S PATENT. [1867]

The sealing of a patent was opposed on the ground of previous public user of the invention, in reply to which the applicant made the case, that such user was obtained by fraud on him, so as to bring the case within 15 & 16 *Vict. c.* 83, s. 10:—Held, that such a case ought to be tried before a jury, and that the patent ought to be sealed that such trial might not be precluded. (*L. R.*, 2 *Ch.* 341.)

264. *In re* MANCEAUX'S PATENT. [1870]

Letters patent will not be sealed where a prior patent has been granted for the same invention, and there is no fraud, although the validity of the first patent is disputed. (*L. R.*, 6 *Ch.* 272; 18 *W. R.* 1184.)

265. *In re* SCOTT & YOUNG'S PATENT. [1871]

Whether an objection to the sealing of a patent, on the ground of a prior patent having been granted, can be made where no complete specification of the prior patent has been filed, *quære*. (19 *W. R.* 425.)

266. *Ex parte* BAILEY. [1872]

B. obtained provisional protection on the 30th of March, gave notice to proceed on the 23rd of April, and on the 21st

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applied for the great seal to be affixed to letters patent for his invention. On the 29th of May a caveat was entered against the sealing, and B. petitioned the Lord Chancellor to affix the seal on the 27th of September:—Held, that B.'s delay was not an objection to sealing his patent, and that he was not put in a worse position because he had given notice to seal his patent some months before he was obliged to do so. (*L. R.*, 8 *Ch.* 60.)

267. *Ex parte* HENRY. [1872]

It is no objection to the grant of a patent that another person has been making experiments and working towards a similar invention. (*L. R.*, 8 *Ch.* 167; 42 *L. J.*, *Ch.* 363; 21 *W. R.* 233.)

Caveat.

268. *R. v.* CUTLER. [1847]

The effect of a caveat, lodged at the chambers of the Attorney-General, is merely to entitle the party lodging it to notice. (3 *C. & K.* 215.)

In re HEATHORN'S PATENT. [1864] See 277.

Hearing before Law Officer.

269. *In re* HENRY'S APPLICATION FOR LETTERS PATENT: *Re* FARQUHARSON'S APPLICATION FOR LETTERS PATENT. [1872]

It is the duty of the law officer, upon the hearing of several applications for letters patent by rival inventors, to determine upon conflicting evidence, and not to remit the question in dispute to the Lord Chancellor, by issuing his warrant for the sealing of both patents. (*L. R.*, 8 *Ch.* 167; 42 *L. J.*, *Ch.* 363.)

*Reference to Law Officer.***270.** *Ex parte* HENSON, *in re* ALCOCK'S PATENT. [1832]

On affidavit that an invention, for which letters patent were about to be sealed, is the invention of the deponent, and had been obtained by a breach of confidence, the Lord Chancellor allowed an opposition at the great seal, though the opponent had not opposed the grant before the law officer. The Lord Chancellor holding that the parties under the circumstances ought to be heard; but that such right ought to be exercised exceedingly sparingly. He referred the matter to the Attorney-General. (1 *Web. P. C.* 432.)

In re FAWCETT'S PATENT. [1852] See **274**.

271. *In re* STOLL'S PATENT. [1853]

An application for the sealing of a patent which, with the consent of the petitioner and the opposing party, the Lord Chancellor had referred to the Assistant Commissioner in the Patent Office for his opinion as to whether there was an infringement of a patent already granted, was, upon that officer's opinion being unfavourable to the petitioner, refused. (21 *L. T. Rep.* 233.)

Ex parte BRENNARD'S PATENT. [1861] See **276**.

272. *Ex parte* YATES. [1869]

Where the sealing of a patent was objected to, on the ground that the invention was a colourable imitation of one which was the subject of an existing patent, a reference was made to the law officer, whether, having regard to the prior patent, the seal ought to be affixed to the patent as applied for. The law officer having certified against the patent the court dismissed the petition with costs, notwithstanding no opposition had been made to the petitioner's application for a patent until he had applied to have it sealed, and he had given all the requisite notices. (*L. R.*, 5 *Ch.* 1.)

Ex parte MANCEAUX. [1870] See **295**.

*Opposition at the Great Seal.***273.** *Ex parte* HENSON, *In re* ALCOCK'S PATENT. [1832]

It is a matter of discretion with the Lord Chancellor whether he will allow a person to oppose the sealing of letters patent before him, when he has not already done so before the law officer. (1 *Web. P. C.* 432.)

274. *In re* FAWCETT'S PATENT. [1852]

Where a caveat was lodged before the great seal was affixed to a patent, the Lord Chancellor declined to enter into the merits of the opposition, but referred the matter back to the Attorney-General. (2 *De G., M. & G.* 439.)

275. *In re* M'KEAN. [1859]

Where no objection is made before the law officer, *semble*, the course of opposing by affidavit before the Lord Chancellor is still open. (1 *De G., F. & J.* 2.)

276. *In re* BRENNARD'S PATENT. [1861]

Leave was given to oppose the granting of letters patent, notwithstanding the time for entering an opposition had expired, the reason for the delay in entering such opposition being accounted for, and the matter was referred back to the Attorney-General. (7 *Jur., N. S.* 690; 4 *L. T. Rep., N. S.* 456.)

277. *In re* HEATHORN'S PATENT. [1864]

Since the passing of 15 & 16 Vict. c. 83, the practice of entering caveats is discontinued unless special leave is obtained, and, therefore, the Lord Chancellor sealed a patent, notwithstanding a caveat was standing against it, no leave having been obtained. (10 *Jur., N. S.* 810; 10 *L. T. Rep., N. S.* 802).

278. *In re* MITCHELL'S PATENT: *In re* BROTHERTON'S PATENT. [1867]

A party who has not opposed the sealing of a patent before the law officer of the Crown under 15 & 16 Vict. c. 83, s. 12,

will not be allowed to oppose before the Lord Chancellor. (*L. R.*, 2 *Ch.* 343.)

279. *In re* VINCENT'S PATENT. [1867]

A person may give notice of objection, and oppose the sealing of a patent before the Lord Chancellor, without previously applying to the Court for leave to enter opposition. The Lord Chancellor, on an application for sealing a patent, will not interfere with the decision of the law officer of the Crown, unless in case of fraud or surprise, or of some material fact having come to the knowledge of the party since the case was before the law officer. (*L. R.*, 2 *Ch.* 341; 15 *W. R.* 524.)

Ex parte YATES. [1869] See **272**.

280 *Ex parte* SHEFFIELD. [1872]

In opposing the grant of letters patent, the burden is on the opponent to show that the grant would be clearly wrong. Where the facts on which the opponent relies were within his knowledge when he opposed before the law officer, he cannot, when before the Lord Chancellor, raise a new legal argument on these facts; nor can he then bring forward evidence which he might have brought before the law officer. (*L. R.*, 8 *Ch.* 237; 42 *L. J.*, *Ch.* 356.)

281. *In re* GETHING. [1874]

Where rival applicants had applied on the same day for patents, and had afterwards mutually agreed to withdraw opposition, letters patent bearing date the day of application were granted to one applicant, although letters patent bearing that date had already been granted to the other. On the hearing before the Lord Chancellor of a petition for the great seal to be affixed to letters patent, witnesses may be examined *vivâ voce*. (*L. R.*, 9 *Ch.* 633.)

282. *In re* HARRISON. [1874]

Applications were made for two patents for inventions alleged to be similar. The second applicant obtained a patent. The first applicant then presented a petition to have the great seal

affixed to letters patent for his invention, alleging that his delay had been caused by the representations of the second applicant, and also that the inventions were not similar. The Lord Chancellor examined the provisional specification of the first applicant, and the complete specification of the second applicant, and finding no substantial similarity between the inventions, directed the letters patent of the first applicant to be sealed. (*L. R.*, 9 *Ch.* 631.)

Delay.

283. *In re* BECK'S PATENT. [1784]

Letters patent bore date the 12th August, but a caveat was not discharged until the 27th, the patentee, thinking the letters patent bore date the latter day, did not enrol his specification till the 18th December, when the four months had elapsed:—Held, that the date of the patent could not be altered. (1 *Web. P. C.* 430.)

284. *In re* MACINTOSH'S PATENT. [1856]

Petition that certain letters patent for materials to be used in warfare might be sealed, notwithstanding the regular time for that purpose had elapsed. On the 6th August, 1855, petition, declaration, and provisional specification deposited. 18th December, warrant for sealing signed, and objections lodged on behalf of the Ordnance. 5th May, 1856, objections withdrawn. 22nd November, petition for sealing; order refused, on the ground that no reason was stated why the application was not made on or immediately after the 15th May. The present petition stated that this delay was owing to the fact that during the period that intervened between 5th May and 17th November, the petitioner was directed by the Secretary of State for War to delay taking the necessary steps for sealing the letters patent.

The Lord Chancellor, thought that, under the circumstances, the petitioner's case was made out, and ordered the letters patent to be sealed. (2 *Jur.*, *N. S.* 1242.)

In re BRENNARD'S PATENT. [1861] See 276.

285. *In re* HERSEE AND SMYTH. [1866]

The time within which the application for the warrant and for the letters patent ought to be made under the rules of the Patent Commissioners extended, where the delay was small and accidental. (*L. R.*, 1 *Ch.* 518; 14 *L. T. Rep.*, *N. S.* 842.)

Ex parte BAILEY. [1872] See **266**.

Inspection.

286. *In re* TOLSON'S PATENT. [1856]

An application under the 2nd section of the 16 & 17 Vict. c. 115, by a person opposing the grant of letters patent, for the inspection of the provisional specification of certain letters patent, on the ground that the subject-matter was the same as that for which the applicant had obtained a patent, refused. (6 *D.*, *M.* & *G.* 422.)

Affidavits.

287. *In re* M'KEAN'S PATENT. [1859]

Where a petition to have the great seal affixed to a patent had been filed, and the respondents served with notice two months before the first day of Michaelmas Term, for which day the petition was answered, and the respondents only filed affidavits on the morning of that day:—Held, that they could not be read; and the patent was ordered to be sealed. (1 *De G.*, *F.* & *J.* 2; 8 *W. R.* 1; 1 *L. T. Rep.*, *N. S.* 19.)

Substituted Service.

288. *In re* CAMPBELL'S PATENT. [1853]

Service of a petition for sealing a patent upon the solicitor of an opposing party, who was out of the jurisdiction, granted. (22 *L. T. Rep.* 93.)

*Costs.***289. *Ex parte* FOX.** [1812]

No costs will be given when the opposition is not unreasonable. (1 *V. & B.* 67; 1 *Web. P. C.* 431.)

290. *Ex parte* HENSON, *In re* ALCOCK'S PATENT. [1832]

Where a person has not opposed before the law officer, and is admitted to oppose the sealing under special circumstances, he will, if unsuccessful, be ordered to pay the costs. (1 *Web. P. C.* 432; 4 *My. & C.* 511.)

291. *In re* CUTLER'S PATENT. [1839]

A party, who has lodged an unsuccessful *caveat* against the granting of a patent, ordered to pay to the patentee the taxed costs occasioned by the *caveat*. *Semble*, such costs will be taxed upon the principle upon which costs in a cause are taxed as between party and party. (See report in this case for the allowances made on taxation.) (4 *My. & Cr.* 510.)

292. *In re* NICKEL'S PATENT. [1841]

Petition to re-seal an altered patent, *caveat* entered, and re-sealing refused. The Lord Chancellor ordered the petitioner to pay the opponent's costs. (Cit. *Hindmarch*, 536; 1 *Phillipps*, 36.)

293. *In re* M'KEAN'S PATENT. [1859]

Where a petition for sealing was answered for the first day of Michaelmas term, and the respondent having only filed his affidavits on that day, was not allowed to read them, and the patent was sealed, the Lord Chancellor refused to give costs against the respondent. (1 *De G., F. & J.* 2; 8 *W. R.* 1; 1 *L. T. Rep.*, N. S. 19.)

294. *In re* COPLEY'S PATENT. [1861]

Where notice of objections to the sealing a patent were filed and afterwards withdrawn, the costs of the objections and of

the petition rendered necessary by them were ordered to be paid by the objector. (31 *L. J.*, *Ch.* 333; 8 *Jur.*, *N. S.* 106; 5 *L. T. Rep.*, *N. S.* 387.)

Ex parte YATES. [1869] See 272.

295. *Ex parte* MANCEAUX. [1870]

When the sealing of a patent is opposed on the ground that the invention is similar to one which is the subject of an existing patent, a reference will be made to the law officer whether, having regard to the prior patent, the seal ought to be affixed to the patent as applied for, *the opponent paying the costs of the hearing*, unless there has been fraud on the part of the applicant. (*L. R.*, 5 *Ch.* 518.)

Filing Specification.

296. *Ex parte* HOOPS. [1802]

Enrolment of a patent cannot be dispensed with for the purpose of preventing the specification being made public. (6 *Ves.* 598.)

297. *WATSON v. PEARS.* N. P. [1809]

A patent, dated 10th May, contained a proviso that a specification should be enrolled within one calendar month next and immediately after the date thereof. The specification was enrolled on the 10th of June following:—Held, that the month did not begin to run till the day after the date of the patent, and that the specification was in time. (2 *Camp.* 294.)

298. *In re* BROUGH. [1844]

The clerk at the enrolment office cannot receive an enrolment conditionally, and the Master of the Rolls refused to cancel or vacate an enrolment of a specification which had been left at the office, and had been enrolled, notwithstanding directions not to enrol it until further order. (7 *Beav.* 104.)

299. *In re* CAMPBELL'S PATENT. [1853]

The Court refused to extend the time for filing specifications, &c., under the Patent Act, 1852, where there had been neglect or default. (22 *L. T. Rep.* 93).

300. *In re* SIMPSON & ISAACS' PATENT. [1853]

A petition for a patent was lodged on the 2nd October, and the warrant to seal the patent was issued on the 9th February following. By reason of objections having been filed to the application, and to the warrant to seal, the patentees were unable to file their specification within six months from the date of the letters patent. Time extended, on petition, to seven months. (21 *L. T. Rep.* 81.)

In re ADAMS' PATENT. [1853] See **574**.

301. *In re* HARRIS' PATENT. [1855]

Leave was granted to file a specification after the time for that purpose had expired, when the delay had arisen solely from the non-delivery of the letter containing the proper instruction for filing. (25 *L. T. Rep.* 90.)

Stamp Duty.

302. *HILL v. MOUNT.* [1856]

By an agreement between A. and B., it was agreed that A. should do all acts necessary, except the advance of money, for the purpose of procuring and perfecting certain letters patent, and should *immediately after the same were procured* execute an assignment of one-third share therein to B.; and B. agreed to pay all fees and disbursements that might be necessary for procuring the letters patent, enrolling the specification, and otherwise *perfecting* the same:—Held, that the execution of an assignment by A. was the whole consideration for the undertaking of B. to pay the sums mentioned in sect. 2 of 16 & 17 Vict. c. 5; and, consequently, a condition precedent to his right to sue B. for the non-payment thereof. (18 *C. B.* 72; 25 *L. J., C. P.* 190.)

303. WILLIAMS v. NASH. Ch. [1859]

The day of the date of the letters patent is excluded, and the three years do not expire until twelve o'clock at night of the anniversary of the day on which the letters patent are granted. (5 *Jur.*, *N. S.* 696; 28 *L. J.*, *Ch.* 886; 28 *Beav.* 93.)

304. SEQUELIN v. TERRELL. N. P. [1867]

In an action for not completing a patent for the full term of fourteen years:—Held, that, as the effect of the statute 16 & 17 Vict. c. 5, is to give a patent by instalments of three, four and seven years, a defendant would not be liable to pay the different sums of money required by the act till the expiration of these different periods. (16 *L. T. Rep.*, *N. S.* 539.)

*Countermanding Warrant.***305. In re SCHLUMBERGER'S PATENT.** [1853]

The Crown can at any time before affixing the great seal, under proper circumstances, countermand the warrant. (9 *Moo. P. C. C.* 1.)

THE GRANT.

Date of Letters Patent.

WATSON *v.* PEARS. N. P. [1809] See 297.

306. *Ex parte* HENSON, *In re* ALCOCK'S PATENT. [1832]

Where the sealing of letters patent was opposed before the Lord Chancellor, no opposition having been made before the law officers, and the matter is referred back to the Attorney-General, it was agreed that in the event of the patents being sealed, they should bear date as of the day they were first delivered at the Great Seal Office. (2 *Lon. Jour.*, C. S. 32.)

307. RUSSELL *v.* LEDSAM. [1845]

Original letters patent were granted on the 26th February, 1825, and renewed letters patent were dated on the 26th February, 1839:—Held, that the day of the date must be reckoned inclusively, and that the former term expired on the 25th February, 1839, and consequently the renewed letters patent were granted after the original letters patent had expired. (14 *M. & W.* 574.)

WILLIAMS *v.* NASH. Ch. [1859] See 303.

308. *Ex parte* BATES & REDGATE. [1869]

Where two parties apply for patents for similar inventions, and the second applicant first has the seal affixed, the first applicant will have his patent, if granted, dated as of the day of application for sealing. (*L. R.*, 4 Ch. 580.)

309. *Ex parte* BAILEY. [1872]

B. applied for a patent and obtained provisional protection on the 30th of March; C. on the 3rd of April. B. applied for the great seal on the 21st of May; C. obtained letters patent on the 22nd of May, antedated, according to the usual practice,

to the 3rd of April. The patents appearing to be partially for the same invention:—Held, that, whether the conduct of C. had or had not been fraudulent, the letters patent granted to B. must bear date on the 21st of May, and not on the 30th of March. (*L. R.*, 8 *Ch.* 60; 42 *L. J.*, *Ch.* 264.)

310. SAXBY v. HENNETT. [1873]

Two patents for the same invention were applied for on the 20th and 23rd of July, 1867, respectively. The patent applied for on the 23rd was sealed before that applied for on the 20th, but each patent was dated as of the day of application:—Held, that under the 15 & 16 Vict. c. 83, s. 24, the patents took effect as upon the days on which they were applied for respectively. (*L. R.*, 8 *Exch.* 210; 42 *L. J.*, *Exch.* 137.)

311. *Ex parte* HARRISON. [1874]

Where two inventors apply for patents for similar inventions, the second applicant at the Great Seal will be allowed to obtain his patent, but it will be dated as of the date of such application. (*L. R.*, 9 *Ch.* 632.)

Conditions and Terms of Grant.

312. *Ex parte* PERING. [1836]

A patent for the exclusive use of an improvement in the invention of anchors, contained a proviso for avoiding the patent, if the patentee should not supply for his Majesty's service all such articles of the invention as should be required, on such reasonable terms as should be settled by the Lords of the Admiralty. The latter used the invention, but did not take the articles from the patentee. The Court refused to issue a mandamus to them, to settle the terms according to the patent. (4 *A. & E.* 949; 6 *N. & M.* 472.)

313. *In re* DAINE'S PATENT. [1856]

B. had obtained letters patent at the cost of D., which had been at D.'s request assigned to H. Subsequently D. applied

for the grant of letters patent for an improvement in B.'s process. The Lord Chancellor being satisfied that D. had arrived at his knowledge of the improvement whilst working B.'s patent, ordered the patent to be sealed on certain terms as to assignment and licence to H. if he required them. (26 *L. J.*, *Ch.* 298.)

314. *In re* RUSSELL'S PATENT. [1857]

Where it appeared that a master and his foreman had both invented certain improvements, for which the master sought letters patent:—Held, that they ought only to be granted on the terms of their being vested in trustees for the master and the foreman. (2 *De G. & J.* 130.)

315. FEATHER *v.* THE QUEEN. [1865]

The Crown may use a patented invention without the assent or remuneration of the patentee. If the law were otherwise, the remedy of the patentee would not be by petition of right, but by action against the officer of the Crown using the patented invention. (8 *B. & S.* 257.)

316. DIXON *v.* LONDON SMALL ARMS CO. [1875]

The right of the Crown to use a patented invention, without the assent or remuneration of the patentee, does not extend to contractors supplying the patented article to, and indemnified against the patentee by, the Crown. (*L. R.*, 10 *Q. B.* 130; 31 *L. T. Rep.*, *N. S.* 830).

See also *Prolongation of Letters Patent—Terms imposed.*

Consideration for Grant.

317. *R. v.* MUSSARY. [1738]

Failure of consideration is a ground for avoiding the grant. (*Bull. N. P.* 76 *a*; 1 *Web. P. C.* 41.)

TURNER v. WINTER. [1787] See 421.

318. JESSOP'S CASE. [Before 1795]

Where letters patent were taken out for a watch, and the invention was only of a part of a watch, they were held void for false suggestion. (2 *H. Bl.* 490; 1 *Web. P. C.* 42, *n.*)

BAINBRIDGE v. WIGLEY. N. P. [1810] See **340.**

HILL v. THOMPSON. [1818] See **342.**

R. v. WHEELER. [1819] See **228.**

319. BRUNTON v. HAWKES. [1821]

Abbott, C. J.: "It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another." (4 *B. & Ald.* 551.) Bayley, J.: "If a patent is taken out for many different things, the entire discovery of all those things is the consideration upon which the King is induced to make the grant. That consideration is entire, and if it fails in any part it fails *in toto*. Upon an application for a patent, although the thing may be new in every particular, it is in the judgment of the Crown, whether it will or will not, as matter of favour, make the grant to the person who has made the discovery. And when an application is made for a patent, for three different things, it may be considered by the persons who are to advise the Crown as to the propriety of the grant, that the discovery as to the three things together may form the proper subject of a patent although each, *per se*, would not induce them to recommend the grant." (*Ib.* 552.) Best, J.: "The King is deceived; the patentee is represented to have the merit of inventing two things, whereas he has discovered only one; and the Crown might have considered the discovery, as to both, a sufficient ground for granting a patent, when it would not have thought so of the discovery of one alone. This has been compared, in argument, to the case of a grant of lands. If, in the same deed, there were included three conveyances of three distinct estates on three considerations, one might be set aside and another be good; but if the grant were upon one consideration which was bad, the whole would be void, because the consideration would fail altogether. Now

the present case is similar to that, because here, the consideration to induce the King to grant the patent, was the statement made by the plaintiff in his petition, that there had been three inventions, when, in fact, there had been only two. The united consideration upon which the whole grant was made, is therefore void; and, consequently, the grant itself is void." (*Ib.* 558.)

BLOXAM *v.* ELSEE. [1825] See **332**.

FELTON *v.* GREAVES. [1829] See **334**.

MINTER *v.* WELLS. N. P. [1834] See **232**.

MORGAN *v.* SEAWARD. [1837] See **335**.

320. FEATHER *v.* THE QUEEN. [1865]

A patent is not based upon a contract between the patentee and the Crown, in which the patentee, by communicating the secret of the invention to the public, gives a valuable consideration for the grant; but is simply an exercise of the royal prerogative. (8 *B. & S.* 285.)

Limited Grant.

321. *Ex parte* BATES AND REDGATE. Ch. [1869]

Where a provisional specification is filed, but, pending the six months' provisional protection, and before obtaining letters patent, a second inventor files a provisional specification, and obtains letters patent for an invention, partly covered by the first provisional specification, letters patent will not, in the absence of fraud, be granted to the first applicant, for any part of his invention which is covered by the letters patent already obtained by the second applicant. (*L. R.*, 4 *Ch.* 577; 38 *L. J.*, *Ch.* 501.)

*Cancelling.***322. R. v. NEWTON.** [1845].

This was an application heard before the Lord Chancellor, assisted by the Master of the Rolls, to compel the defendant to bring into court a certain patent, to have the same cancelled, and the seal cut therefrom. It appeared that the patent had been obtained by the defendant for a foreigner resident abroad, and that he had forwarded the patent to him. It was ordered that the enrolment of the patent should be cancelled; and, that a *vocator* should be entered on the roll; and that the defendant should undertake to bring no writ of error, or make any assignment of the patent. (26 *Lon. Jour.*, C. S. 361.)

TITLE OF PATENT.

Title generally.

323. HORNBLOWER *v.* BOLTON. [1799]

Grose, J., said: "I consider the patent (title) and specification so connected together as to make a part of each other, and that to learn what the patent is, I may read the specification, and consider it as incorporated with the patent." (*Dav. P. C.* 230.)

324. THE HOUSEHILL COMPANY *v.* NEILSON. N. P. [1843]

The title of a patent discloses the object of the invention. (1 *Web. P. C.* 678.)

325. THE ELECTRIC TELEGRAPH COMPANY *v.* BRETT. [1851]

Patent "for improvements in giving signals and sounding alarums in distant places, by means of electric currents transmitted through *metallic circuits*." Subsequently to the patent, it was discovered that the return current could be conducted back to the battery through the earth as effectually as through a continuous metallic circuit, and this was the method used by defendants. Cresswell, J., delivering the judgment of the court, said: "With regard to the use of the words 'metallic circuits' in the title of the patent, it was urged that the patentees, by using those words, would mislead a person who was in possession of improvements identical with the plaintiff's, but which he intended to use in giving signals by non-metallic circuits, and who might have opposed the grant of a patent of a more comprehensive title, but would acquiesce in one confined to metallic circuits. But it appears to us, that, whatever might be the case, supposing currents transmitted in the manner used by the defendants to have been known at the time of granting

the patent, or of giving notice of the application for it, the title did, in the actual circumstances of the case, that is to say, the earth-circuit not being publicly known, give sufficient notice to any person secretly acquainted with that discovery, or thinking it probable that some such discovery might be made, and having also invented improvements like those of the patentees, to put him on his guard, and on an inquiry how far the proposed patent might interfere with him." (10 *Com. B. Rep.* 881; 20 *L. J., C. P.* 130; 15 *Jur.* 582.)

326. NEWTON v. VOUCHER. [1851]

The title of a patent, which should be read in conjunction with the specification, may limit a patentee's claim, which would otherwise have voided the patent as being too large. (6 *Ex.* 866; 21 *L. J., Ex.* 308.)

327. HILLS v. THE LONDON GAS LIGHT COMPANY. [1860]

The title of a patent was for "an improved mode of manufacturing gas." The invention consisted in the application of the hydrated oxides of iron in purifying gas from sulphuretted hydrogen, and in renovating the oxides so used by exposure to the air. The court held this to be an improved mode of manufacturing gas. (5 *H. & N.* 370; 29 *L. J., Ex.* 424.)

Longness of Title.

328. REX v. ELSE. [1785]

The patent was for a new invented manufacture of lace, called French, or wire-ground lace. The specification went generally to the invention of mixing silk and cotton thread upon the frame. It was proved that this was not new. It was contended, in answer, that the former use was inadequate to the purpose of making lace on account of its coarseness, and that the patentee was the first to succeed in uniting strength and fineness. Buller, J., held the patent void, as the claim

(expressed in the title) went to the exclusive liberty of making lace composed of silk and cotton thread mixed, and not to any particular mode of making it. (1 *Web. P. C.* 76; *Dav. P. C.* 144; *Bull. N. P.* 76.)

329. COCHRANE v. SMETHURST. [1816]

A patent was granted for “a method or methods of more completely lighting cities, towns, and villages.” The invention described consisted of improvements in street lamps:—Held, that the patent was void, on the ground of the title being too large. The patent ought to have been taken for an improvement in street lamps. (*Dav. P. C.* 354; 1 *Stark. N. P.* 205.)

330. CAMPION v. BENYON. [1821]

Where a patent was obtained, for “a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, without any starch whatever,” and the specification described the invention to consist in an improved texture, or mode of twisting the threads, to be applied to the making of un-starched cloth; on its being proved that the exclusion of starch had been before adopted:—Held, that such patent was void, as being taken out for more than the patentee had really discovered. Dallas, C. J.: “If there be any ambiguity, either in the patent itself, or in the specification, in any material point, it is of itself a ground for rendering the patent absolutely void. (6 *B. Mo.* 71; 3 *B. & B.* 5.)

331. BRUNTON v. HAWKES. [1821]

A patent was granted for improvements in the construction of ships' anchors, windlasses, and chain cables. It was proved at the trial, that the windlasses and chain cables were new, but that the anchors had been before constructed and used. The patent was held bad for want of a consideration, upon the authority of *Hill v. Thompson*. Abbott, C. J., said: “The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improve-

ments, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention." (4 B. & Ald. 552.) Best, J., based his judgment expressly upon the ground of fraud. He said the patentee had "taken out his patent for more than he is entitled to; and I am of opinion, that that avoids the patent *in toto*. For the King is deceived; the patentee is represented to have the merit of inventing two things, whereas he has discovered only one; and the Crown might have considered the discovery, as to both, a sufficient ground for granting a patent, when it would not have thought so of the discovery of one alone. This has been compared, in argument, to the case of a grant of lands. If, in the same deed, there were included three conveyances of three distinct estates on three considerations, one might be set aside and another be good; but if the grant were upon one consideration which was bad, the whole would be void, because the consideration would fail altogether. Now the present case is similar to that, because here, the consideration to induce the King to grant the patent, was the statement made by the plaintiff in his petition, that there had been three inventions, when, in fact, there had been only two. The united consideration upon which the whole grant was made, is therefore void, and, consequently, the grant itself is void." (*Ib.* 558.)

332. BLOXAM v. ELSEE. [1825]

Action for the infringement of a patent for "a machine for making paper in single sheets, without seam or joinings, from 1 foot to 12 feet and upwards wide, and from 1 foot to 45 feet and upwards in length." It appeared in evidence, that the machine was so constructed as to be capable of producing paper of one definite width only, and that in order to vary the width a new machine was required. It was held by the Court of King's Bench, that the meaning of the patentee's representation was, that paper of various widths might be obtained by one and the same machine; and, as that representation, which was a material one, was not true, the consideration for the grant had failed, and the patent was void. (6 B. & C. 169; 9 Dow. & Ry. 215; 1 C. & P. 565.)

333. STURTZ v. DE LA RUE. [1828]

The patent was “for certain improvements in copper and other plate printing.” The specification declared that “the nature of the invention consisted in putting a glazed or enamelled surface on paper, to be used for copper and other plate printing, by means of whitelead and size, whereby the finer lines of the engraving are better exhibited than heretofore, and also in a mode of polishing the said enamel, and the impression after it has been drawn from the plate. Lord Lyndhurst, L. C.: “The description in the patent must unquestionably give some idea, and, so far as it goes, a true idea of the alleged invention, though the specification may be brought in aid to explain it. The title in this patent is for ‘certain improvements in copper and other plate printing.’ Copper-plate printing consists of processes involving a great variety of circumstances; the paper must be of a particular description: before it is used, it must be damped; it must remain damp a certain time, and must be placed in a certain temperature; the plate must be duly prepared, and duly applied, and various processes must be gone through, before the impression is drawn off and brought to a finished state. An improvement in any one of those circumstances,—in the preparation of the paper, for instance, or the damping it, &c.—may truly be called an improvement in copper-plate printing.” (5 *Russ.* 322.)

334. FELTON v. GREAVES. N. P. [1829]

A patent was granted for “a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments.” As the machine described in the specification would not do for sharpening scissors, the patent was held void. (3 *C. & P.* 611.)

335. MORGAN v. SEAWARD. [1837]

The patent was taken out “for certain improvements in steam engines and in machinery for propelling vessels; which improvements are applicable to other purposes.” The jury found that the alleged invention was not an improvement in steam

engines. Parke, J., delivering the judgment of the court, said: "Upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown. . . A patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill v. Thompson*, and *Brunton v. Hawkes*; for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute, the patent would be void as far as related to that which was old, yet the principle on which the patent has been held to be void altogether, is, that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it." (1 *Web. P. C.* 196; 2 *M. & W.* 561; *Mur. & H.* 60; 1 *Jur.* 529.)

336. STEAD v. WILLIAMS. N. P. [1843]

Action for the infringement of a patent "for making or paving public streets and highways, and public and private roads, courts and bridges, with timber or wooden blocks." The defendants pleaded, *inter alia*, "that the title, in its claim, was too large, uncertain, inapplicable, inexplicable, inconsistent, vague and ambiguous, and at variance with the specification." Cresswell, J., referring to this, said: "Whether it is too vague or not is rather a matter of law than anything else, and upon that I also say that I am in favour of the plaintiff. I think that it is not too vague, and therefore I advise you to find that issue for the plaintiff." (2 *Web. P. C.* 137.)

337. COOK v. PEARCE. [1844]

The patent was taken out "for improvements in carriages," and the invention was an improvement in German shutters, which could only be used in some kinds of carriages:—Held, that, by reason of the title of the invention being too large and general, the patent was void. Lord Denman, C. J., delivering the judgment of the Court of Queen's Bench, said: "If it were enough to state some improvement in a particular subject in the title of the letters patent, and the patentee were at liberty in

his specification to obtain a monopoly in the use of anything falling under that general description, he might employ the whole six months in making a discovery unknown to him when he obtained the patent. His *title* might even deprive a person, who should within the six months have made an original invention, of the right to use his own invention, although the patentee had not actually made it, and took out his patent without even suspecting that it could be made, and merely on a general speculation that he or some other person might possibly put in some improvement. . . . There is, to a certain extent, a resemblance between the title and the specification of a patent, in this, that the former must, though not with the same degree of particularity and minuteness of detail, describe the nature of the invention for which such patent is obtained." (8 *Q. B.* 1050; 12 *L. J.*, *Q. B.* 190; 7 *Jur.* 765.) The above decision was reversed on appeal. Tindal, C. J., delivering the judgment of the Exchequer Chamber, said: "The mere vagueness of the title appears to us to be an objection that may well be taken on the part of the Crown, before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown, in obtaining the patent with such title, the patent in those cases might, undoubtedly, be held void. Any evidence of a design on the part of the inventor to choose a vague and general title, in order that he might avail himself, at the time of the enrolling of the specification, of an invention not discovered by him at the time of taking out the patent, or in order to prevent other subjects of the Queen, from availing themselves of a discovery made by them, upon the ground of its falling within the range of the general terms of the title, although such invention was different from that for which the patent was really and in truth taken out, might afford such proof of fraud upon the Crown and such injury to the subject, as that the vagueness and generality of the title in such case might avoid the patent. But, in the present case, no such evidence was given, nor was the existence of fraud suggested; but the patent has been held void (in the court below), upon the mere ground of the title being so large

as to be capable of comprising a different invention from that which is described in the specification, and from no other cause." (8 *Q. B.* 1064; 8 *Jur.* 500; 13 *L. J.*, *Q. B.* 192.)

338. CROSSLEY v. POTTER. N. P. [1853]

Pollock, C. B., in summing up to the jury, said: "In the year 1842, Mr. Thompson, a weaver and machinist, takes out a patent for an improvement in weaving figured fabrics; and one of the objections of the defendants to the patent, stated in the notice of objections, is, that the patentee has taken out his patent for an invention entitled, 'Improvements in weaving figured fabrics,' and that these improvements are applicable to a certain class of figured fabrics only, namely, those which have a terry surface. That objection, in my opinion, is not well founded. The improvement in a particular portion of figured fabrics may be well called, I think, an improvement in weaving figured fabrics. Though it be not applicable to all, it is an improvement in the general weaving of figured fabrics; though it may not apply itself to any particular individual case, I think there is nothing wrong in that." (*Macr. P. C.* 242.)

339. NEWALL v. ELLIOTT. [1864]

Pollock, C. B., stated that he had, when Attorney-General, refused an application for a patent for "an improvement in locomotion," such a title being too general. (13 *W. R.* 15; 10 *Jur.*, *N. S.* 955.)

Variance between Title and Specification.

340. BAINBRIDGE v. WIGLEY. N. P. [1810]

Action for the infringement of a patent for improvements on the flageolet. The specification stated that by the improvements the instrument produced *notes* not before produced on the old instrument. It appeared also in evidence, that the invention was a great improvement, but that only *one new note* was produced. Ellenborough, C. J., held, that this was fatal to the patent, the consideration on which it was granted not being

truly stated. For the patentee had stated that, by his improvements, he had given *new notes*, when in fact he had given but *one new note*. (*Parl. Rep. Pat.* 1829, p. 197; 18 *Rep. Arts.* 127; 1 *Carp. P. C.* 270.)

341. REX v. METCALF. *Sci. fac.* [1817]

This was a *scire facias* brought to repeal a patent, obtained by the defendant, for the manufacture of hair brushes, which were described to be tapering brushes. The specification directed a method of making brushes in which the bristles would be of unequal lengths. Lord Ellenborough: "If the word tapering be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense." No such evidence being given there was a verdict for the Crown. The court subsequently refused a rule *nisi* for a new trial. (2 *Stark. N. P.* 249; 1 *Web. P. C.* 141, *n.*)

342. HILL v. THOMPSON. [1818]

A patent had been obtained for "the invention of certain improvements in the smelting and working of iron." The specification claimed certain improvements by which the iron in slags or cinders could be brought into the state of bar iron; and also the *discovery* of the employment of lime, to prevent that quality in iron called "cold short." At the trial for an infringement of the patent it was proved, that the lime had been used for the above purpose before the date of the patent. And further, that the iron from slags and cinders had been before obtained when those materials were used in various proportions:—Held, that the patent was void, as the specification claimed, not an improvement upon the previous use of lime, but the *discovery* of its power of preventing cold short; and "if any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." (8 *Taunt.* 375; 1 *Web. P. C.* 239; 2 *B. Moore*, 433.)

343. REX v. WHEELER. *Sci. fac.* [1819]

Patent for "a new and improved method of drying and preparing malt." The specification described an invention which consisted in submitting malt, prepared by the ordinary process, to a high degree of temperature, and thus producing a colouring material for beer:—Held, that the patent was void, on the ground (*inter alia*), that the patent was for a different thing from that described in the specification. Abbott, C. J., delivering the judgment of the court, said: "The language of the patent may be explained and reduced to certainty by the specification; but the patent must not represent the party to be the inventor of one thing, and the specification show him to be the inventor of another; because, perhaps, if he had represented himself as the inventor of that other, it might have been well known that the thing was of no use, or was in common use, and he might not have obtained a grant as the inventor of it. . . . It was contended that this process was in truth a preparation of malt to answer a particular purpose, and that the purpose need not be noticed in the grant. It may be true in general that the purpose need not be mentioned in the grant; but if in any particular case the mention of the purpose be necessary to explain the words previously used, to show that they were not used in their ordinary and obvious sense, but in a sense limited and confined to that particular purpose; in such a case, we think, the purpose ought to be mentioned." (2 *B. & Ald.* 345.)

344. CROSSLEY v. BEVERLEY. [1829]

In moving for a nonsuit it was objected that the patent was void, as, between the date of the patent and the specification, the patentee had invented improvements in the apparatus, which he described in the specification as part of his invention:—Held, that the insertion of these improvements in the specification not only did not render the patent void, but that it was the duty of the patentee to communicate them to the public. (9 *B. & C.* 63; 1 *Web. P. C.* 112.)

345. FISHER v. DEWICK. [1838]

The patent was for improvements in machinery for making bobbin net lace. The invention was for making a spot during a particular part of the process, and was useless where that addition was not wanted. The Judge at Nisi Prius held the title to be sufficient, and the Court of Common Pleas refused a *rule nisi* for a new trial, on the ground of misdirection; Tindal, C. J., observing that it could not, without great refinement, be said, that the invention was not an improvement in the manufacture of bobbin net lace. (Not reported on this point. Cited in the agreement in *Cook v. Pearce*, 8 Q. B. 1056.)

346. NEILSON v. HARFORD. [1841]

The patent was granted for “an invention for the improved application of air to produce heat in fires, forges, and furnaces, where bellows and other blowing apparatus are required.” The invention consisted in passing the air, from the blowing apparatus, into an artificially-heated receptacle, and from thence to the furnace. It was objected, that it was doubtful whether the patent was for the invention of the application of hot air, or only for an improved mode of applying hot air. Abinger, C. B., said: “If the specification is consistent with the title, that would be sufficient.” Parke, B., delivering the judgment of the court, said: “The title of the patent is for ‘the improved application of air.’ Though that is ambiguous, it is sufficiently explained by the specification, and is not at variance with it, as was the case in *Rex v. Wheeler*.” (8 M. & W. 806; 1 Web. P. C. 331.)

347. NICKELS v. HASLAM. [1844]

The plaintiff obtained letters patent for “improvements in the manufacture of plaited fabrics.” The specification described that which together amounted to but a single improvement in the mode of manufacture:—Held, upon the authority of *Cook v. Pearce*, that this was not such an inconsistency between the title of the patent, and the description in the specification, as to invalidate the patent. (8 Scott, N. R. 97; 7 M. & G. 378; 8 Jur. 474; 13 L. J., C. P. 146.)

348. BEARD v. EGERTON. [1846]

The title described the patent to be for "a new *or* improved method of obtaining the spontaneous reproduction of all the images received in the focus of the camera obscura." The title was held to be sufficient, on the authority of *Neilson v. Harford*, and *Nichols v. Haslam*. Cresswell, J., said: "If *part* of the method be new, so as to produce a result that as a whole is new, surely it may be called a new or improved method. If the method be altogether new, may it not be properly called an improved method? They seem to be convertible terms." (3 C. B. 97; 15 L. J., C. P. 270.)

349. CROLL v. EDGE. [1850]

A patent was granted "for certain improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas." In the specification, the words "therein and" were interpolated between "used" and "when." So that the specification was represented to be "for improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used *therein and* when transmitting and measuring gas." The patent was held bad, as the patentees specified for "a more extensive and different patent from that which was granted to them." (9 C. B. 479; 14 Jur. 553; 19 L. J., C. P. 261.)

350. REGINA v. MILL. [1850]

The title of the patent was "for improvements in instruments used for writing and marking, and in the construction of inkstands;" and the specification, as amended by the disclaimer, described pens and pencils, and improvements in the construction of inkstands:—Held, that there was no variance. (10 C. B. 379; 1 L. M. & P. 695; 15 Jur. 59; 20 L. J., C. P. 16.)

351. PATENT BOTTLE ENVELOPE COMPANY v. SEYMER.
[1858]

A patent was granted for "improvements in the manufacture of cases or envelopes for covering bottles." The specification,

after describing the apparatus, in the arrangement of which the invention was stated to consist, claimed the combination of mechanism, and the making of envelopes for bottles as described:—Held, that the specification was for the mode of making, and not for the envelope; and that it was, therefore, not larger than the grant. (28 *L. J.*, *C. P.* 22; 5 *C. B.*, *N. S.* 164; 5 *Jur.*, *N. S.* 174.)

352. OXLEY v. HOLDEN. [1860]

The title was “for certain improvements in the doors and sashes of *carriages*.” The specification stated, that the improvements were applicable “in any position where windows and doors are subject to jar and vibration.” Erle, C. J., delivering the judgment of the court, said: “It seems to us reasonable that the claim should be construed with reference to the title, and confined accordingly to the doors and windows of carriages. The present case has no analogy to the decision of this court in *Croll v. Edge*.” (8 *C. B.*, *N. S.* 707; 30 *L. J.*, *C. P.* 74; 8 *W. R.* 627; 2 *L. T.*, *N. S.* 464.)

353. PENN v. BIBBY: PENN v. JACK. [1866]

Evidence may be given, under an issue as to the sufficiency of the specification, to prove a variance between the complete specification and the title, or provisional specification. (*L. R.*, 2 *Ch.* 130; 36 *L. J.*, *Ch.* 458; 15 *L. T. Rep.*, *N. S.* 401; 15 *W. R.* 211.)

354. PARKES v. STEVENS. [1869]

A patent was entitled for “improvements in the manufacture of railway station and other gas lamps,” but the specification claimed only (by reference to a former specification) improvements in “that class of lanterns suitable for suspension in railway stations and other public places.” Whether the patent was confined to lamps suspended, *quære*. (*L. R.*, 8 *Eq.* 358; 38 *L. J.*, *Ch.* 627.)

355. WRIGHT v. HITCHCOCK. [1870]

Patent “for the invention of improvements in the manu-

facture of frills or ruffles, and in the machinery or apparatus employed therein." The provisional specification described the invention, as relating to the manufacture of frills or ruffles, but the complete specification extended the invention to the manufacture of frills, ruffles, or trimmings. Held, that as the words "frills, ruffles, and trimmings," are all *ejusdem generis*, and as they are only important as showing what it is that is ultimately to be made by the machinery, of which alone the plaintiff claims to be the inventor, the variation is not such as to render the patent invalid. (*L. Rep.*, 5 *Ex.* 37 ; 39 *L. J.*, *Ex.* 97.)

PROVISIONAL SPECIFICATION.

356. *In re* NEWALL AND ELLIOTT. [1858]

A. was the inventor of "improvements in apparatus employed in laying down submarine electric telegraph wires." In the provisional specification the invention was thus described: "The cable or rope containing the insulated wire or wires is passed round a cone, so that the cable in being drawn off the coil is prevented from kinking, by means of the cone, and there is a cylinder on the outside, which prevents the coil from shifting in its place." In the complete specification, after describing the invention in the same terms, the inventor proceeds to say: "When the wire or cable is to be laid down, I place over the cone an apex or top, which is conoidal or conical, and round this I suspend several rings of iron or other metal by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is, to prevent the bight of the rope from flying out when going at a rapid speed, and the combination of these parts of the apparatus prevents the wire or cable from running into kinks:" and the claim at the end ran thus: "What I claim as my invention is, first, coiling the wire or cable round a cone; second, the supports placed cylindrically outside the coil round the cone; third, the use of rings in combination with the cone as described." Held, that the validity of the patent was not affected by the omission of all mention of the metal rings in the provisional specification. Byles, J., delivering the judgment of the court, said: "The office of the provisional specification is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out; otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed, the statute itself indicates this distinction

between the provisional and the final specification ; for, it calls the latter the *complete* specification, implying that the former is, or may legally be, in some respects executory and incomplete. Moreover, it enacts (s. 6) that the provisional specification is to describe *the nature* of the invention, and no more ; but when the statute comes to speak of the complete specification, its language is altogether different ; it enacts (s. 9) that the complete specification shall describe, not only the nature of the invention, but also the manner in which it shall be performed ; and not only describe, but particularly ascertain it." (4 *C. B.*, *N. S.* 269 ; 4 *Jur.*, *N. S.* 562 ; 27 *L. J.*, *C. P.* 337.)

357. MACKELCAN v. RENNIE. [1862]

Action for the infringement of a patent for "improvements in floating docks." It was proved, during the trial at Nisi Prius, that the construction was not novel, floating docks having been previously constructed of *timber*. The plaintiff then alleged his invention to consist entirely in the use of *iron* in their construction, according to the mode pointed out in the specification. The provisional specification did, but the complete specification did not, mention iron as being used in the construction. Erle, C. J. (affirmed by the Court of Common Pleas), held, that the provisional specification could not be prayed in aid for the purpose of supplying a defect in the subsequent complete specification. (13 *C. B.*, *N. S.* 52.)

358. NEWALL v. ELLIOTT. [1864]

Pollock, C. B. : "The object of the statute, which requires a provisional specification, is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for the patent, to give some notion of what his invention is. That has been followed up by an act of parliament requiring it to be done ; but the object in both cases is to ascertain the identity of the invention, and to make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance I have no doubt that the object of the act

of parliament was not to ascertain the entirety of the invention, but the identity of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury, ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." (10 *Jur.*, *N. S.* 955.) Channel, B.: "I entirely adopt the test which my Lord Chief Baron suggested—that the question is as to the identity of the invention, which is disclosed by the full specification, with that of which a short note or minute was made in the provisional specification." (10 *Jur.*, *N. S.* 960.)

359. FOXWELL *v.* BOSTOCK. Ch. [1864]

The provisional and complete specifications of a patent ought not so to differ, as that the nature of the invention as described in the one, shall be materially different from the nature of the invention, as described in the other. (4 *De G.*, *J. & S.* 298; 12 *W. R.* 723; 10 *L. T. Rep.*, *N. S.* 144.)

360. PENN *v.* BIBBY: PENN *v.* JACK. Ch. [1866]

Chelmsford, L. C., in the course of his judgment, said: "It seems clear from these sections (Patent Law Amendment Act 1852, sects. 6 and 8) that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officer what is to be the subject-matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes in which the invention is to be worked or carried out. That is left to the complete specification, which, by sect. 9 of the act, must not only describe and ascertain the nature of the invention, which, of course, must be of no other than that described in the provisional specification, but also in what manner the same is to be performed, which is not at all required to be explained by the provisional specification. The filing of the provisional specification, by the express provisions of the statute, protects the invention for six months, and gives the patentee, during this

period, the like powers, rights, and privileges, as might have been conferred upon him by letters patent. The object of this protection evidently is, to enable the patentee to perfect his invention by experiments, which, although open and known, will not be a user and publication to the prejudice of letters patent to be afterwards granted, so that he may be in a condition to describe in his complete specification, as the result of his experience, the best manner of performing the invention. It clearly appears, therefore, that the complete specification is, in a sense, supplemental to the provisional specification, not going beyond, nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional specification, as to the manner in which the invention is to be performed. From this description of the different offices of the two specifications, it follows that upon an issue 'whether the specification, enrolled in pursuance of the letters patent, describes and ascertains the nature of the invention,' if the claim in the complete specification is comprehended within the terms of the provisional specification, that issue will be satisfied. The relation which the provisional specification bears to the complete specification is much the same as that which, before the Patent Law Amendment Act, the title bore to the specification. The observations of Tindal, C. J., in *Cook v. Pearce*, are as applicable to the provisional specification now, as they were to the title formerly. That learned Judge says; 'The vagueness' (he had previously spoken of the vagueness and generality) 'of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void.' These remarks, applied to the title of the patent, have a stronger application to the case of a provisional specification under the Patent Law Amendment Act, because the law officer, if he thinks the specification too large, can order it to be amended.

And, if no objection is made by him, the generality of the specification, to repeat the words of Chief Justice Tindal, affords no ground for avoiding the patent after it is granted." (*L. R.*, 2 *Ch.* 132.) "Nor is it at all necessary that the complete specification should extend to everything comprehended within the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now, if he would be allowed to disclaim in such a case, which is matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand." (*L. Rep.*, 2 *Ch.* 134.)

361. THOMAS v. WELCH. [1866]

Any part of the provisional specification of a patent may be omitted in the complete specification, if there is no fraud, and the effect of the remainder is not altered by the omission. (*L. R.*, 1 *C. P.* 192; 12 *Jur.*, *N. S.* 316; 35 *L. J.*, *C. P.* 200.)

COMPLETE SPECIFICATION.

Sufficiency of, generally.

362. ARKWRIGHT *v.* NIGHTINGALE. N. P. [1785]

Lord Loughborough: "One of the requirements (of the patent law) is, that a specification shall be enrolled, stating the nature of the invention; the object of which is, that after the term is expired the public shall have the benefit of the invention, but without that condition is complied with, the patentee forfeits all the benefit he derives from the great seal." (*Dav. P. C.* 55; 1 *Web. P. C.* 61.)

363. BOULTON *v.* BULL. [1795]

Action for the infringement of a patent for lessening the consumption of steam and fuel in fire-engines. The defendants contended (*inter alia*) that the patentee had not sufficiently specified his invention. Eyre, C. J., in the course of his judgment, said: "The substance of the invention is a discovery, that the condensing the steam out of the cylinder, and protecting the cylinder from the external air, and keeping it hot to the degree of steam heat, will lessen the consumption of steam. Now, the specification of such a discovery seems to consist in nothing more than saying to the constructor of a fire-engine, 'for the future condense your steam out of the body of the cylinder, instead of condensing it within it, put something round the cylinder to protect it from the external air, and to preserve the heat within it, and keep your piston air-tight without water.' Any particular manner of doing this, one should think, would hardly need be pointed out, for it can scarcely be supposed, that a workman capable of constructing a fire-engine would not be capable of making such

additions to it as should be necessary to enable him to execute that which the specification requires him to do." (2 *H. Bl.* 497.) "Suppose a new invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary, in order to this operation, that the gold should be put into a crucible, and should be melted in that crucible ; but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold into a state of fusion was to be performed. These are mere incidents with which every man acquainted with the subject is familiar." (*Ib.* 498.) Rooke, J., said : "As to the second objection, that no particular engine is described, that no model or drawing is set forth, I hold this not to be necessary, provided the patentee so describes the improvement as to enable artists to adopt it when his monopoly expires." (*Ib.* 479.)

364. HORNBLOWER v. BOULTON. [1799]

Grose, J., said : "By a proviso in the patent, the patentee is bound particularly to describe and ascertain the nature of his invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and to cause the same to be enrolled in chancery. On which another question arises, namely, whether the specification enrolled be sufficient. The aim of the legislature is obvious ; on the one hand, it was to encourage ingenious artificers and able and studious men to invent and bring forward, for the use of the public, new manufactures, the produce of their own ingenuity, by holding out to them the reward of fourteen years' monopoly ; on the other hand, to secure to the public the benefit of the discovery, by causing to be enrolled a complete description of the thing to be done, and the manner of doing it, that others might be fully informed of it ; and, at the end of the fourteen years, to be enabled to work or make the manufacture of which the patentee was the inventor." (8 *T. R.* 100 ; *Dav. P. C.* 227.)

365. NEWBERY v. JAMES. Ch. [1817]

Eldon, L. C.: "In order to support a patent, the specification should be so clear, as to enable all the world to use the invention as soon as the term for which it had been granted was at an end." (2 *Mer.* 451; 1 *Carp. P. C.* 368.)

366. R. v. WHEELER. *Sci. fac.* [1819]

Patent for "a new or improved method of drying and preparing malt." In the specification it was stated, that the invention consisted in exposing malt previously made to a very high degree of heat: but it did not describe any new machine invented for that purpose; nor the state, whether moist or dry, in which the malt was originally to be taken for the purpose of being subjected to the process; nor the utmost degree of heat which might be safely used; nor the length of time to be employed; nor the exact criterion by which it might be known when the process was accomplished. Held, that the specification was not sufficiently precise. (2 *B. & Ald.* 345; 1 *Carp. P. C.* 394.)

Abbott, C. J., in delivering the judgment of the court, said: "It was argued that the term 'malt' is applied to the grain as soon as it has germinated by the effect of moisture, and before it has been dried; that malt in that state might be taken and used for the objects of the defendant's invention; and, as these were to be accomplished by heat, his was an invention for drying malt. But, if this were so, then the specification would be defective in not informing the reader that the malt to be used for the intended object might or ought to be taken in that state, and in leaving him to discover, by experiment, whether it should be taken in that state, or after drying, which, according to the most common use of the word malt, he might very reasonably suppose." (2 *B. & Ald.* 353.)

367. BRUNTON v. HAWKES. [1821]

Best, J.: "The specification must embrace two objects; it must first clearly describe the nature of the invention; and secondly, the manner in which it is to be performed." (4 *B. & Ald.* 556.)

368. FELTON v. GREAVES. N. P. [1829]

A patent was granted for a machine to sharpen knives and scissors, and, in the specification, this was directed to be done by passing their edges backward and forward, in an angle formed by the intersection of two circular files; and in the specification it was also stated, that other materials might be used according to the delicacy of the edge. It was proved that, for scissors, there ought to be one circular file and a smooth surface, but that two Turkey stones might also succeed. Held, that the specification was bad, as it neither directed the machines for scissors to be made with Turkey stones, nor to be made with one circular file and a smooth surface. (3 *C. & P.* 611.)

369. SAUNDERS v. ASTON. [1832]

The patent was for "improvements in constructing or making buttons." The specification claimed the invention to be an improvement, upon a prior invention of the plaintiff's, by substituting flexible for metal shanks to buttons. This, however, was proved not to be new. The specification also described the application of a toothed collet in the production of the flexible shanks in a particular way, which was new; but it did not anywhere appear in the specification, that the patentee relied upon the collet as a material part of his invention, and there were other modes in which the object of the invention could be accomplished. Held, that as the patentee had not claimed the use of the particular mode of substituting the flexible shank by means of the toothed collet, the patent was void. (3 *B. & Ad.* 881.)

370. DEROSNE v. FAIRIE. [1835]

Patent for certain improvements in extracting sugar or syrup from cane-juice and other substances containing sugar, and in refining sugar and syrup. In the specification the patentee said: "The invention consists in a means of discolouring syrups of every description by means of charcoal, produced by the distillation of bituminous schistus alone, or mixed with

animal charcoal, and even of animal charcoal alone." The specification then stated that the "discolouration" was to be produced by means of a filter of the charcoal, and continued: "The carbonization of bituminous schistus has nothing particular; it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it." The specification said nothing as to any previous operation on the syrup before it was submitted to the filter, but it did state that syrup in a proper state might be obtained by a mixture of sugar and water. The defendant objected to the sufficiency of the specification.

Held, first, upon proof that the invention was applicable with advantage to the syrup, after it had undergone a certain degree of heat, though it failed when applied to the first drawings of the syrup, that the specification was sufficient. Secondly, that it was incumbent on the patentee to prove, that the presence of iron in the bituminous schistus, used in the process of filtering, would not be injurious; or else, that the method of extracting the iron from it was so simple and well known, that a person ordinarily acquainted with the subject could remove it with ease; or, that the bituminous schistus, as known in England, could be used in the process with advantage. (5 *Tyr.* 393; 2 *Cr. M. & R.* 476; 1 *Gale*, 109; 1 *Web. P. C.* 158.)

Abinger, C. B., said: "Thus then it appearing by the evidence that in all the various forms in which the article (bituminous schistus) exists in this country, sulphuret of iron is found, and the witnesses not describing any known process by which it can be extracted, it appears to me that the plaintiff ought to prove one of two things—either that the sulphuret of iron in bituminous schistus is not so absolutely detrimental as to make its presence disadvantageous to the process (in which case this patent would be good), or that the process of extracting the iron from it is so simple and well known, that a man may be able to accomplish it with ease." (1 *Web. P. C.* 162.) Alderson, B., said: "A specification must state one or more methods which can be followed for the purpose of accom-

plishing and carrying into effect the invention. . . . Had it been shown, either that bituminous schistus, deprived of iron, could be made by a process known to ordinary chemists of skill, or that it was a substance capable of being ordinarily purchased in the market as an article of commerce, it would have been unnecessary to have shown the operation of separating the iron from it; if its presence in the bituminous schistus was a positive detriment to the process of depriving the sugar of colour, then indeed the patent would fail." (*Ib.* 165.)

371. MORGAN v. SEAWARD. N. P. [1836]

Alderson, B., in addressing the jury, said: "It is the duty of a party who takes out a patent to specify what his invention really is, and although it is the bounden duty of a jury to protect him in the fair exercise of his patent right, it is of great importance to the public, and by law it is absolutely necessary, that the patentee should state in his specification, not only the nature of his invention, but how the invention may be carried into effect. Unless he be required to do that, monopolies would be given for fourteen years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect. . . . He (the patentee) has described two inventions, and if either of those inventions is insufficiently specified, the patent fails; for if a person runs the hazard of putting two inventions into one patent, he cannot hold his patent, unless each can be supported as a separate patent. (1 *Web. P. C.* 173). . . . The public, on the one hand, have a right to expect and require that the specification shall be fair, honest, open and sufficient; and on the other hand, the patentee should not be tripped up by captious objections which do not go to the merits of the specification. (*Ib.* 174). . . . You should discard, on both sides, all exaggerated cases, and look to the substance of the thing. If you think in substance that the information really

communicated would be enough in all ordinary cases, or in such cases as are likely to occur, then that would do." (*Ib.* 180).

372. KAY v. MARSHALL. [1839—41]

A patent was taken out for "new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances, by power;" and, by the specification, the invention was declared to consist of "new machinery for macerating flax, and other similar fibrous substances, previous to drawing and spinning it; and also of improved machinery for spinning the same after having been so prepared." The only alleged improvement in the spinning machinery was declared to be "placing the drawing rollers only two inches and a half from the retaining rollers," which was nearer than they had ever before been placed for the purpose of spinning *flax*. It appeared, however, that spinning machines were always so constructed, as, by means of slides, to allow the distance of the rollers to be varied according to the staple or fibre of the article to be spun; and that *cotton* had always been spun with a reach of less than two inches and a half. Held, that this was not the proper subject of a patent, though the jury found that the invention was both new and useful; and, consequently, that the specification, being void as to part, was void altogether. (7 *Scott*, 548; 5 *Bing. N. C.* 492; 2 *Arn.* 78; 5 *Jur.* 1028; 8 *C. & F.* 245; *West*, 682.)

373. NEILSON v. THOMPSON. [1841]

Cottenham, L. C.: "The public are entitled to know for what it is that the patentee claims the invention, that they may be saved inconvenience upon the subject; therefore, the specification must tell the public for what it is that he claims protection." (1 *Web. P. C.* 283.)

374. WALTON v. POTTER. N. P. [1841]

The specification is the price paid by the inventor for the patent he obtains. (1 *Web. P. C.* 595.)

375. HOLMES v. LONDON & NORTH WESTERN RAILWAY COMPANY. [1852]

Jervis, C. J., said: "The object of the condition in the patent requiring a specification is twofold; first, that useful novelties should be given to the public, of which, at the end of the term granted to the patentee, they should have the full benefit; and, secondly, that no person should inadvertently infringe the rights of the patentee during the term for which the patent has been granted." (*Macr. P. C.* 16.)

376. CROSSLEY v. POTTER. N. P. [1853]

Pollock, C. B., said: "This patent is taken out for the making of coach lace, carpets, velvets, and velveteens of all sorts, and it must be competent to do all and every part of that work, by the means stated in the specification, otherwise the patent is not good. . . . A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind and the introduction of other inventions adapted to the particular subject to which the invention may be applicable,—a patent which has for its object to snatch and grasp at everything in all directions which may possibly come within the general language the patentee may choose to adopt in his specification,—a patent, the object of which is, not to benefit the world by its communication, but to obstruct, by the very general character of the claims made for conferring peculiar privileges on the patentee; such a patent as that, in my judgment, cannot be supported." (*Macr. P. C.* 245.)

377. HILLS v. LONDON GAS LIGHT COMPANY. [1860]

Pollock, C. B.: "The condition that a patentee shall specify is introduced into letters patent in order to prevent patents being granted for known things, and to secure the public the benefit of new inventions." (5 *H. & N.* 340.)

378. MORTON v. MIDDLETON. [1863]

Lord President: "In judging of the sufficiency of a specification, it is necessary to see whether the patentee sets forth clearly the nature of his invention, and sets it forth so as to serve the double purpose—first, of showing a workman of ordinary knowledge and skill how he can construct the thing specified in the patent; and, second, of showing persons who read the patent what they must avoid doing if they would not infringe the patent." (1 *Cr. S.*, 3rd series, 721.)

379. THOMAS v. WELCH. [1866]

It is necessary that the specification should state the object of the invention, and the means by which the patentee proposes to effect it. (*L. R.*, 1 *C. P.* 201.)

380. BETTS v. NEILSON. Ch. [1868]

Whether a specification contains a sufficient description can only be ascertained by experiment; and, in making the experiment, knowledge and means may be employed which have been acquired since the date of the patent. (*L. R.*, 3 *Ch.* 429.)

*To whom it must be intelligible.***381. REG. v. ARKWRIGHT.** *Sci. fac.* [1785]

Buller, J.: "It has been truly said by the counsel, that if the specification be such that mechanical men of common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that the mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own." (1 *Web. P. C.* 66; *Dav. P. C.* 106.)

382. ARKWRIGHT v. NIGHTINGALE. N. P. [1785]

Lord Loughborough: "The clearness of the specification must be according to the subject-matter of it; it is addressed to persons in the profession having skill in the subject, not to men of ignorance, and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible." (*Dav. P. C.* 37; 1 *Web. P. C.* 60.)

BOULTON v. BULL. [1795] See **363.**

383. HORNBLLOWER v. BOULTON. [1799]

Grose, J., said: "I shall content myself with repeating what was said by one of the learned judges of the Court of Common Pleas, that if the specification be such as to enable artists to adopt the invention and make the manufacture, it is sufficient." (*Dav. P. C.* 228.)

Lord Kenyon, C. J.: "No technical words are necessary to explain the subject of a patent." (*Ib.* 224.)

384. HARMAR v. PLAYNE. [1809]

Ellenborough, C. J., in the course of the argument, said: "When Lord Mansfield said, in the case of *Liardet v. Johnson*, that the meaning of the specification was, that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch." (*Dav. P. C.* 318.) And again: "The object of requiring a specification to be enrolled seems to be to enable persons of reasonable intelligent skill in the subject-matter, to tell from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed." (*Ib.* 316.)

385. MANTON v. MANTON. [1815]

Gibbs, C. J.: It is necessary that the patentee "should show that he has accurately explained the nature of his inven-

tion in his specification, separating that which is new from that which is old, so as to enable a person of *tolerable* skill to make the thing by means of his specification." (*Dav. P. C.* 349.)

386. STURZ v. DE LA RUE. Ch. [1828]

The specification must describe the invention in such a way that a person of *ordinary* skill in the trade shall be able to carry on the process. (*5 Russ.* 327.)

387. CROSSLEY v. BEVERLEY. N. P. [1829]

It appeared from the evidence that the specification did not give any directions respecting a condenser, which was well known to be an essential part of every gas apparatus. It was objected for the defendant that the things comprised in the specification would not make a gas apparatus, because it would be incomplete for want of a condenser. Tenterden, C. J., however, held, that a workman who was capable of making a gas apparatus would know that he must put that in, and that although the specification did not direct a condenser to be put in, yet, as it did not say that it was to be left out, it was sufficient. (*3 C. & P.* 513; *Mo. & Mal.* 283; *1 Web. P. C.* 106.)

388. CORNISH v. KEENE. N. P. [1835]

In the absence of evidence on the part of the defendants that persons could not understand, or have been misled by the specification, it is sufficient for the plaintiff to call persons who say that to them it is clear. (*1 Web. P. C.* 502.)

389. MORGAN v. SEAWARD. N. P. [1836]

The defendant put in evidence a model, made according to the specification, which would not work on account of one part being a little too small.

Alderson, B., referring to this, said: "A workman of ordinary skill when told to put two things together, so that they should move, would, of course, by the ordinary knowledge and

skill he possesses, make them of sufficient size to move. There he would have to bring to his assistance his knowledge that the size of the parts is material to the working of the machine. That is within the ordinary knowledge of every workman. . . . What is required is, that the specification should be such as to enable a workman of ordinary skill to make the machine; with respect to that, therefore, I do not apprehend you will feel much difficulty." (1 *Web. P. C.* 176.)

390. GALLOWAY v. BLEADEN. N. P. [1839]

Tindal, C. J.: The specification must contain "such a fair and clear statement, that a person with a competent degree of knowledge upon the subject-matter to which the patent relates, would be able to make that which the plaintiff enjoys the exclusive privilege of." (1 *Web. P. C.* 524.)

391. ELLIOTT v. ASTON. N. P. [1840]

Coltman, J., said: "The patentee must give such a description in his specification as would enable a workman of competent skill, conversant with the trade, to carry the invention into effect." (1 *Web. P. C.* 224.)

392. BICKFORD v. SKEWES. [1841]

The specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufactures to which it relates. (1 *Q. B.* 938; 1 *Web. P. C.* 214; 10 *L. J.*, *Q. B.* 302.)

393. NEILSON v. HARFORD. [1841]

A specification is sufficient, if it enables a person of *ordinary skill and knowledge* of the subject, to construct the patented machine.

Parke, B., said to the jury: "You are not to ask yourselves the question, whether persons of great skill, a first-rate engineer, or a second-class engineer, as described by Mr.

Farey—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would upon a mere hint in the specification probably invent a machine which should answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed; it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity to the subject.” (1 *Web. P. C.* 314.) In the course of the argument in the Court of Exchequer, Abinger, C. B., said: “Where the specification uses scientific terms, which are not understood except by persons acquainted with the nature of the business, the specification is not bad because an ordinary man does not understand it, provided a scientific man does; but where the specification does not make use of technical terms, where it uses common language, and where it states that by which a common man may be misled, though a scientific man would not—when it does not profess to use scientific terms, and an ordinary man reading the specification is misled by it—it would not be good.” (*Ib.* 341.)

394. GIBSON v. BRAND. N. P. [1842]

The specification ought to be so clearly worded as to enable any person of sufficient understanding on the particular subject to attain the result without doubt or difficulty, it being the price paid by the inventor for keeping the public out of the enjoyment of the manufacture. (1 *Web. P. C.* 629.)

395. THE HOUSEHILL COMPANY v. NEILSON. N. P. [1842]

It is not necessary that the apparatus, described in the specification, should be productive of the greatest amount of benefit; it is sufficient if an ordinary workman, acquainted with the subject, could, by following the specification, construct an apparatus productive of some benefit. Lord Justice Clerk Hope, in addressing the jury, said: “The specification is to be read as addressed to artists, or persons of competent skill in the branch of manufacture or process to which it is applicable. Hence, known machinery need not be described, when the use

of them is to be made in carrying out the object of the patent. (1 *Web. P. C.* 676.) Workmen of ordinary skill, means those competent in the ordinary business and conducting of the particular trade—to furnish and construct apparatus for the purpose required. Certainly, the pursuer does not satisfy the condition of law, if he says men of the greatest science—first-rate engineers—could understand him, and would know what to do, or what direction to give. That is not enough. The specification must be for the benefit of the trade when the patent is out; it is addressed to those engaged in particular departments of trade, and who are to be employed in order to make apparatus for the purpose, those who are competent to make similar apparatus for similar purposes. But the terms in the issue do not denote common labourers or workmen employed under those which do furnish and construct such apparatus.” (1*b.* 692.)

396. BEARD v. EGERTON. [1849]

A specification is sufficient if it is free from any such mistake or obscurity as would mislead a person of fair intelligence. Maule, J., during the argument, said: “A specification is not to compel a person, who is determined to misunderstand, to learn, but to direct one who is willing to understand.” (19 *L. J., C. P.* 36; 8 *C. B.* 167; 13 *Jur.* 1004.) *See also* 540.

397. HEATH v. UNWIN. Ex. Ch. [1852]

Alderson, B., said: “Every specification is to be read as if by persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention. Thus, if a particular mechanical process is specified, and there are for some parts of it as specified, other well-known mechanical equivalents, the specification of those parts is in truth a specification of the well-known equivalent also, to those to whose general knowledge we refer, namely, mechanics, and readers of specifications; and so it is with chemical equivalents also in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and

chemists. These are not included in the specification, but must be expressly stated there." (2 *Web. P. C.* 245.)

THE PATENT TYPE FOUNDRY COMPANY *v.* RICHARDS. Ch. [1859] See 435.

MORTON *v.* MIDDLETON. [1863] See 378.

398. FOXWELL *v.* BOSTOCK. [1864]

The law requires that a specification should be intelligible to a workman of *ordinary* skill and information on the subject. (10 *L. T. Rep.*, *N. S.* 147.)

399. SIMPSON *v.* HOLLIDAY. Ch. [1865]

Lord Westbury: "When it is stated that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification, or the drawings it refers to; or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is, because such errors cannot possibly mislead. But the proposition is not a correct statement of the law, if applied to errors which are discoverable only by experiment and further inquiry; neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject." (13 *W. R.* 578; 12 *L. T. Rep.*, *N. S.* 99.)

Should be sufficient without Experiments.

400. R. *v.* ARKWRIGHT. [1785]

Buller, J.: "It does not prove that a specification is sufficient, because a man from the knowledge he has got from three trials, and seeing people immediately employed about it, is able to make use of it." (1 *Web. P. C.* 67.)

401. R. v. WHEELER. *Sci. fac.* [1819]

Abbott, C. J., delivering the judgment of the court, said: "A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad." (2 *B. & Ald.* 354.)

402. MORGAN v. SEAWARD. N. P. [1836]

Alderson, B., in addressing the jury, said: "If the invention can only be carried into effect by persons setting themselves a problem to solve, then they who solve the problem become the inventors of the method of solving it, and he who leaves persons to carry out his intention by means of that application of their understanding, does not teach them in his specification that, which, in order to entitle him to maintain his patent, he should teach them, the way of doing the thing, but sets them a problem, which being suggested to persons of skill, they may be able to solve. That is not the way in which a specification ought to be framed. It ought to be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon him to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention." (1 *Web. P. C.* 174.)

403. NEILSON v. HARFORD. [1841]

The specification should be such as, if fairly followed out by a competent workman, *without invention or addition*, would produce the machine for which the patent is taken out, and such machine so constructed must be one beneficial to the public. (8 *M. & W.* 806; 10 *L. J., Ex.* 20; 1 *Web. P. C.* 331.) Parke, B., said, at *Nisi Prius*: "If experiments are necessary in order to construct a machine to produce some beneficial effect, no doubt this specification is defective. If experiments are only necessary in order to produce the greatest beneficial effect, in that case I think the patent is not void." Parke, B., delivering the judgment of the Court of Exchequer,

said, there was no authority to show that a specification, which could only be supported by a fresh invention, and correction by a scientific person, would be good. (1 *Web. P. C.* 371.)

404. MACNAMARA v. HULSE. N. P. [1842]

Action for the infringement of a patent for "certain improvements in paving, pitching, or covering streets, roads, and other ways." The patentee, in his specification, said: "My invention consists in an improved mode of cutting or forming stone, *or other suitable material*, for paving or covering roads," &c. The specification directed the blocks, to be used for paving, to be bevelled both inwards and outwards, but said nothing as to the precise angle at which the bevels were to be made. The infringement complained of was the manufacture of *wooden* blocks according to the improvement of the plaintiff. Abinger, C. B., said: "If the specification leaves it to experiment to determine what is the proper angle, it is not good; but if any angle is a benefit, it will do." After verdict, his Lordship said: "I may now say that my opinion was against the plaintiff as to the angle not being stated, and that the specification in that respect was insufficient." (1 *Car. & Marsh.* 477; 2 *Web. P. C.* 129.)

405. MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships or other such vessels." The patentee, in his specification, directed copper and zinc to be melted together "in the usual manner, in proportions between 50 per cent. of copper to 50 per cent. of zinc, and 63 per cent. of copper to 37 per cent. of zinc, both of which extreme and all intermediate proportions will roll to a red heat." The defendant contended, that in describing the proportions of the copper and the zinc it was left uncertain, upon the face of the specification, whether those quantities were to be taken with reference to the measured quantities that are cast in common into the fusing-pot, or whether they mean to specify that which will be the result and aggregate of the two combined together when it is taken out,

Referring to this, his Lordship said: "A very proper objection, and if it creates in the mind of a workman any degree of doubt which was intended, it would be a fatal one to the specification. Because people are not to go on and make experiments afterwards, at a great expense to themselves, which shall turn out to be bootless and fruitless; but they rely on an honest, and open, and candid exposition by the patentee, of everything that is necessary for the easy and certain procurement of the commodity, for which the patent was granted." (2 *Web. P. C.* 109.)

Prejudicial Concealment.

LIARDET *v.* JOHNSON. N. P. [1778] See 419.

406. REG. *v.* ARKWRIGHT. *Sci. fac.* [1785]

Buller, J., in addressing the jury, said: "It is clearly settled at law that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret, and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the specification is, to teach the public, after the term for which the patent is granted, what the art is, and it must put the public in possession of the secret, *in as ample and beneficial a way as the patentee himself uses it.* This I take to be clear law, as far as it respects the specification; for the patent is the reward, which, under the act of parliament, is held out for a discovery, and therefore, unless the discovery be true and fair, the patent is void. If the specification in any part of it, be materially false or defective, the patent is against law, and cannot be supported." (1 *Web. P. C.* 66; *Dav. P. C.* 106.)

407. TURNER *v.* WINTER. [1787]

Butler, J., said: "If he (the patentee) make the article, for which the patent is granted, with cheaper materials than those which he has enumerated, although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to

derive the same benefit which he himself does." (1 *T. R.* 607 ; *Dav. P. C.* 154 ; 1 *Web. P. C.* 81.)

408. WOOD v. ZIMMER. N. P. [1815]

In this action, to try the validity of Zinck's patent for "a method of making verdigris," it appeared that the method described in the specification was sufficient to make the verdigris, but that Zinck had been accustomed clandestinely to put *aqua-fortis* into the boiler, whereby one of the ingredients, copper, was dissolved more rapidly ; but the verdigris so produced was neither better nor cheaper than that made according to the specification, which did not mention *aqua-fortis* in any way whatever. Gibbs, C. J. : " It is said that the method described makes verdigris, and that the specification is, therefore, sufficient. The law is not so ; a man who applies for a patent, and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour, as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way, and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without *aqua-fortis* as with it, still, inasmuch as it would be made with more labour by the omission of *aqua-fortis*, it is a prejudicial concealment, and a breach of the term, which the patentee makes with the public." (*Holt, N. P.* 58 ; 1 *Web. P. C.* 82.)

409. BOVILL v. MOORE. N. P. [1816]

Gibbs, C. J., in addressing the jury, said : " There is another consideration respecting the specification, which is also a material one, and that is, whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent to the extent most beneficial within the know-

ledge of the patentee at the time; for a patentee, who has invented a machine useful to the public, and can construct it in one way more extensive in its benefit than in another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends; yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of, for exercising the privilege granted to him. If at the time when he obtained his patent he was apprised of this more beneficial mode of working, and did not, by his specification, communicate this more beneficial mode of working to the public, that will have been a fraudulent concealment from the public, and will render his patent void." (*Dav. P. C.* 400.)

CROMPTON *v.* IBBOTSON. [1828] See 425.

410. LEWIS *v.* MARLING. [1829]

Bayley J.: "To support a patent it is necessary that the specification should make a full disclosure to the public. If the patentee, suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad. So, if he says that there are many modes of doing a thing, when in fact one only will do, this will also void the patent; but if he makes a full and fair communication, as far as his knowledge at the time extends, he has done all that is required." (10 *B. & C.* 26; 4 *C. & P.* 57; 1 *Web. P. C.* 496.)

411. CROSSLEY *v.* BEVERLEY. [1830]

Bayley, J.: "It is the duty of the inventor, if between the period of taking out the patent and enrolling the specification he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to

the public the knowledge he has obtained before the specification." (1 *Web. P. C.* 117.)

412. JONES v. HEATON.

Tindal, C. J.: "The patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification." (1 *Web. P. C.* 404, *n.*)

413. MORGAN v. SEAWARD. N. P. [1836]

Alderson, B.: "If a patentee is acquainted with any particular mode by which his invention may be more conveniently carried into effect, he ought to state it in his specification." (1 *Web. P. C.* 174.)

414. NEILSON v. HARFORD. N. P. [1841]

The omission to mention in the specification anything which may be necessary for the beneficial enjoyment of the invention is a fatal defect. *Aliter* if such omission go only to the degree of the benefit. (1 *Web. P. C.* 317.)

The omission to mention in the specification anything which the patentee knows to be useful is a fatal defect. (*Ib.* 321.)

415. WALTON v. BATEMAN. N. P. [1842]

If a patentee knows a better mode than that which he states in his specification of carrying out his invention, his patent is void. (1 *Web. P. C.* 622.)

416. TETLEY v. EASTON. N. P. [1852]

Pollock, C. B.: "A man has no right to patent a principle, and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it." (*Macr. P. C.* 76.)

417. HEATH v. UNWIN. Ex. Ch. [1852]

Coleridge, C. J., in the course of his judgment, said: "The specification, to be perfect, must be taken to specify impliedly all the chemical equivalents of those chemical means expressly

stated for producing the promised result, which were at the time of specifying known to ordinarily-skilled chemists or to the patentee himself; the latter of these seems to me to be as necessary as the former. If the inventor of an alleged discovery, knowing of two equivalent agents for effecting the end, could by the disclosure of one preclude the public from the benefit of the other, he might for his own profit force upon the public an expensive and difficult process, keeping back the simple and cheap one, which would be directly contrary to the good faith required from every patentee in his communication with the public." (2 *Web. P. C.* 243.)

418. MACKELCAN v. RENNIE. [1862]

Williams, J.: "The plaintiff in this case had obtained a patent for 'improvements in floating-docks.' In the course of the trial, it appeared that the construction of floating-docks was not novel. The plaintiff then alleged that his invention did not consist in the construction of floating-docks, but in the application of iron so as to form air-tight and water-tight chambers. The Lord Chief Justice was of opinion that, inasmuch as there was no mention of iron in the complete specification, the plaintiff had not complied with the conditions of the letters patent by duly describing the nature of his invention, and in what manner it was to be carried into effect; and, accordingly, he directed a nonsuit to be entered. We are all of opinion that he was quite right in so doing." (13 *C. B., N. S.* 59.)

Misleading.

419. LIARDET v. JOHNSON. N. P. [1778]

"The meaning of the specification is, that others may be taught to do the thing for which the patent is granted, and if the specification is false the patent is void, for the meaning of the specification is, that after the term the public shall have the benefit of the discovery."

In a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, which was rubbing

it with tallow, and for want of that Lord Mansfield held it void. (1 *Web. P. C.* 53; *Bull. N. P.* 76.)

420. R. v. ARKWRIGHT. *Sci. fac.* [1785]

According to the evidence, certain parts of the machine described were useless. Referring to these, Buller, J., said: "If those are of no use, but to be thrown in merely to puzzle, I have no difficulty to say, upon that ground alone, the patent is void. (*Dav. P. C.* 118.) . . . If four things only were necessary instead of ten, the specification does not contain a good account of the invention." (*Ib.* 125.)

421. TURNER v. WINTER. [1787]

Action for the infringement of a patent for "a method of producing a yellow colour for painting in oil or water, making white lead, and separating the mineral alkali from common salt, all to be performed in one single process." The patentee, in his specification, said: "Take any quantity of lead and calcine it, or minium, or red lead, litharge, lead ash, or any calx, or preparation of lead fit for the purpose; to any given quantity of the above-mentioned materials, add half the weight of sea salt, with a sufficient quantity of water to dissolve it, or rock salt, or sal gem, or fossil salt, or any marine salt, or salt water, proper for the purpose. . . . The yellow colour is produced by calcinating the lead after the alkali has been separated from it, till it shall acquire the colour wanted; this will be of different tints, according to the continuance of the calcination or the degree of heat employed." Three objections were taken to the specification. "First; that, after directing that lead should be calcined, it directed another ingredient to be taken, which would not answer the purpose, viz., minium. Neither was it said that minium should be calcined or fused; but if it had any reference to the preceding words, then it should be calcined, which would not produce the effect, fusion being necessary. Second; that 'fossil salt' was improperly mentioned. There were many kinds of fossil salt, only one of which, viz., sal gem, would answer the purpose, because it must be a marine salt. Third; that the white substance produced

was not that commonly known as white lead:”—Held, that, if any of these objections were well founded, it would avoid the patent. (1 *T. R.* 602; *Dav. P. C.* 145; 1 *Web. P. C.* 77.) Ashhurst, J., in the course of his judgment, said: “I think that, as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law, and would be a reason against it, were it not for the advantages the public derive from the communication of the invention after the expiration of the time for which the patent is granted. It is, therefore, incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear there is any unnecessary ambiguity affectingly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. (1 *Web. P. C.* 80.) . . . It is certainly of consequence that the terms of a specification should express the invention in the clearest and most explicit manner; so that a man of science may be able to produce the thing intended, without the necessity of trying experiments.” (*Ib.* 81.) Buller, J., said: “If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant. Slight defects in the specification will be sufficient to vacate the patent.” (*Ib.* 82.)

422. HUDDARD v. GRIMSHAW. N. P. [1803]

The insertion or representation of anything as material, not being so in fact, will vitiate the specification. (*Dav. P. C.* 295; 1 *Web. P. C.* 93.)

HARMAR v. PLAYNE. [1809] See **472.**

CAMPION v. BENYON. [1821] See **330.**

423. SAVORY v. PRICE. N. P. [1823]

Action for the infringement of a patent for a method of making seidlitz powder. The specification gave three recipes for preparing the ingredients, which were Rochelle salt, carbon-

ate of soda, and tartaric acid. It was proved that by following the directions given in the specification, the result was obtained, and that it was new and useful. It appeared also that the three recipes were only common processes for preparing the ingredients, which were sold in shops before the date of the patent. The specification did not give any name to the ingredients resulting from the three recipes. Held, that the patent was void. (1 *Ry. & Mo.* 1; 1 *Web. P. C.* 83.) Abbott, C. J., in delivering judgment, said: "It is the duty of anyone, to whom a patent is granted, to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when, in fact, he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported." (1 *Ry. & Mo.* 3.)

424. STURTZ v. DE LA RUE. Ch. [1828]

The patent was "for certain improvements in copper and other plate printing." The specification declared that "the nature of the invention consisted in putting a glazed or enamelled surface on paper to be used for copper and other plate printing, by means of white lead and size." This glaze or enamel was directed to be made by mixing size, in certain proportions, with "the finest and purest chemical white lead," but the evidence went to show that there was no substance generally known in the trade by that denomination. Lyndhurst, L. C., said: "It is a principle of patent law, that there must be the utmost good faith in the specification. It must describe the invention in such a way, that a person of ordinary skill in the trade shall be able to carry on the process. Here, the specification says, that there is to be added to the size certain proportions 'of the finest and purest chemical white lead.' A workman

would naturally go to a chemist's shop, and ask for 'the finest and purest chemical white lead;' the answer which he would receive would be, that there was no substance known in the trade by that name. He would be compelled to ask for the purest and finest white lead; and, according to the evidence, the purest and finest white lead that can be procured in London will not answer the purpose. It is said that there is a substance prepared on the Continent, which is white lead, or some preparation of white lead; and that, by using it in the manner described in the specification, the desired effect is produced. If that be so, the patentee ought to have directed the attention of the public to that circumstance. He ought to have said, 'the purest white lead which can be obtained in the shops in London will not do; but there is a purer white lead, prepared on the Continent, and imported into this country, which alone must be used.' 'The purest and finest chemical white lead' must mean the finest and purest white lead usually gotten in the general market for that commodity, unless the public be put on their guard by a statement, that what would be called very fine and pure white lead, in the ordinary sense of the trade, will not answer, but that the white lead used must be of a superlatively pure and fine quality, prepared in a particular way, and to be gotten only in a particular place. If the article is not made in this country, but may be imported, it would be necessary to mention that circumstance." (5 *Russ.* 327; 1 *Web. P. C.* 83.)

425. CROMPTON v. IBBOTSON. [1828]

The patent was for an improvement in drying and finishing paper. The patentee said in his specification: "The invention I claim consists in conducting the paper, by means of cloth or cloths, against the heated cylinders, which cloth may be made of any suitable material, but I prefer it to be made of linen warp and woollen weft." The evidence showed, that, before the date of the specification, the patentee had tried several fabrics for the purpose, but none had answered except the one made of linen and wool:—Held, that the specification was bad, as it tended to mislead the public. Tenterden, C. J.: "Other

persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail, and the public, therefore, has not the full and entire benefit of the invention." (*Dan. & L.* 34; 1 *Web. P. C.* 83; 1 *Carp. P. C.* 462.) Bayley, J.: "A party knowing that given materials will not answer the purpose, he is bound in his specification so to word it as to prevent parties from trying experiments on that which he knows will not answer." (1 *Carp. P. C.* 462.)

426. LEWIS v. MARLING. [1829]

A party took out a patent for an improved shearing machine, to shear woollen cloths, and claimed four things as his invention. One of them was a proper substance to brush the cloth. In describing the machine in the specification, he directed plush to be used for this purpose, but he nowhere stated that this was an essential part of his machine. Before the time of the patentee's invention some kind of brush had been uniformly used, but it was subsequently ascertained that with this machine no brush was necessary:—Held, that this did not invalidate the patent. (10 *B. & C.* 22; 4 *C. & P.* 56; 5 *M. & R.* 66; 1 *Web. P. C.* 493.) Tenterden, C. J., said: "If the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and thereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful." (1 *Web. P. C.* 495.) Bayley, J., said: "If the party knew that it (the brush) was unnecessary, the patent would be bad, on the ground that this was a deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection." (*Ib.* 496.)

427. DEROSNE v. FAIRIE. [1835]

A specification must state at least one method which will succeed. (2 *C., M. & R.* 493; 1 *Web. P. C.* 165.)

428. BICKFORD v. SKEWES. [1841]

Patent for a miner's safety fuse. The specification directed the use of "gunpowder, or other proper combustible matter," for the manufacture of the fuse. It was objected, on behalf of the defendants, that the plaintiff had failed to show that any other material but gunpowder had ever been used in the fuse; or, if introduced, would answer the purpose desired. Denman, C. J., in delivering the judgment of the Court, said: "The first part of this objection is true in fact; but it seems to us immaterial; for if other materials, not specified (and it is certainly not necessary to specify all), but still within the description given, will answer the purpose, no ambiguity is occasioned, nothing that can mislead the public, or increase the difficulty hereafter of making the instrument, by the introduction of terms which import that the patentee has himself used them. The latter part of the objection, if true in fact, would have been more material, because it does tend to mislead if it be stated that a whole class of substances may be used to produce a given effect, when, in fact, only one is capable of being used successfully." (1 *Q. B.* 948; 1 *Web. P. C.* 218.)

429. NEILSON v. HARFORD. [1841]

A specification, which contains a false statement in a material circumstance, of a nature that, if literally acted upon by a competent workman, would mislead him, and cause the experiment to fail, is bad, and the patent invalidated, although the jury finds that a competent workman, acquainted with the subject, would not be mislead by the error, but would correct it in practice. The patentee, in his specification, said: "The shape of the receptacle" (a part of his machine) "is immaterial to the effect." This was held to cast upon the patentee the necessity of proving to the satisfaction of the jury that any shape which could reasonably be expected to be made by a competent workman, would produce a beneficial effect, and be a valuable discovery. (8 *M. & W.* 806.) *See also* 393.

430. SIMPSON v. HOLLIDAY. Ch. [1864]

Patent for "improvements in the preparation of red and

purple dyes." The patentee in his specification said: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time; *or* I accelerate the operation by heating it to, or near to, its boiling point." The operation would not succeed if conducted by the first of these methods, viz., without heat. Wood, V.-C., said: "If the Court had any notion whatever that it (the first method) was put in with an intent to mislead, then without doubt or hesitation it would hold the patent to be bad; because there are two points in these cases of somewhat confused description in specifications which the Court mainly attend to—whether or no it has been put in with a fraudulent intent to mislead, so as to have a larger claim—on the one hand, that species of fraudulent intent to mislead, which at once leads the Court to decide against the validity of the patent; or, on the other hand, whether, although put in innocently by mistake, and without any fraudulent intent, it is such a description as will or can mislead any ordinary workman in the operation that he has to carry on." (20 *Newt. Lon. Jour.*, N. S. 108.)

Ambiguity in.

431. GALLOWAY v. BLEADEN. N. P. [1839]

Tindal, C. J., referring to the specification, said: "If there is a want of clearness, so that the public cannot afterwards avail themselves of it, much more if there is any studied ambiguity in it, so as to conceal from the public that which the patentee for a term is enjoying the exclusive benefit of, no doubt the patent itself would be completely void." (1 *Web. P. C.* 524.)

432. WALTON v. POTTER. N. P. [1841]

Tindal, C. J., in addressing the jury, said: "The object of the specification is, that it is the price which the party who obtains the patent pays for it, and it would be a hard bargain on the part of the public, if he were allowed to clothe his discovery and his description in characters so dark and so am-

biguous, that no one could make from it when the fourteen years have expired, and he should not have paid the price for which he enjoyed the exclusive privilege, but that he should have it in his own hands still for as long a period as he chooses; and therefore, it is always a proper answer when a patent is set up, to say that you have not so described it, that it may be understood." (1 *Web. P. C.* 595.)

433. MACNAMARA v. HULSE. [1842]

In a patent for blocks for pavement, the patentee claimed as his invention, that his block was bevelled both inwards and outwards on the same side of the block; but the specification did not state at what angle the bevels should be made; and one witness stated that the angle was material, but another witness stated that any angle would be of some benefit:—Held, that if the jury thought that a bevel at any angle would be beneficial, the specification would be good, although it omitted to state any particular angle at which the bevels should be made. (*Car. & M.* 471.)

MUNTZ v. FOSTER. N. P. [1844] See **405.**

434. HASTINGS v. BROWN. [1853]

A specification in a patent, for a particular construction of windlasses, stated that the object was "to hold, without slipping, a chain cable of any size." Before the date of the patent, constructions were known by which a windlass might be made to hold a single chain cable of any assigned size:—Held, that the specification did not unequivocally show, that the object was to construct a single windlass which might hold different chain cables, whatever their size, and that such a windlass was, therefore, not protected by the patent. (1 *E. & B.* 450; 22 *L. J., Q. B.* 161; 17 *Jur.* 647.)

435. THE PATENT TYPE FOUNDRY COMPANY v. RICHARDS.
Ch. [1859]

The specification of an invention, which consists in the use of known materials in new proportions, is not necessarily bad for uncertainty, though the patentee does not limit himself to

the precise proportions recommended. The patentee is bound, according to the authorities, to state what he considers the best proportions.

A specification stated in substance, that the usual practice in the manufacture of type was, to employ lead and antimony, and in some cases to add a small per centage of tin; that the object of the invention was to obtain tougher metal by employing tin in large proportions with antimony, greatly reducing or wholly omitting the use of lead; that the best proportions were seventy-five of tin and twenty-five of antimony, but that this might be, to some extent, varied; and that, if lead were used, it must not exceed fifty per cent. of the whole, one part of antimony to three of tin, or tin and lead, being the best:—Held, on demurrer, that the specification was not bad on the face of it for uncertainty, and that the evidence of persons acquainted with the usual modes of manufacture was necessary to determine whether the invention was stated with sufficient precision. (1 *John Rep.* 381; 6 *Jur.*, N. S. 39.)

436. RALSTON v. SMITH. H. L. [1865]

Lord Westbury: "There were some objections raised to the specification, and particularly with regard to the uncertainty of the material, the language of the amended specification being that the plaintiff took 'a roller of hard metal, or other suitable material.' I do not think those words 'or other suitable material' contain anything like such a generality of direction as would be fatal to the patent; 'other suitable material' no doubt would mean any material equally sufficient for the purpose with hard metal. I think your Lordships would be of opinion that there was no solid weight in that objection." (11 *H. L. Cas.* 248; 35 *L. J.*, C. P. 56; 20 *C. B.*, N. S. 47; 13 *L. T. Rep.*, N. S. 4.)

Should distinguish what is New from what is Old.

437. MANTON v. MANTON. N. P. [1815]

Gibbs, C. J., in addressing the jury, said: "It is necessary that the patentee should show that he has accurately explained

the nature of his invention in his specification, *separating that which is new from that which is old*, so as to enable a person of tolerable skill to make the thing by means of his specification." (*Dav. P. C.* 349.)

438. CARPENTER v. SMITH. N. P. [1841]

Abinger, C. B., in his remarks to the jury, said: "It is required as a condition of every patent, that the patentee shall set forth in his specification a true account and description of his patent or invention, and it is necessary in that specification that he should state what his invention is, what he claims to be new, and what he admits to be old; for, if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole as new, why then his patent must be taken to be a patent for the whole, and for each particular part, and his patent will be void if any particular part turns out to be old, or the combination itself not new." (1 *Web. P. C.* 532.)

439. GIBSON v. BRAND. [1842]

Cresswell, J.: "Every party is bound to tell the public clearly, by his specification, what he claims, and what they may do, or not do, without risk of an action for infringing his patent." (1 *Web. P. C.* 640.)

440. CRANE v. PRICE. [1842]

It is no objection to the validity of a patent that the invention cannot be used except by means of a former patented invention, where the second patentee expressly disclaims any part of such former invention. (4 *M. & G.* 580.)

Tindal, C. J., in delivering the judgment of the court, said: "Unless the grantee of the new letters patent is bound by law to specify whether such former invention, which is excepted, was so excepted on the ground of its being generally known, and used by the public, or because it was the subject of a patent which secured the use of it to a former patentee, the new patent will be good. But that distinction is as much in the knowledge

of the public as in that of the grantee of the patent. If, indeed, the new patent had been taken out for an improvement or alteration of an invention secured by a former patent, then, for obvious reasons, a greater particularity would be necessary to distinguish the new from the old." (*Ib.* 608.)

441. HOLMES v. THE LONDON AND NORTH-WESTERN RAILWAY COMPANY. [1852]

The plaintiff obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument:—Held, that the specification was bad, as it did not distinguish what was new from what was old. (*Macr. P. C.* 13.) Jervis, J., in delivering judgment, said: "It is admitted as a general proposition that every patentee must, in his specification, describe the nature of his invention either directly or in such a way as that those who read the specification with common ordinary understanding, and fairly read it, may see and understand what is new and what is old." (*Ib.* 26.)

442. TETLEY v. EASTON. [1853]

A specification describing a patent invention must, unless a contrary intention appears, be deemed to claim all that it describes, not only as a whole taken in combination, but also all the essential parts of which such combination is composed. (2 *Ell. & Bl.* 956; *Macr. P. C.* 82.) Coleridge, J., said: "This rule may, perhaps, admit of some modification in favour of the patentee, in respect of things incidentally mentioned, which are old and universally known to be so; for, if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new." (*Macr. P. C.* 87.)

443. LISTER v. LEATHER. [1858]

A patent for a combination is not a claim that each part thereof is new. (8 *E. & B.* 1004; 3 *Jur.*, *N. S.* 811.) Affirmed on appeal to the Exchequer Chamber:—Held, also, that a patent is a patent for a combination, if a combination is distinctly stated in the specification to be a part of the invention, although the combination is not expressly claimed; for a claim is not an essential to a specification, or necessary for the protection of the invention. Nor is it necessary to disclaim those matters which manifestly form no part of the invention. (8 *E. & B.* 1031; 27 *L. J.*, *Q. B.* 295.)

444. MORTON v. MIDDLETON. [1863]

Lord President: “The usual mode of claiming as new merely a combination or arrangement of certain things, not in themselves new, is to set forth, that what the patentee claims is not each of the parts, but the combination and arrangement of them, so as to produce either a new result, or a greater and better one than has been attained before. But this course is not essential. If it appears from the reading of the document, that, although the patentee does not in so many words say, ‘I limit my claim to so and so,’—yet if it plainly enough appears that he actually does only claim so and so, that is enough.” (1 *Cr. S.*, 3rd *Ser.* 722.)

445. NEWALL v. ELLIOTT. [1864]

Pollock, C. B.: “The patentee of a combination is bound to state what parts of the combination he claims to be new, or what parts of the combination he has taken from that general stock of knowledge which is common to all the public.” (10 *Jur.*, *N. S.* 956.)

446. RENARD v. LEVINSTEIN. Ch. [1864]

Lord Justice Knight Bruce: “Considering the different consequences that may arise as to the part of an invention communicated from a foreign country, and as to the part of the

same invention, or set of inventions, which may be deemed to be in every respect new, I consider it to be a serious and very arguable question, whether it is or is not incumbent on the patentee to distinguish, to define, and to particularize what is new and what is old." (10 *L. T. Rep.*, *N. S.* 177.)

447. DANGERFIELD v. JONES. Ch. [1865]

Where the patented machine or apparatus is entirely new, the patentee is not bound to describe and distinguish the different parts; but where the invention consists of a machine which is only an improvement upon an old machine, he must distinguish and describe all the parts which he claims as new. (13 *L. T. Rep.*, *N. S.* 144.)

448. DAW v. ELEY. Ch. [1867]

Where a specification, in the first instance, describes the invention in too general terms, but afterwards, in describing the method of performing the invention, refers to certain figures in drawings annexed thereto, and the claim made is for the manufacture of the invention described with reference to those figures, the specification is sufficient.

The patent was for improvements in central-fire breech-loading cartridges. The specification, describing the method of performing the invention, referred to certain figures in drawings annexed thereto, but did not distinguish between what was new and what was old. The patentee claimed "the manufacture of cartridges described with reference to figs. 1, 2, and 1*; and I also claim the manufacture of cartridges described with reference to figs. 3, 4, and 3*:"—Held, that the patent might be upheld by limiting the claim (as in *Seed v. Higgins*) for the manufacture of cartridges described with reference to the above-mentioned figures. (*L. R.*, 3 *Eq.* 500 n, 513; 36 *L. J.*, *Ch.* 482; 14 *W. R.* 126; 13 *L. T. Rep.*, *N. S.* 399.)

449. WRIGHT v. HITCHCOCK. [1870]

A patent was taken out by W. for "improvements in the manufacture of frills or ruffles, and in the machinery or appa-

ratus employed therein." The specification described a process of plaiting fabrics by means of a reciprocating knife in combination with a sewing machine. The first claim was for the general construction, arrangement, and combination of machinery for producing plaited frills or trimmings in a *sewing machine*; the second, was for the application and use of a reciprocating knife for crimping fabrics *in a sewing machine*; and the third, for the peculiar manufacture of crimped or plaited frills or trimmings "as hereinbefore described" and illustrated by drawings:—Held, that W.'s patent was not for the manufactured product, but for the process of manufacturing it; and was not limited to the manufacture of plaited fabrics by the knife *in combination* with a sewing machine. Kelly, C. B., said: "It was contended that the manufacture described includes the use of the sewing machine, or that it is a manufacture by means not only of the reciprocating knife, but of a sewing machine, without which unquestionably the complete article cannot be produced in the manner described. But, looking at the whole specification and claim, this is only pointed out as the best mode of completing the manufacture. The sewing machine is treated as a known invention already in use, and it is separate and distinct from the mode of crimping or plaiting to which the plaintiff lays claim." (39 *L. J.*, *Ex.* 97; *L. R.*, 5 *Ex.* 37.)

See also under "*Specifying an Improvement.*"

Claiming too much.

450. *R. v. ELSE. Sci. fac.* [1785]

Where a patent claimed the exclusive liberty of making lace, composed of silk and cotton thread mixed, and not any particular mode of mixing, it was held to be void, on proof that silk and cotton thread had been before mixed on the same frame for lace, although not in the same mode. (1 *Web. P. C.* 76.)

451. HUDDARD v. GRIMSHAW. N. P. [1803]

Ellenborough, C. J., in addressing the jury, said: "In claiming the benefit of a patent, it is required that there shall be enrolled a specification, which shall convey to the public a corresponding advantage with that of the individual whose sole right is protected for that time, so that any person looking at a specification, who is skilled in the subject, may be able to accomplish the end; and if, in stating the means necessary to the production of that end, he oversteps the right, and appropriates more than is his own, he cannot avail himself of the benefit of it." (*Dav. P. C.* 279; 1 *Web. P. C.* 86.)

452. BOVILL v. MOORE. N. P. [1816]

Gibbs, C. J., in the course of his remarks to the jury, said: "If the plaintiff has in this specification asserted to himself a larger extent of invention than belongs to him, if he states himself to have invented that which was well known before, then the specification will be bad, because that will affect to give him, through the means of this patent, a larger privilege than could legally be granted to him." (*Dav. P. C.* 404.) If the patentee has claimed too much, it is immaterial whether he has done so fraudulently or inadvertently. (*Ib.* 414.)

R. v. CUTLER. Sci. fac. [1816] See 109.

453. HILL v. THOMPSON. Ch. [1817]

Eldon, L. C.: "The specification must not attempt to cover more than that which, being both matter of actual discovery, and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled. On the other hand, there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is

in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials. If there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might for the improvement merely, it is good for nothing altogether, on account of its attempting to cover too much." (1 *Web. P. C.* 237; 3 *Mer.* 629.)

454. BLOXAM v. ELSEE. [1827]

The patent was for a machine for making paper in single sheets, without seam or jointing, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length:—Held, that this imported that paper, varying in width between those extremes, should be made by the same machine, and that the patentee at the time of taking out the patent, not having any machine capable of producing paper of different widths, the patent was void. (6 *B. & C.* 169; 9 *D. & R.* 215.)

455. LEWIS v. MARLING. [1829]

A patent is not voided by the specification claiming as part, but not as an essential part of the invention, something which proves useless. (5 *M. & R.* 66; 10 *C. B.* 22; 4 *C. & P.* 56; 1 *Web. P. C.* 493.)

456. MINTER v. MOWER. [1837]

"Patent for an improvement in the construction, making, or manufacturing of chairs." The specification thus concludes: "What I claim as my invention is, the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair as above described." It appeared from the evidence, that a chair, acting upon the same principle as that which the patentee claimed, had been constructed and sold by a person of the name of Brown, before the date of the patent; this chair had, however, been encumbered by additional

machinery:—Held, that the specification was bad. (6 *A. & E.* 735; 1 *N. & P.* 595; *W. W. & D.* 262; 1 *Web. P. C.* 142.) Denman, C. J., said: “The specification claimed more than the plaintiff had invented, and would have actually precluded Brown from continuing to make the same chair that he had made before the patentee’s discovery. We are far from thinking that the patentee might not have established his title by showing that a part of Brown’s chair could have effected that for which the whole was designed. But his claim is not for an improvement upon Brown’s leverage, but for a leverage so described that the description comprehended Brown’s.” (6 *A. & E.* 745.)

457. GIBSON *v.* BRAND. [1842]

If the patentee claims as his invention improvements in machinery, or a new combination of machinery, and the jury find that he has only invented an improved process, the patent is void. (1 *Web. P. C.* 613; 4 *M. & G.* 179; 4 *Scott, N. R.* 844.) Tindal, C. J., said: “Looking at the specification in the case, it appears to me that this patent cannot be supported at law, because the plaintiffs have, in the course of it, claimed more than they are entitled to.” (1 *Web. P. C.* 634.)

458. MUNTZ *v.* FOSTER. N. P. [1844]

Action for the infringement of a patent for “an improved manufacture of metal plates for sheathing the bottoms of ships or other such vessels.” The patentee, in his specification, directed copper and zinc to be melted together “in the usual manner, in proportions between 50 per cent. of copper to 50 per cent. of zinc, and 63 per cent. of copper to 37 per cent. of zinc, both of which extremes, and all intermediate proportions, will roll at a red heat:”—Held, that if the invention could not be made in one or two of the different proportions of zinc and copper mentioned in the specification, the patent would be void. (2 *Web. P. C.* 110.)

459. GAMBLE v. KURTZ. [1846]

Where a patent was granted for improvements in apparatus for the manufacture of certain chemical substances, and the jury found that the apparatus itself was not new, but that the patentee's mode of connecting the parts of that apparatus was new, the Court directed the verdict to be entered for the defendant, as the patentee had claimed more than was new. (3 C. B. 425.)

460. BEARD v. EGERTON. [1849]

Maule, J.: "If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad." (19 L. J., C. P. 40.)

461. R. v. CUTLER. [1849]

The specification of a patent for "improvements in the construction of the tubular flues of steam boilers," described two modes of performing one part of the invention, either of which it was stated would produce the effect. At the trial the judge told the jury that, if either mode succeeded, the patent might be good, notwithstanding the imperfection of the others:—Held, that this was a misdirection. Denman, C. J., delivering the judgment of the Court, said: "I told the jury that if either of those methods were proved satisfactorily to do the work, the patent might be good, notwithstanding the imperfection of the other. The case of *Lewis v. Marling* had been quoted as establishing that doctrine, but on examination we find that the Court then only said that the claim of some part of the machine which turned out to be useless, did not vitiate the patent. This is certainly a very different thing from describing a part of the machine as capable of co-operating in the work, when in fact it is incapable, even though, at the same time, other means are described which might be effectually employed. The reader of the specification, relying upon it, might attempt to use the former mode in constructing the machinery, which would fail of its purpose from being too accurately made according to the patentee's instructions." (*Macr. P. C.* 137; 14 Q. B. 372, n.)

NEWTON v. VOUCHER. [1851] See 326.

462. TETLEY v. EASTON. N. P. [1852]

By making a general claim, a patentee cannot include in his patent improvements of which he was ignorant at the date of his patent. (*Macr. P. C.* 77.)

463. CROSSLEY v. POTTER. N. P. [1853]

Pollock, C. B. : "In my mind, the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves specially to one good thing, and a jury will always take care that if that be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of their genius." (*Macr. P. C.* 256.) *See also* 218.

464. BOOTH v. KENNARD. [1857]

Action for the infringement of a patent for "improvements in the manufacture of gas." The specification stated the invention to "consist in the direct use of seeds, leaves, flowers, branches, nuts, fruit, and other substances and matters containing oil, or oily or resinous matter." The specification also stated "that the mode of using seed, and constructing the apparatus used under this my patent in preparing gas, may be the same as the apparatus used in the ordinary mode of making gas with coal." The claim was as follows : "I claim for making gas direct from seeds, and matter herein named, for practical illuminations, or other useful purposes, instead of making it from the oils, resins, or gums, previously extracted from such substances." A previous patentee had, by his specification, proposed, for the manufacture of gas, to use fatty substances, such as greaves or graves ; also the residuum after the oil had been expressed from seeds, such as oil cake ; also beech nuts, mast, cocoa nuts, and other matters abounding in oil, and he proposed to use these substances separately and in combination : —Held, that the claim, being merely for making gas direct from seeds and matter stated in the specification, without reference to any method of doing it, was too large and general, and could not be supported. (2 *H. & N.* 84 ; 26 *L. J., Ex.* 305.)

465. THOMAS v. FOXWELL. Ex. Ch. [1858]

The patentee of a sewing machine, in his specification, claimed "the application of a shuttle in combination with a needle, as shown in sheet 1, for forming and sewing loops of thread or other substance, for the purpose of producing stitches either to unite or ornament fabrics, whatever may be the means employed for working such shuttle and needle when employed together:"—Held, that this claim was not confined to the single application of a shuttle in combination with a needle, as shown in sheet 1, but extended generally to the application of a shuttle with a needle for the attaining the object therein stated; and, as the shuttle and needle had been used together previously, the patent was void. (5 *Jur.*, N. S. 37; affirmed in Ex. Ch., 6 *Jur.*, N. S. 271.)

466. SEED v. HIGGINS. H. L. [1860]

The plaintiff took out a patent for an improvement in machinery used for roving cotton. His specification claimed the discovery of the application of the principle of centrifugal force for such purpose, but he filed a disclaimer, declaring that he intended to claim only the application of centrifugal force in the particular manner represented in drawings attached to the specification:—Held, that, taking the specification and disclaimer together, they sustained the patent for the invention of the particular machine described in the drawings. (8 *E. & B.* 755; 27 *L. J.*, Q. B. 148.) Affirmed by a majority of the judges on appeal to the Court of Exchequer Chamber (8 *E. & B.* 771; 27 *L. J.*, Q. B. 411). Affirmed in the House of Lords (8 *H. of L. Cas.* 550). Campbell, C. J., in delivering the judgment of the Court of Queen's Bench, said: "It is quite clear that, if the specification and the disclaimer being taken together, anything is claimed which was not comprised in the original specification, the whole is bad; and on the issue that the plaintiff has not duly specified his invention, the verdict ought to be entered for the defendant." (27 *L. J.*, Q. B. 150.) Lord Chelmsford, in delivering his judgment in the House of Lords, said: "Assuming that the specification had been originally bad,

on account of the generality of the claim, I see nothing in the act of parliament which prevents such an objection as this being removed, the only limitation to a disclaimer of any part of the specification being that it shall not extend the exclusive right granted by the letters patent." (8 *H. L. Cas.* 568.)

467. SIMPSON v. HOLLIDAY. H. L. [1866]

A patent for "improvements in the preparation of red and purple dyes," thus described the process: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour." It was proved (and not denied by the patentee) that it was necessary to apply heat in order to produce the colour; but evidence was given that a competent workman would apply heat:—Held, however, that this description in the specification was bad, and the patent founded thereon was invalid. (13 *W. R.* 577; 12 *L. T. Rep.*, *N. S.* 99. Affirmed in the House of Lords, *L. Rep.*, 1 *H. L.* 315; 35 *L. J.*, *Ch.* 811.) Westbury, L. C., hearing the case on appeal from Wood, V.-C., in the course of his judgment, said: "If the true construction of the specification be, that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is, therefore, invalid and bad at law." (13 *W. R.* 578.)

468. RUSHTON v. CRAWLEY. Ch. [1870]

Sir R. Malins, V.-C.: "The public must be told in very distinct language in every specification, what are the articles they may use, and what they may not use. Therefore, if a man makes a discovery, and, instead of limiting himself in his specification to that which properly is the discovery (if it be one), makes his specification too extensive, and claim more than he is entitled to claim, that is calculated to embarrass the

public, and is, I apprehend, a fatal objection to the patent.” (*L. R.*, 10 *Eq.* 527.)

469. ARNOLD v. BRADBURY. Ch. [1871]

Where a patentee, in his specification, professes to do by machinery, what has never been done before by machinery, and describes the machinery by which he does it, his claim is not too large on the face of it, because it claims generally to perform the operation “by machinery.”

A patentee in his specification described an improved ruffle or frill, and the machinery by which he proposed to make such improved ruffle, and to fasten it to a plain fabric by a single series of stitches. By his claim he claimed “the production by machinery of ruffles, and the simultaneous attachment of them to a plain fabric by a single series of stitches:”—Held, that the claim was not, on the face of it, too large. (*L. R.*, 6 Ch. 706.)

Specifying an Improvement.

470. WILLIAMS v. BRODIE. [Before 1785]

The invention was an improvement upon an old stove, but in the specification the whole stove was described, including both the old and new parts, without describing the invention as a new improvement upon an old thing, and it was held that the patent was therefore void. (Cit. *Dav. P. C.* 96.)

471. HORNBLOWER v. BOULTON. [1799]

The specification of a patent for a “method of lessening the consumption of steam and fuel in fire engines,” stated that the “method consisted in the following principles,” and then described the mode in which those principles were applied to the purposes of the invention. Lord Kenyon, C. J., in delivering judgment, said: “I do not consider it as a patent for the old engine, but only for the addition to, or improvement of,

the old engine. . . . It possibly occurred to the inventor, that if the patent were to be obtained for the whole engine, it might be open to cavil, and therefore he took out his patent not for the engine, but for his invention of a method of lessening the consumption of steam and fuel in fire engines. The method is disclosed in the specification, and it is by the addition of what is there disclosed, and by managing it in the way described. The patent therefore is only for that additional improvement as described in the specification; and there is no pretence to say that he claims or could claim the sole making of the old engine. (8 *T. R.* 103.)

472. HARMAR *v.* PLAYNE. [1809]

The patent in this case was granted for improvements in machinery, secured by previous letters patent. It was admitted by the defendant, that the improvements for which the second patent was granted are included in the second specification, which gives a full and proper description of the whole machine in its improved state. But it was objected, that the second specification does not, in any manner, point out or explain the improvements upon the former patented machine, for which the second patent was granted, and, therefore, that it was insufficient:—Held, that the specification was sufficient. (11 *East*, 101; *Dav. P. C.* 311.) Ellenborough, C. J., in the course of the argument, said: “The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose, that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted; when he can only tell by comparing it with some other patent what are the new, and what are the old parts; and if this may be done with reference to one, why not by reference to many other patents, so as to render the investigation very complicated? It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to

those the improvement; but, on many occasions, it may be sufficient to refer generally to them. As in the instance of a common watch; it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." (11 *East*, 107; *Dav. P. C.* 318.)

473. MACFARLANE v. PRICE. N. P. [1816]

A person ought to be warned by the specification against the use of the particular invention. Therefore, in the specification of a patent for an *improved* instrument, it is essential to point out precisely what is new, and what is old, and it is not sufficient to give a general description of the construction of the instrument without making such distinction, although a plate is annexed, containing a detached and separate representation of the parts in which the improvement consists. (1 *Stark.* 199; 1 *Web. P. C.* 74.)

474. BOVILL v. MOORE. N. P. [1816]

Action for the infringement of a patent for a machine or machines for making lace. The specification described the whole machine, without pointing out any particular part or parts of it, as the invention of the patentee. Gibbs, C. J., held, that, if a combination of a certain number of the parts of the machine up to a given point, had existed before the date of the patent, and if the patentee's invention sprang from that point, and added other combinations to it, then the specification, stating the whole machine as his invention, was bad. (*Dav. P. C.* 361.)

475. HILL v. THOMPSON. C. P. [1818]

If the invention be an improvement, it must distinctly appear on the face of the specification to be claimed as such, and not as an original discovery. (1 *Web. P. C.* 247.)

476. M'ALPINE v. MANGNALL. [1846]

If, taking the whole specification together, and giving its words a fair and reasonable interpretation, the court can see

that the specification only claims an improvement on an old machine, it will be sufficient. (3 *C. B.* 518.)

477. FOXWELL v. BOSTOCK. Ch. [1864]

In a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise, and in a more specific form, than by the general description of the entire machine. It is not sufficient that a person possessed of all the knowledge existing at the time of the patent on the subject-matter of the patent, will discern the improvement; or, that it may be discovered upon a minute comparison and collation of all existing combinations with the new combination that is claimed. The term "combination of machinery" is nothing but an extended expression of the word "machine." (10 *L. T. Rep.*, *N. S.* 144; 12 *W. R.* 723.)

478. PARKES v. STEVENS. [1869]

Where a patentee has taken out a fresh patent for improvements on his original invention, it is sufficient, if, reading his second specification with the first, an artisan would have no substantial difficulty in ascertaining what was claimed. (*L. R.*, 8 *Eq.* 358; judgment affirmed, *L. R.*, 5 *Ch.* 36.)

Sir W. M. James, V.-C., in the course of his judgment, said: "It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant, if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and common-place, all that was the subject of other patents, or of other improvements, bringing to the subject not only the knowledge of an ordinarily skilled artisan, but of a patent lawyer or agent." (*L. R.*, 8 *Eq.* 365.) See also *Murray v. Clayton*.

Variance between Provisional and Complete Specification.

In re NEWALL AND ELLIOTT. [1858] See 356.

FOXWELL *v.* BOSTOCK. Ch. [1864] See 358.

479. PENN *v.* BIBBY: PENN *v.* JACK. [1866]

The provisional specification of a patent for an improvement in the bearings and bushes for the shafts of screw and submerged propellers, described the invention as consisting in employing wood in the construction of such bearings and bushes. The complete specification, after describing the mode in which the wood was used, claimed the employment of wood in the construction of the bearings and bushes "as therein described:"—Held, that this was no such variation between the provisional and complete specification, as would invalidate the patent. (*L. R.*, 2 Ch. 127; 36 *L. J.*, Ch. 455; 15 *L. T. Rep.*, N. S. 399; 15 *W. R.* 208.)

480. THOMAS *v.* WELCH. [1866]

The provisional specification of a patent for sewing machines, claimed, amongst other improvements, that a certain instrument which moved the work, "or another acting therewith," acted to hold the work during the insertion of the needle, while the complete specification appeared to describe only one instrument as moving and holding the work:—Held, that such a variance would not invalidate the patent. (*L. R.*, 1 C. P. 192; 12 *Jur.*, N. S. 316; 35 *L. J.*, C. P. 200.)

481. WRIGHT *v.* HITCHCOCK. [1870]

The title of the patent being for improvements in the manufacture of frills or ruffles, and the provisional specification describing the invention as relating to a particular manufacture of frills and ruffles, the complete specification described the invention as relating to a particular manufacture of frills, ruffles, or *trimmings*:—Held, that this was no such material variation, as to render the patent invalid. (*L. R.*, 5 *Exch.* 37; 39 *L. J.*, *Exch.* 97.) Kelly, C. B., said: "A third point made is that there is an inconsistency between the provisional and the final specification, the word 'trimming' being added in the latter. But by whatever name it is

described, the thing is in itself identical; it is something attached to any part of the dress, either of men or women, whether it is called the frill of a sleeve, or the ruffle of a shirt, or the trimming of a lady's dress. These are all *ejusdem generis*, and the description is only important for the purpose of showing for what purpose the product may be ultimately used when it has been manufactured by means of the plaintiff's invention." (*L. Rep.*, 5 *Ex.* 46.) Channell, B.: "One of the objections turns on the form of the specification, the final specification going, it is said, beyond the provisional. I do not think it necessary to discuss in general the relation of the provisional and complete specifications. In the view which I take of the circumstances of the case that question does not arise, for there being no proof or suggestion of fraud, I do not think that there is any such extension of the claim in the final specification as disables the plaintiff from claiming this as a good patent." (*Ib.* 49.)

How affected by subsequent Discoveries.

482. CROSSLEY v. BEVERLEY. N. P. [1829]

Action for the infringement of a patent for "an improved gas apparatus." In the specification the patentee said: "My improved gas apparatus is for the purpose of extracting inflammable gas by heat from pit coal, or tar, or any other substance from which gas or gases capable of being employed for illumination can be extracted by heat." It was objected to the sufficiency of the specification, that the retort described would not do for making gas from oil. Before the date of the specification, however, oil had never been employed for that purpose:—Held, that the specification was sufficient. (3 *C. & P.* 513; *Mo. & Mal.* 283; 1 *Web. P. C.* 106.) Tenterden, C. J., said: "I think it quite clear in this specification, when he speaks of coal and other matters, he means matters *ejusdem generis*. The patentee must be understood to mean things that were in use, and not things which would produce gas, as everything inflammable would, but, from being so expensive, was never expected to be in use. . . . The patentee never supposes that they will apply oil for the purpose of lighting towns

and rooms, because it was too expensive. A man must have the spirit of prophecy if he knows that people will apply those things to the purpose for which they were not considered applicable at that time." (1 *Web. P. C.* 107.)

483. LEWIS v. MARLING. [1829]

A party took out a patent for an improved shearing machine, to shear woollen cloth, and claimed four things as his invention—one of them was, a proper substance (plush) to brush the cloth. In describing the machine in the specification, he directed plush to be used for this purpose, but he nowhere stated that this was an essential part of his machine.

Bayley, J., said: "At the period when this specification was made, the plush was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material; and I am of opinion that the subsequent discovery, that the plush was unnecessary, is no objection to the validity of the patent." (4 *C. & P.* 57; 10 *C. B.* 27; 1 *Web. P. C.* 496.)

484. NEILSON v. HARFORD. [1841]

If the apparatus, described in a specification, can be used beneficially in its simplest form, it is no objection that great improvements may have been made. (8 *M. & W.* 806.)

THE ELECTRIC TELEGRAPH COMPANY v. BRETT. [1851]
See 16.

TETLEY v. EASTON, N. P. [1852] See 462.

485. HEATH v. UNWIN. H. L. [1855]

Parke, B.: "The specification must be read as persons acquainted with the subject would read it, at the time it was made; and if it could be construed as containing any chemical equivalents, it must be such as are known to such person at that time; but those which are not known at the time as equivalents, and afterwards are found to answer the same purpose, are not included in the specification." (25 *L. J., C. P.* 19.)

486. SIMPSON v. HOLLIDAY. Ch. [1864]

Where a patentee describes, in his specification, his invention

in the best form that science could then give it, it is immaterial that a cheaper way of carrying out the invention has been subsequently discovered. (20 *Newt. Lon. Jour.*, N. S. 116.)

BETTS *v.* NEILSON. Ch. [1868] See 380.

The Claim.

487. KAY *v.* MARSHALL. Ch. [1836]

Lord Cottenham, L. C., said: "It (the claim) is introduced, lest in describing and ascertaining the nature of his invention, and by what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification, as containing the description, be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they professed to be part of the description." (2 *Web. P. C.* 39; 1 *My. & Cr.* 383.)

488. WALTON *v.* BATEMAN. N. P. [1842]

Action for the infringement of a patent for "certain improvements in cards for carding wool," &c. The specification stated the invention "to consist in the application and adaptation of the material known by the name of caoutchouc, or India-rubber, as a substitute for the fillets or sheets of leather which are commonly used in the construction of ordinary cards, and thus giving a superior elasticity and durability to such cards." The claim was for "the application and adaptation of caoutchouc or India-rubber as the fillet or sheet, or medium in which the dents or teeth are to be set together in the manufacture of cards, and thereby obtaining a superior elasticity and durability to cards as above described." In describing the method of carrying out the invention, the patentee recommended that a piece of linen should be fastened to the back of the India-rubber.

Cresswell, J., said to the jury: "I was called on to express some opinion as to whether the plaintiff claimed, as an essential part of his patent, the application of linen, but I cannot help thinking there is some little confusion in the use of the term, 'what he claims as an essential part of his patent.' He claims, as distinctly as possible, the application of India-rubber as a substitute for leather in making the backs of cards in order to get an elastic bed; that is what he claims, and there is nothing about the cloth in that. But it is not sufficient that a man should claim a principle. He must add to it in his specification a mode of working out that principle practically, and that he does now; for you will find he recommends, as the best mode of working that out, the application of the cloth, but he does not profess to say it cannot be done without. If he had said, it cannot be done without, I should have thought he would have said the linen was essential to the working out of his principle." (1 *Web. P. C.* 622.)

489. HEATH v. UNWIN. H. L. [1855]

Pollock, C. B.: "The right of the plaintiff does not turn upon the extent of his claim, but upon the communication made to the public as to the mode of accomplishing his object, and he has no right to claim anything but that which he has communicated to the public, however large in point of language his claim may appear to be." (5 *H. L. Cas.* 540; 25 *L. J.*, *C. P.* 20.)

490. TETLEY v. EASTON. [1857]

A patentee describing his invention in the specification, is to be taken to claim as part of his invention all that he describes as the means by which it is to be carried into effect, unless he clearly expresses a contrary intention. (2 *C. B.*, *N. S.* 706; 26 *L. J.*, *C. P.* 269.)

491. LISTER v. LEATHER. Ex. Ch. [1858]

A claim is not an essential part of a specification, or necessary for the protection of the patent. (8 *E. & B.* 1034; 27 *L. J.*, *Q. B.* 296.)

Effect of Drawings annexed to Specification.

492. BOULTON v. BULL. [1795]

Rooke, J.: "I am not aware of any rule of law which requires a model or a drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement, merely because no drawing or model is annexed." (2 *H. Bl.* 481.)

493. Ex parte Fox. Ch. [1812]

Lord Chancellor Eldon: "I take it to be clear, that a man may, if he chooses, annex to his specification a picture or a model descriptive of it; but his specification must be in itself sufficient; or, I apprehend, it will be bad." (1 *V. & B.* 67; 1 *Web. P. C.* 431.)

494. BOVILL v. MOORE. [1816]

The drawings annexed to the specification need not be well executed, or skilfully drawn; they are sufficient if they enable a workman of fair and competent skill in mechanism to make the patented machine. (*Dav. P. C.* 369.)

MACFARLANE v. PRICE. [1816] See **473.**

495. BRUNTON v. HAWKES. N. P. [1820]

Abbott, C. J.: "If a drawing, or figure, enables workmen of ordinary skill to construct the improvement, it is as good as any written description." (1 *Carp. P. C.* 410.)

496. BLOXAM v. ELSEE. N. P. [1825]

Abbott, C. J., said: "An inventor of a machine is not tied down to make such a specification, as, by words only, would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient." (1 *C. & P.* 564.)

497. MORGAN v. SEAWARD. N. P. [1836]

Drawings are to be taken as part of the specification. (1 *Web. P. C.* 173.)

498. HASTINGS v. BROWN. [1853]

A drawing may be taken to explain an ambiguity in the written description of the invention contained in the specification. (1 *E. & B.* 454.)

499. MORTON v. MIDDLETON. [1863]

Drawing connected with the specification, and referred to in the letter-press, are to be examined and construed in connection with the specification ; and, therefore, their intelligibility is a matter for the jury. (1 *Cr. S.*, 3rd Ser. 722.)

The absence of a scale attached to drawings with a specification is an imperfection ; and when any question as to identity of proportions arise, their absence becomes a matter of importance. (*Ib.* 724.)

500. FOXWELL v. BOSTOCK. Ch. [1864]

Lord Westbury, C. : “ It was contended by the plaintiff’s counsel, and perhaps justly, that a patent for a new machine would be good if the specification contained nothing but clear drawings of the machine and a description of them.” (4 *De G.*, *J. & S.* 303 ; 10 *L. T. Rep.*, *N. S.* 146.)

501. DAW v. ELEY. Ch. [1867]

Where a specification in the first instance describes the invention in too general terms, but afterwards, in describing the method of performing the invention, refers to certain figures in drawings annexed thereto, and the claim made is for the manufacture of the invention described with reference to those figures, the specification is sufficient. (*L. R.*, 3 *Eq.* 500, n. ; 14 *W. R.* 126 ; 13 *L. T. Rep.*, *N. S.* 399.)

502. POUPARD v. FARDELL. Ch. [1869]

Malins, V.-C. : “ A specification may consist of a drawing alone, and *Ex parte Fox* is clearly overruled.” (18 *W. R.* 129.)

*Verbal Errors in.***503. DEROSNE v. FAIRIE.** [1835]

The patentee, who was a Frenchman, used, in his specification, the word "discolouring" to signify depriving of colour, and the word "baked," instead of the word crystallized:—Held, that this did not render the specification void. (5 *Try.* 393; 2 *Cr. M. & R.* 476; 1 *Web. P. C.* 158; 1 *Gale*, 109.)

504. MINTER v. MOWER. N. P. [1835]

It is quite indifferent whether a word used in a specification is the correct description of the thing, provided it describes it so that no man can doubt what it is. (1 *Web. P. C.* 141.)

505. NEILSON v. HARFORD. [1841]

A patent is not vitiated by a mistake in the specification, as where air is called an imponderable substance, or sulphur a mineral; nor by a mistake in a matter foreign to the invention, which cannot mislead; nor by the inaccurate use of words which are explained by the context. (1 *Web. P. C.* 331.)

506. SIMPSON v. HOLLIDAY. Ch. [1865]

Lord Westbury, L. C., in delivering judgment, said: "When it is stated that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification, or the drawings it refers to; or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is, because such errors cannot possibly mislead. But the proposition is not a correct statement of the law, if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject." (13 *W. R.* 578; 12 *L. T. Rep.*, N. S. 99.)

507. NEILSON v. BETTS. H. L. [1871]

After a patent has stood inquiry and the test of time, courts do not encourage verbal objections to the form of the specification. (*L. Rep.*, 5 *H. L. Cas.* 1; 40 *L. J.*, *Ch.* 317; 19 *W. R.* 1121.)

*Construction of, generally.***508. HULLETT v. HAGUE. [1831]**

Lord Tenterden, C. J.: "I cannot forbear saying, that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them." (2 *B. & Ad.* 377.)

509. HARWORTH v. HARDCASTLE. [1834]

Tindal, C. J.: "There can be no rule of law which requires the court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts would warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent." (1 *Web. P. C.* 485.)

A patentee is to be presumed not to claim things which he must have known to be in use. (*Ib.* 484.)

510. RUSSELL v. COWLEY. [1834]

Alderson, B.: The specification ought to be taken as a whole, and fairly and candidly construed, without astuteness to pick holes in it.

Parke, B.: In the construction of a patent, the court is bound to read the specification so as to support it, if it can fairly be done. (1 *Web. P. C.* 470.)

511. DEROSNE v. FAIRIE. N. P. [1835]

Matters of construction that arise on the face of the patent and specification are matters of law for the court, subject to

the sense put upon the terms of art by the jury. (1 *Web. P. C.* 156.)

512. BICKFORD v. SKEWES. [1841]

The language of the specification ought not to be astutely construed, so as to overthrow a patent. (1 *Q. B.* 950; 1 *Web. P. C.* 219.)

513. NEILSON v. HARFORD. [1841]

The construction of the specification is for the Court, the meaning of the words and surrounding circumstances having been ascertained by the jury. Parke, B., delivering the judgment of the Court of Exchequer, held it a just rule of construction, to judge of the meaning of a particular phrase by taking the whole instrument together; and he construed the word "effect" in one part of the specification as meaning beneficial effect, because it was evidently used in that sense in some other parts of the specification. (1 *Web. P. C.* 295.)

514. THE HOUSEHILL COMPANY v. NEILSON. [1843]

The letters patent and specification constitute one instrument, and are to be interpreted according to the ordinary sense of the terms. (1 *Web. P. C.* 679.)

515. ELLIOTT v. TURNER. Ex. Ch. [1845]

The words of a specification are to be construed according to their ordinary and proper meaning, unless it be shown by something in the context (which may be explained by evidence) that a different construction ought to be adopted. (2 *C. B.* 446; 15 *L. J., C. P.* 49.)

516. STEVENS v. KEATING. N. P. [1847]

Pollock, C. B.: "Some observations have been made at the bar on the subject of patents and specifications, and the different rules of construction that have been maintained at different

periods. I take the rule to be, that you are not to intend anything in favour of a specification or patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon every allegation and every fact connected with it, and you are to find what is the true and fair and just result. You are not to lean in favour of the public against the patent, which it is to be regretted was many years ago rather the fashion of the courts of justice, under the notion that it was a monopoly, that all monopolies were odious, and that, therefore, you were to intend everything against them; although, on the other hand, in modern times, it is said the leaning is the other way, I do not think there ought to be any leaning one way or the other." (2 *Web. P. C.* 187.)

517. BEARD v. EGERTON. [1848]

In the construction of the specification, the whole instrument must be taken together, and a fair and reasonable interpretation given to the words used in it. (8 *C. B.* 165; 13 *Jur.* 1004; 19 *L. J., C. P.* 36.)

518. SELLERS v. DICKINSON. [1850]

Pollock, C. J.: "The specification should be met with candour and indulgence." (5 *Ex.* 324.) Rolfe, B.: "The court should read a specification as a person of ordinary understanding would do, not loosely conjecturing anything, but, at the same time, not scanning it as if it were a special plea." (5 *Ex.* 326.)

519. THE ELECTRIC TELEGRAPH COMPANY v. BRETT. [1851]

Patent "for improvements in giving signals and sounding alarms in distant places, by means of electric currents transmitted through *metallic circuits*." Subsequently to the patent, it was discovered that the return current could be conducted back to the battery through the earth as effectually as through a continuous metallic circuit. The defendant contended that,

by using this method, they did not infringe the plaintiff's patent. Cresswell, J., delivering the judgment of the Court of Common Pleas, said: "With respect to the specification, it is to be observed, that the claim of the patentees being for improvements not all immediately connected with, or dependent on, each other, but all applicable to giving signals, &c., by means of electric currents, the plan adopted in the specification, was, to give an account of the whole system or mode of transmission of electric currents for the purpose of giving signals, and the modes of giving those signals, specifying afterwards those parts claimed as improvements, and either expressly disclaiming, or leaving unclaimed, all that was not expressly claimed. It is obvious, that in such a specification, that part which describes the matter claimed, is to be much more strictly construed than that which, though necessarily mentioned, is not spoken of as a new matter, or as the subject of a grant, but only as something known, and necessary to be referred to for the purpose of explaining the claim. Considered in this view, we think the specification, in speaking of metallic circuits, may properly be considered as comprehending all circuits which are metallic, as far as it is material to the improvements claimed that they should be so; and that the expression in question is not to be construed with more strictness and precision than is necessary to enable it to fulfil that purpose of explanation for which it was introduced. (10 *Com. B.* 880.) It appears to us reasonable to hold that a claim for a patent for improvements in the mode of doing something by a known process, is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed, and their application." (*Id.* 881.)

520. *NEWTON v. VAUCHER.* [1851]

Specifications are to be read in connection with their titles. (6 *Exch.* 864.)

521. TETLEY v. EASTON. N. P. [1852]

Pollock, C. B.: Specifications are to be construed in a candid and fair spirit, and if any mistake in one part can be corrected by other parts of the specification, such correction should be made. (*Macr. P. C.* 74.)

522. PALMER v. WAGSTAFF. [1854]

Pollock, C. B.: "A patent or specification should be construed in the sense which the patentee intended, and if any expressions are ambiguous, we should endeavour to give effect to the intention; and, moreover, I think that every patent should be expounded favourably to the patentee. But we ought not to violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate." (9 *Exch.* 501.)

523. UNWIN v. HEATH. H. L. [1855]

Crompton, J.: "I think that it would be a narrow and dangerous construction to limit the invention, claimed in express words, by the mode and process of working which the plaintiff sets forth, as a means of carrying his invention into effect." (25 *L. J., C. P.* 12.)

524. BOVILL v. PIMM. [1856]

The construction of a specification is a question of law when the facts are not disputed. (11 *Exch.* 740.)

HILLS v. THE LONDON GAS LIGHT COMPANY. [1857]

See **542.**

THOMAS v. FOXWELL. [1858] See **556.**

525. SEED v. HIGGINS. H. L. [1860]

Lord Campbell, L. C.: "Where novelty or infringement depend merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine, or a material part of one machine, imitates or resembles another in that which is the alleged

invention, it generally becomes a mixed question of law and fact which must be left to the jury." (8 *H. L. Cas.* 561.)

526. BETTS v. MENZIES. H. L. [1861]

Blackburn, J., said: "I agree with what was said by Mr. Justice Crompton, in the Court below, that if the general claim to the use of an invention were cut down and limited to the use of the invention in the particular way pointed out by reason of the words 'as herein described,' it would be a narrow rule of construction, generally working to the detriment of patentees; and, what weighs more with me, generally giving an effect to specifications different from what the persons drawing them intended, or those reading them understand." (10 *H. L. Cas.* 140.)

527. HILLS v. EVANS. Ch. [1862]

The construction of a specification, as the construction of all other written instruments, belongs to the Court; but the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which it is the province and right of a jury to decide. But when those portions of a specification are made the subject of evidence, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction upon the hypothesis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. (31 *L. J., Ch.* 457; 8 *Jur., N. S.* 525.)

528. MACKELCAN v. RENNIE. [1862]

In construing a specification, it is not competent to the inventor to pray in aid the provisional specification, in order to

explain or enlarge the meaning of the complete specification. (13 *C. B.*, *N. S.* 52.)

529. SIMPSON v. HOLLIDAY. [1866]

Lord Westbury, L. C., hearing the case on appeal from Wood, V.-C., in the course of his judgment, said: "With respect to the rules that govern the construction of specifications, they are the ordinary rules for the interpretation of written instruments, having regard especially to the fact that the specification must clearly fulfil the obligation imposed on the patentee by the proviso contained in all letters patent, viz., that the grant shall be void if the patentee shall not particularly describe and ascertain the nature of his invention, and in what manner the same is to be performed. It is, therefore, made a settled rule, that the specification must be so expressed as to be perfectly intelligible to a workman of ordinary knowledge, and it must follow, that if there be any obscurity or ambiguity in the specification which is likely to mislead, this defect ought not to be helped by any refined or secondary interpretation of the language. It was contended before me, and the Vice-Chancellor is reported to have said, that it has been settled by authority that the most liberal construction is to be given to the patent that will sustain it, especially in those cases where the Court is satisfied that the invention is really new and useful. (20 *Newt. Lon. Jour.*, *N. S.* 107.) If the words, 'the most liberal construction' are intended to denote some principle of interpretation different from the ordinary rules for the construction of written instruments, I am not aware of any such authority." (13 *W. R.* 578.)

Construction of, in particular Cases.

530. FORSYTH v. RIVIERE. [1819]

Patent for a "method of discharging or giving fire to artillery, and all other fire-arms, mines, chambers, cavities and places in which gunpowder, or other combustible matter, is or may be put for the purpose of explosion." The specification pointing out

how the invention was to be carried out:—Held, that the patentee was entitled to the exclusive application of the detonating mixture as priming, whatever the construction of the lock by which it was discharged. (1 *Web. P. C.* 97.)

BLOXAM *v.* ELSEE. [1827] See 454.

HULLETT *v.* HAGUE. [1831] See 111.

531. MINTER *v.* WELLS. [1834]

In summing up his invention, a patentee stated it thus:—“My invention is the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair, as above described:”—Held, that this was not a claim to the principle of the lever, but to an application of that principle to a certain purpose, by certain means, and that the patent was good. (1 *C. M. & R.* 505; 5 *Tyr.* 163; 1 *Web. P. C.* 134.)

532. RUSSELL *v.* COWLEY. [1835]

A patent claimed the invention of manufacturing tubes by drawing them through rollers, using a mandrel in the course of the operation. A later patent claimed the invention of manufacturing tubes by drawing them through fixed dies or holes, but the specification was silent as to the use of the mandrel:—Held, that the Court, taking the whole of the latter specification together, would infer that the mandrel was not to be used, and that the latter patent was good. (1 *C. M. & R.* 864; 1 *Web. P. C.* 463.)

533. GIBSON *v.* BRAND. [1842]

A patent was obtained for a new and improved process or manufacture of silk, and silk in combination with certain other fibrous substances. By the specification, the inventors declared the nature of the invention to consist of eight several and distinct parts or heads, the sixth being “the application of an improved process to the throstle machine, on the principle of the long-ratch, for the new and useful purpose of spinning

silk waste ;” and the seventh, “ certain improvements effected by them in the throstle machine, by which the utility in spinning silk waste was greatly augmented.” After describing the old process of converting silk waste into yarn, the specification proceeded to describe the novel process by which the plaintiffs produced their new or improved manufacture ; and, referring to drawings, continued : “ the annexed drawings for the most part represent the well-known spinning-frame, called a ‘ throstle,’ on the principle of the long-ratch, as implied in the spinning of flax ; which machine, combined with the improvements we have applied to it, we apply to the new and useful purpose of spinning silk waste of long fibres, in combination with flax or wool.” And the specification concluded thus :— “ We desire it to be understood that we disclaim those parts of the process, or mechanism, which were, or may have been, previous to the granting of our patent, well known or in use for the same purposes ; but we restrict our claims to the eight several heads of invention mentioned in the early part of the specification, all of which we believe to be new, and of great public utility :”—Held, that this was a claim, either of a new invention, or a new combination of parts of the throstle machine ; and the jury having found “ that the invention was not new, but an improved process, not a new combination,” that the patent could not be supported. (4 *Scott, N. R.* 844 ; 4 *M. & G.* 179 ; 1 *Web. P. C.* 631.)

534. MACNAMARA v. HULSE. N. P. [1842]

Action for the infringement of a patent for “ certain improvements in paving, pitching, or covering streets, roads, and other ways.” The patentee, in his specification, said : “ My invention consists in an improved mode of cutting or forming stone, or other suitable material, for paving or covering roads.” The infringement complained of was the manufacture of wooden blocks according to the improvement of the plaintiff. Abinger, C. B., said : “ I think that the words ‘ any other suitable material’ include a wood pavement, though probably the plaintiff never contemplated it.” (*Car. & Marsh.* 477 ; 2 *Web. P. C.* 129.)

535. MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships and other such vessels." The patentee, in his specification, said: "I take that quality of copper known in the trade by the appellation of 'best selected copper,' and that quality of zinc known in England as 'foreign zinc,' and melt them together in the usual manner in proportions between 50 per cent. of copper to 50 per cent. of zinc, and 63 per cent. of copper to 37 per cent. of zinc, both of which extremes and all intermediate proportions will roll at a red heat."

Tindal, C. J., in summing up to the jury, said: "You have had evidence before you that 'best selected copper' is the very purest that can be had. What I understand, therefore, when he says, 'I take that quality of copper known in the trade by the appellation of 'best selected copper,' he takes it of that degree of purity of which the best selected copper was known at the time to consist. He adds also, 'and that quality of zinc known in England as foreign zinc.' I do not understand him to mean it should be made of foreign zinc alone, but of zinc of that quality wherever it was made." (2 *Web. P. C.* 104.)

536. ELLIOTT v. TURNER. Ex. Ch. [1845]

In covenant on an indenture, by which B. was licensed to make and sell buttons according to A.'s patent, the issue was, whether certain buttons, made by B., were made under the licence. The specification described the invention to consist in the application to the covering of buttons, of such figured woven fabrics "wherein the ground, or the face of the ground thereof, is produced by a warp of *soft or organzine silk*, such as is used in weaving satin and the classes of fabrics produced therefrom." The jury asked how they were to understand the word "or" in the specification; whether it was used disjunctively, or whether "*organzine*" was the construction of the word "*soft*." The judge told them, that, in his opinion, unless the silk was *organzine*, it was not within the patent:—Held, that this direction was erroneous; for that the judge

should not have told the jury, absolutely, that soft and organzine silk were the same, but that the words were *capable* of being so construed, if the jury were satisfied that, at the date of the patent, there was only one description of soft silk,—and that organzine,—used in satin weaving; but, otherwise, that the proper and ordinary sense of the word “or” was to be adopted, and the patent held to apply to every species of soft silk, as well as to organzine silk. (2 *C. B.* 446; 15 *L. J.*, *C. P.* 49.)

537. M'ALPINE v. MANGNALL. [1846]

Patent for “improvements in machinery or apparatus for stretching, drying, and finishing woven fabrics.” The specification, after explaining the mode of conducting the operation, continues:—“We are perfectly aware that many simple contrivances might be devised for effecting the object of our improvements, viz. giving vibrating motion to the selvages of the cloth, for the purposes above stated; but as it is not practicable to describe every possible method in detail, we desire it to be understood that any mode even of moving one side or selvage of the cloth whilst the other remains stationary, we shall consider to be an evasive imitation of our invention, if for the purpose of drawing the threads into diagonal positions by mechanical means instead of manual labour:”—Held, that the patentee claimed, not the whole machine, but only those improvements which gave the vibrating motion to the fabric while in the course of dyeing. (3 *C. B.* 496; 15 *L. J.*, *C. P.* 298.)

538. BARKER v. GRACE. [1847]

The specification of a patent for “improvements in the process of finishing hosiery, and other goods manufactured from lamb’s-wool, &c.,” stated the invention to consist in submitting hosiery, and other similar goods, to the finishing process of a *press* heated by steam, &c., *in the manner hereinafter mentioned*. A description was then given, by letters, of a drawing which represented a press, which consisted of a box heated by steam, up to which another box similarly heated was to be pressed by

means of hydraulic pressure, or by screws or other well-known means. After describing the method of pressing the goods between these hot boxes, the specification concluded by confining the inventor's claim to the submitting hosiery and similar goods to the pressure of hot *boxes or surfaces* heated by steam *as above described*:—Held, that the specification did not claim a general mode of applying hot surfaces to fabrics, but that it was merely for the particular machine described in the specification, and that a method of finishing hosiery goods, by passing them through heated *rollers*, was not included in the patent. (1 *Exch.* 339; 17 *L. J.*, *Exch.* 122.)

Pollock, C. B., said: “Were the Court to hold that rollers are included in this patent, the effect of it would be, that if the party could have kept his process a secret in point of fact, and have given the public nothing but what they could gather from the specification, he might have had the exclusive use of rollers under the protection of the law for fourteen years, and at the end of that period the public would be wholly ignorant that rollers were capable of being used, and had been used, for such a process, or that they were the object of the patent.” (1 *Exch.* 344.)

539. STEVENS v. KEATING. [1848]

Patent for “a process or method of combining various materials so as to form stuccoes, plasters, and cements, and for the manufacture of artificial stones, marbles, &c. used in buildings.” The specification, after stating the invention to consist in producing certain hard cements of the combination of the powder of gypsum, powder of limestone, and chalk, with other materials, such combinations being (subsequent to their mixing) submitted to heat, described the method or process of making a cement from gypsum to consist in mixing with powdered gypsum, strong alkali (*ex. gr.* best American pearl-ash) dissolved in a certain proportion of water; this solution to be neutralized with acid (sulphuric acid being the best), the mass to be kept in agitation, and the acid to be added gradually till the effervescence should cease; and then a certain proportion

of water to be added (if other alkali were used, the quantity to be varied in proportion to its strength); and the mixture having been brought to a proper consistence by the further addition of powdered gypsum, to be dried in moulds, and finally subjected to a furnace capable of producing a red heat. The specification concluded by stating that other alkalies and acids beside those before mentioned would answer the purposes of the invention, though not so well, and that the inventor claimed the method or process thereinbefore described:—Held, that the specification was bad. “It must either be a claim of all acids and alkalies, or of all acids and alkalies that will answer the purpose. If it be a claim of all acids and alkalies, it is clearly bad, as there are some which will not answer the purpose. If it be a claim of those only which will answer the purpose, it is as clearly bad, in consequence of not stating those which will answer the purpose, and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not.” (2 *Exch.* 772; 19 *L. J.*, *Ex.* 57.)

540. BEARD v. EGERTON. [1849]

A specification of a patent for “a new and improved method of obtaining the spontaneous reproduction of all the images received on the focus of the camera obscura,” in describing the process, stated: “It is to be divided into five operations. The first consists in polishing and cleaning the silver surface of the plate, in order to properly prepare or qualify it for receiving the sensitive layer or coating (iodine), upon which the action of the light traces the design; the second operation is the applying that sensitive layer or coating to the silver surface; the third, in submitting, in the camera obscura, the prepared surface or plate to the action of light, so that it may receive the images; the fourth, in bringing out or making appear the image, picture, or representation, which is not visible when the plate is first taken out of the camera obscura; the fifth, and last operation, is that of removing the sensitive layer or coating, which would continue to be affected and undergo different changes from the

action of light; this would necessarily tend to destroy the design or tracing so obtained in the camera obscura." It then proceeded to give a description of the first operation,—preparing the silver surface of the plate; the concluding part of which directed that nitric acid dissolved in water should be applied *three* different times, the plate being each time sprinkled with pounce, and lightly rubbed with cotton; adding, "When the plate is not intended for immediate use or operation, the acid may be used only *twice* upon its surface after being exposed to heat; the first part of the operation, that is, the preparation as far as the second application of the acid, may be done at any time; this will allow of a number of plates being kept prepared up to the last slight operation; it is, however, considered indispensable, that, just before the moment of using the plates in the camera, or the reproducing the design, to put at least once more some acid on the plate, and to rub it lightly with pounce, as before stated; finally, the plate must be cleaned with cotton from all pounce dust which may be on the surface, or its edges." In a subsequent part of the specification, having described the *second* operation, viz., the application of the iodine, the inventor observed: "After this second operation is completed, the plate is to be passed to the third operation, or that of the camera obscura; whenever it is possible, the one operation should immediately follow the other:"—Held, that, taking the whole specification together, the direction as to the third application of acid was not to be understood to be a direction to apply the acid after the second operation, viz., the coating the plate with iodine,—which, it was proved, would render the whole process abortive,—but to apply it as part of the first operation; and that the specification gave sufficient information to an operator of reasonable skill, and was therefore sufficient. (8 C. B. 165; 13 Jur. 1004; 19 L. J., C. P. 36.)

541. HOLMES v. THE LONDON AND NORTH WESTERN RAILWAY COMPANY. [1852]

The plaintiff obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not

enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found, that the introduction of certain suspending rods made the table a new instrument. Jervis, C. J., in delivering judgment, said: "The claim in substance is this—'for an improved turning-table.' Now, that will not have the effect of making everything that follows a combination, merely because he claims the turning-table." (*Macr. P. C.* 27.) Maule, J., after pointing out that the patentee had not distinguished what was new from what was old, said: "If it be impliedly said in the specification, that the suspension rods are new, and an improvement on what existed before, the same implication arises as to every other part." (*Ib.* 29.)

542. HILLS v. LONDON GAS LIGHT COMPANY. [1857]

Though the construction of a patent or specification is ordinarily for the judge, yet where a specification mentioned "the precipitated or hydrated oxides of iron," and there was (on the issue of novelty) a prior patent proved, the specification of which mentioned carbonate of iron, and the scientific evidence showed that real carbonate of iron was difficult to be preserved, that it was not commonly sold in the shops (though it existed as a chemical substance), and what was sold for it would be, in fact, a hydrate, through absorption, but that carbonate would not be understood chemically as meaning hydrate; the judge, having ruled that the specification was to be construed commercially not scientifically, that carbonate commercially meant the "hydrate," and that, on the issue of novelty, the plaintiff must be nonsuited, the Court, after great doubt, set aside the nonsuit, and granted a new trial. (27 *L. J.*, *Exch.* 60.)

543. THOMAS v. FOXWELL. Ex. Ch. [1859]

The patentee of a sewing machine, in his specification, claimed "the application of a shuttle in combination with a needle, as shown in sheet 1, for forming and sewing loops of

thread or other substance, for the purpose of producing stitches either to unite or ornament fabrics, whatever may be the means employed for working such shuttle and needle when employed together." By a disclaimer he stated, "I do not claim the use in a machine of several needles and shuttles, nor do I claim any of the mechanical parts separately of which the machinery shown in the drawing is composed:"—Held, (affirming the judgment of the Court of Queen's Bench (5 *Jur.*, *N. S.* 37),) that the claim was not confined to the single application of a shuttle in combination with a needle, as shown in sheet 1, but extended generally to the application of a shuttle with a needle, for attaining the object therein stated. (6 *Jur.*, *N. S.* 271.)

544. HILLS v. THE LONDON GAS LIGHT COMPANY. [1860]

In a patent for an improved mode of manufacturing gas, the plaintiff claimed a mode of purifying gas by means of "hydrated or precipitated oxide of iron:"—Held, that this included only precipitated hydrates. (5 *H. & N.* 312; 29 *L. J.*, *Ex.* 409.)

Bramwell, B., in delivering the judgment of the Court of Exchequer, said: "The next objection was, that the plaintiff's specification was insufficient on this ground. He says: 'I use the hydrated *or* precipitated oxides.' It was said that included all hydrated oxides, and inasmuch as some of the natural hydrated oxides would not do, the plaintiff's specification was bad. Now, that question turns upon this: If the plaintiff in his specification means all the hydrated oxides, it is open to that objection; but if he means only those hydrated oxides which are also precipitated,—that is, the artificial hydrated oxides—it is not open to that objection. It may be said that the language is in any sense ungrammatical, and that hydrated or precipitated—the whole or the part—cannot be right. To say, 'The works of Shakespeare, or Hamlet and King Lear,' would obviously be an inaccuracy, which cannot be judged by the ordinary rules of grammar, and therefore we must endeavour to find out the proper meaning of this inaccurate expression. It appears to us, upon looking at the specification, that the plaintiff uses those equivalent expressions, because he says 'hydrated or pre-

ciptated,' and that oxide of iron may be conveniently *prepared* for these purposes, and so on; and therefore it is obvious that when he uses that word hydrated, he uses it as synonymous with precipitated; and consequently, when he speaks of using hydrated or precipitated oxides, he means such hydrated oxides as are precipitated." (5 *H. & N.* 368; 29 *L. J., Ex.* 424.)

545. OXLEY v. HOLDEN. [1860]

Patent for "certain improvements in the doors and sashes of carriages." One part of the invention was described as "a novel arrangement and mode of fitting and working sliding sashes, glass frames, blinds and shutters for railway and other carriages," which consisted of a metal plate, with a slot and a stud or pin working in a groove on each side of the sash or frame; and the patentee claimed "the metal fittings and the mode of applying the same, described herein as the second part of my invention." The description of the metal fittings was inseparably interwoven, throughout the specification, with the mode of applying them:—Held, that this was a claim, not for the metal fittings themselves, but for the mode of applying them, and consequently, that the patent was sustained by proof that the application was new, though the stud and plates themselves were old. (8 *C. B., N. S.* 666; 30 *L. J., C. P.* 68; 8 *W. R.* 626; 2 *L. T. Rep., N. S.* 464.)

546. SIMPSON v. HOLLIDAY. Ch. [1864]

A patentee, in his specification of a patent for preparing red and purple dyes, said: "I mix aniline with *dry* arsenic acid," &c. At the date of the patent an arsenic acid entirely free from water was known to chemists as anhydrous arsenic acid, but could not be commonly bought in the trade. This would not produce the dyes. A hydrated acid, containing from 12 to 14 per cent. of water was commonly sold by manufacturers, which was dry to the touch, and known in the trade as "dry arsenic acid." This would produce the dyes. Wood, V.-C., found, on the ground that the specification was addressed to manufacturers, and not to scientific chemists, that "dry arsenic acid" meant dry hydrated arsenic acid. (20 *Newt. Lon. Jour., N. S.* 118.)

547. RALSTON v. SMITH. H. L. [1865]

R., in his specification, described his patent for improvements in embossing and finishing woven fabrics, as enabling him, upon a roller, either spirally or longitudinally, or in a circular form, to groove, or flute, or engrave, or mill, or otherwise indent any design. The fact was, that if the design was engraved longitudinally it would destroy the material. R. therefore, in a disclaimer, altered "upon" into "around the roller:"—Held, that the construction of the specification, as amended by the disclaimer, excluded spiral engraving, and confined it to circular engraving or grooves. (11 *H. L. Cas.* 223; 35 *L. J., C. P.* 49; 13 *L. T. Rep., N. S.* 1; 20 *C. B., N. S.* 28.)

548. THOMAS v. WELCH. [1866]

A specification, to which drawings were attached, after describing an instrument marked "g," continued, "It is the arranging an instrument 'g,' as herein described, which, while it is the means of holding the fabric . . . is also the means by which the step-by-step movement is given to the fabric, which constitutes the peculiarity of my invention:"—Held, that this was not a claim of all instruments which were at once the means of holding and moving the fabric: nor, on the other hand, of the exact machine, with all its arrangements, contained in the drawings; but a claim to the exclusive right to use "g," or any similar instrument, for the purpose of holding and moving the fabric at the same time. (*L. R.*, 1 *C. P.* 192.)

549. JORDAN v. MOORE. [1866]

A. obtained a patent for "certain improvements in the construction of ships and other vessels navigating on water." By his specification the patentee claimed as his invention, amongst others, (1) the construction of ships "with an iron frame, combined with an external covering of timber planking for the sides, bilges and bottoms; (6) the construction of iron frames adapted to an external covering of timber for the sides, bilges and bottoms, as described:"—Held, that the expression "iron frame" in the first claim, was not confined to an iron frame,

such as that specified in the sixth claim, but comprehended whatever might, according to the ordinary use of language, be called "an iron frame," and that, as there had existed ships with iron framings similar to that which the plaintiff claimed, the claim was too large. (*L. Rep.*, 1 *C. P.* 624; 35 *L. J.*, *C. P.* 268.)

550. WRIGHT v. HITCHCOCK. [1870]

A patent was taken out for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The specification described a process of plaiting fabrics by means of a reciprocating knife in combination with a sewing machine. The first claim was for the general construction, arrangement and combination of machinery for producing plaited frills or trimmings *in a sewing machine*; the second was for the application and use of a reciprocating knife for crimping fabrics *in a sewing machine*; and the third, for the peculiar manufacture of crimped or plaited frills or trimmings "as hereinbefore described," and illustrated by a drawing:—Held, first, that the patent was not for the manufactured product, but for the process of manufacturing it; secondly, that the patent was not limited to the manufacture of plaited fabrics by the knife *in combination* with a sewing machine. (*L. Rep.*, 5 *Ex.* 37; 39 *L. J.*, *Ex.* 97.)

Comparison of Specifications.

551. MUNTZ v. FOSTER. N. P. [1844]

Tindal, C. J.: "The identity of the inventions described in two specifications is a question for the jury." (2 *Web. P. C.* 105.)

552. ALLEN v. RAWSON. [1845]

Coltman, J., delivering the judgment of the Court, said: "It was objected that it should have been left to the jury to say whether the present patent and *Robertson's* patent were the same as to the method of diagonal or cross felting. On looking at the judge's notes, it appears that there was no evidence given

to show that the two were the same: and, standing as the question did nakedly on the two specifications, the constructions of them, according to the authority of *Neilson v. Harford*, was for the judge, and not for the jury." (1 *C. B.* 571.)

553. TETLEY v. EASTON. N. P. [1852]

Pollock, C. B.: "The question as to the identity of two inventions described in the specifications is for the Court." (*Macr. P. C.* 68.)

554. BUSH v. FOX. H. L. [1856]

In an action for an alleged infringement of a patent, where the defence is, that the supposed invention is not new, the judge may compare the plaintiff's specification with the specification of a previous patent, and may on such comparison direct the jury to find a verdict. (5 *H. L. Cas.* 707; *Macr. P. C.* 178; 2 *Jur.*, *N. S.* 1029; 25 *L. J.*, *Ex.* 251.)

555. BOOTH v. KENNARD. [1857]

Held, upon the authority of *Bush v. Fox*, that as the want of novelty in the plaintiff's invention appeared clearly from the two specifications in evidence, it was for the Court, and not for the jury, to determine the identity of the two supposed inventions. (2 *H. & N.* 84; 26 *L. J.*, *Exch.* 305.)

556. THOMAS v. FOXWELL. [1858]

Lord Campbell, C. J., in delivering the judgment of the Court of Queen's Bench, said: "We by no means lay down, as a general rule, that upon a question of novelty of invention such as this, raised by the comparison of two specifications, it must necessarily be a pure question of law for the Court. The specifications may contain expressions of art and commerce, upon which experts must be examined, and there may be conflicting evidence raising a question of fact to be determined by

the jury. But it is quite clear that there may be cases in which the Court would be bound to decide the question of novelty exclusively; for the two specifications might be, *in ipsissimis verbis*, the same; and, if they be in such plain and common language that the judge is sure he understands their meaning, he is bound to construe them as he does other written documents. (5 *Jur.*, *N. S.* 38; affirmed on appeal, 8 *Jur.*, *N. S.* 271.)

On appeal to the Exchequer Chamber judgment was affirmed, when Pollock, C. B., said: "I agree that we are to construe the specification '*ut res magis valeat quam pereat*;' but still we are to ascertain what is the true and sound construction of the instrument, construing the language used with reference to the subject-matter." (6 *Jur.*, *N. S.* 272.)

557. HILLS v. LONDON GAS LIGHT COMPANY. [1860]

The plaintiff obtained in 1849 a patent for the purification of coal gas by means of *hydrated* oxides of iron. In 1847, F. having obtained a patent for the purification of gas by chloride of calcium, specified a mode of making the chloride of calcium by decomposing muriate of manganese, iron or zinc, and said, "the oxides or carbonates which result are useful for the said purification of gas, and need not be removed." The oxides so prepared would be hydrates:—Held, that the Court, on a comparison of F.'s specification with that of the plaintiff, could not say, as a matter of law, that F. had anticipated the plaintiff's invention. (5 *H. & N.* 312; 29 *L. J.*, *Ex.* 409.) Bramwell, B., in delivering the judgment of the Court, said: "We hold that there are certain cases in which, upon the mere collocation of the two specifications, or the specification of a patent and a previous written document, the Court may say that the patentee has been anticipated. Undoubtedly that is so; the process may be described in identically the same words, or, if there be a variety in the words, there may be no variety in the process. Probably it will be found that in the case of what are called mechanical patents, the Court can do so more readily than in the case of chemical patents, or in other cases where the invention depends on what may be called the

occult qualities of matter,—those in fact which are not the subject of popular knowledge.” (5 *H. & N.* 363.)

558. BETTS v. MENZIES. H. L. [1862]

As specifications describe external objects, though the language in two specifications be identically the same, it would be impossible to predicate of the two that they described exactly the same identical external object, unless the terms of art used in both the specifications could be ascertained to have been the same at the date of both the patents. The question of identity of signification belongs to the province of evidence, and not to the province of construction. (10 *H. L. Cas.* 117; 31 *L. J., Q. B.* 233; 11 *W. R.* 1; 7 *L. T. Rep., N. S.* 110.)

Wilde, B., in the course of his answers to the questions put to the judges by the House of Lords, said: “If the terms of the two specifications are identical, and if it is not disputed that the terms of art used in the one have the same meaning as the same terms used in the other, which, from the lapse of time between the dates of the two patents may not always be the case, the Court ought to determine that the first publication anticipated the second, without evidence, and without any proof that either the first or second was practicable. If, though not identical, the language used in the two, when construed by the Court, describes identically the same process, machine, or manufacture, the Court may, subject to the same remark as to the terms of art, decide at once upon the question of anticipation. But if after construction, and after the meaning of the parties in the two documents has been ascertained by the Court, there be any difference between the two things described, which may be essential or material to the invention, and which is contended by either of the parties to be essential or material to the invention, the Court cannot decide such a controversy; it has neither materials nor means for so doing, and it must go to a jury. In a word, the Court can pronounce two identical descriptions to portray two identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence.” (10 *H. L. Cas.* 134.)

559. HILLS v. EVANS. Ch. [1862]

In the comparison of two specifications, each of which is filled with terms of art, and with the description of technical processes, the duty of the Court is confined to giving the legal construction of such documents taken independently, but the comparison of the two instruments, and ascertaining whether the words, as interpreted by the Court, and contained in one specification, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in the other specification, is a matter of fact, and within the province of a jury. (31 *L. J.*, Ch. 457; 8 *Jur.*, N. S. 525; 6 *L. T. Rep.*, N. S. 90.)

*Sufficiency of, a Question for the Jury.***560. HILL v. THOMPSON.** Ch. [1817]

The intelligibility of the description in the specification is a matter of fact for the jury, but whether or not, the patent is defective in attempting to cover too much, is a question of law. (3 *Mer.* 626; 1 *Web. P. C.* 235; 1 *Carp. P. C.* 377.)

561. BECKFORD v. SKEWS. [1841]

The sufficiency of the specification is a question for the jury. (1 *Q. B.* 938; 1 *G. & D.* 736; 6 *Jur.* 167; 1 *Web. P. C.* 214.)

562. NEILSON v. HARFORD. [1841]

The intelligibility of the specification is a question for the jury. (1 *Web. P. C.* 295.)

563. WALTON v. BATEMAN. N. P. [1842]

Cresswell, J., held, that it was a question for the jury whether the patentee has given such a description of his invention and of the manner of carrying it out as will enable a workman of competent skill in that line of business to act upon it. (1 *Web. P. C.* 621.)

564. BEARD v. EGERTON. [1848]

Cresswell, J.: "The judge is to state what the specification orders to be done, the jury are to say whether it would produce the result." (19 *L. J., C. P.* 38.)

565. WALLINGTON v. DALE. [1852]

The sufficiency of the description of an invention, contained in a specification, is a question for the jury. (7 *Ex.* 888.)

566. MORTON v. MIDDLETON. [1863]

The Court should decide what construction or meaning is to be put upon the specification, but the jury should decide matter of fact. The sufficiency of the specification, as serving the double purpose,—first, of showing a workman of ordinary knowledge and skill how he can construct the thing specified in the patent; and, secondly, of showing persons who read the patent what they must avoid doing if they would not infringe the patent, is a matter for the jury. (1 *Cr. S., 3rd Series*, 721.)

566*. PARKES v. STEVENS. [1869]

The sufficiency of a specification is not a question of law, but a question of fact in each particular case. (*L. R.*, 8 *Eq.* 358; 38 *L. J., Ch.* 627; affirmed, *L. R.*, 5 *Ch.* 36; 22 *L. T. Rep.*, *N. S.* 635.)

AMENDMENT OF PATENT, SPECIFICATION AND ENROLMENT.

At Common Law.

567. *Ex parte* BECK. [1784]

A caveat having been entered against the sealing of a patent which bore date August 12th, 1784, the Lord Chancellor, upon hearing the petition, took some time to consider it; and did not make his order for discharging the caveat until the 27th August. The patentee, supposing the patent bore date the latter day, did not enrol his specification till the 18th December, when the four months allowed for enrolment had expired. The patentee now petitioned the Lord Chancellor to alter the patent, by making it bear date the 27th of August, instead of the 12th.

The Lord Chancellor said, that although he was perfectly satisfied that the patentee was well entitled to his patent, and that his case was a very hard one; yet he could not make such a use of his power, as Keeper of the Great Seal, as to alter a patent, in any degree, upon an application of this sort. That, perhaps, upon the petitioner's applying for a new patent, the officers might, under these circumstances, be induced to remit their fees; but that he could give no relief upon the present petition. (1 *Br. C. C.* 578.)

568. *In re* REDMUND'S PATENT. [1828]

The patentee stated by a petition, that, within the last month, he had discovered that the copying clerk, in engrossing the specification and the plan annexed to it, had by mistake trans-

posed the numbers by which, in the specification, reference was made to the plan. His petition was, that this clerical error in the enrolment of the specification, might be amended.

The Master of the Rolls made the order. (5 *Russ.* 44; 1 *Web. P. C.* 649 (n).)

569. *In re* WHITEHOUSE'S PATENT. [1830]

In the original specification the word "wire" was by mistake substituted for the word "fire," and was so enrolled. Five years afterwards, Lord Gifford, M. R., ordered the mistake to be corrected, and the enrolment of it altered accordingly. (1 *Web. P. C.* 649, note (m).)

570. *In re* RUBERY'S PATENT. [1837]

The specification recited the letters patent to have been granted in "October" instead of "November." Lord Langdale, M. R., ordered the amendment as prayed. The petition stated that *scire facias*, or other proceedings at law on the patent, had been instituted. (1 *Web. P. C.* 649 (n).)

571. *In re* SHARP'S PATENT. [1840]

Except for the purpose of correcting mere verbal or clerical errors, proved to have arisen from mistake or inadvertence, the Master of the Rolls has no authority to make any alteration in the enrolment of the patent or of the specification.

If an enrolled memorandum of alteration, by mistake of the writer, contained verbal or clerical errors, by means of which something was enrolled contrary to the true intent of the party, the Master of the Rolls has authority to correct the error and make the enrolment accord with the proved intention of the party at the time of enrolment. (1 *Web. P. C.* 645.) For instances in which verbal amendments have been made by the Master of the Rolls, see 1 *Web. P. C.* 647, note (l).

572. *In re* NICKEL'S PATENT. [1841]

In this case "recovering" had been written for "covering." The Chancellor and Master of the Rolls made a joint order for the re-sealing of the letters patent with an alteration of this mistake, on the undertaking of the patentee to abandon and pay the costs of an action then pending, and not to bring any action for infringement before the re-sealing. (*Turner & Phillips*, 36; 1 *Web. P. C.* 650.)

The petitioner not acceding to these terms, relief was refused; and the petitioner was ordered to pay the costs of the party opposing the petition. (*Hindmarch*, p. 218.)

The Master of the Rolls has no authority to amend letters patent; the Lord Chancellor alone can do so. (1 *Web. P. C.* 660.)

Cottenham, L. C., said: "I may observe that I had some doubt before as to the *mode* in which an alteration was to be made when the letters patent had been actually enrolled. I have since, however, been furnished with the only instance of the kind which I am told exists, and it was effected in this way. An application had been made to Lord Alvanley, when he was Master of the Rolls, to alter the enrolment. He thought he could not do it, because it would make the enrolment vary from the letters patent; and afterwards, on communication with the Lord Chancellor, who thought the case was one in which an alteration ought to be made in the patent, the Master of the Rolls came into this court, and, under the authority of the Lord Chancellor, the patent having been altered, was re-sealed, and then the Master of the Rolls made the enrolment correspond with the patent so altered." (1 *Web. P. C.* 663.)

573. *In re* DISMORE'S PATENT. [1853]

After the specification had been enrolled, it was discovered that the stationer, in engrossing from the draft specification, had, in the recital of the patent and throughout the specification, by mistake, inserted the name of "Charles" instead of "George." On a petition that this might be amended, Lord

Romilly, M. R., took time to consider, and after some hesitation, made an order on the authority of and similar to that in Rubery's case. He required, however, that the signature of the Attorney-General should be obtained, and that the letters patent themselves should be handed in for inspection. (18 *Beav.* 538.)

574. *In re* ADAMS' PATENT. [1853]

The engrossment of letters patent bore date two days after the date of the writ of the privy seal, and the patentee, not being aware of the discrepancy, was a day too late in enrolling his patent: ordered that, as the mistake arose from a misprision of the clerk, the enrolment should be amended. (21 *L. T. Rep.* 38.)

575. *In re* BLAMOND'S PATENT. [1860]

An application for amendment of a patent granted in 1856, by rectifying an error in the spelling of the name of the patentee, was refused on the ground of lapse of time. *Quære*, whether the court has power to make such an order under 15 & 16 Vict. c. 83, s. 15. (3 *L. T. Rep.*, N. S. 800.)

By Disclaimer and Memorandum of Alteration.

By whom entered,

576. SPILSBURY v. CLOUGH. [1842]

A grantee of letters patent, though having entirely parted with his interest, may enter a disclaimer. (2 *Gale & Dav.* 17; 6 *Jur.* 579; 2 *Q. B.* 466; 1 *Web. P. C.* 255.)

577. WALLINGTON v. DALE. [1852]

A grantee had assigned his letters patent before the expiration of the six months within which the specification was to be

filed, and after this assignment disclaimed part of the title of the letters patent:—Held, that the disclaimer was valid as soon as it was entered of record. (7 *Exch.* 888; 23 *L. J.*, *Ex.* 49.)

Grounds for and Objections to,

578. *In re* DEROSNE'S PATENT. [1835]

A disclaimer may be made after judgment of a court of law adverse to the validity of the patent. (1 *Carp. P. C.* 698.)

579. *MORGAN v. SEAWARD.* [1838]

A patentee may disclaim a part of his invention after verdict adverse to the validity of a patent, and thus preserve the new and useful parts of the patent. (2 *Carp. P. C.* 104.)

580. *In re* SHARP'S PATENT. [1840]

If the memorandum goes beyond the act (5 & 6 Will. 4, c. 83) it is void, and cannot be given in evidence or made any use of. (1 *Web. P. C.* 643.)

581. *R. v. WHEELER. Sci. fac.* [1850]

Maule, J.: "The spirit of the act (5 & 6 Will. 4, c. 83) seems to be this,—that, where there are objections that go only to a small and insignificant part of a patent, which, if sustained, would defeat it altogether, the patentee may relieve himself from the difficulty by a disclaimer." (10 *C. B.* 395; 20 *L. J.*, *C. P.* 16.)

582. *REG. v. MILL.* [1851]

Romilly, M. R.: "The power to disclaim given by Lord Brougham's Act (5 & 6 Will. 4, c. 83) is very valuable, and of great importance to patentees; but it is a power which, if indiscriminately exercised, would work considerable injustice to the public. In many cases a person may make an invention,

some part of which may be comprised in another patent, which he may be advised is wholly invalid, and yet, by the effect of a subsequent disclaimer, it may become perfectly good, and a liability created which did not previously exist. It is very desirable to afford protection to patentees in consequence of the difficulties arising from the nature of the subject and the state of the law. It is proper they should be allowed to correct errors in their patents by removing from the specification *parts which are not material or substantial*, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." (14 *Beav.* 315.)

583. *In re* BATEMAN & MOORE'S PATENT. [1854]

Where there was some evidence, upon the face of the specification, that the patentees intended their invention to comprise an entire apparatus, but at the end of the specification they claimed the several parts of the apparatus, Bethell, S.G., allowed a disclaimer, the effect of which was to convert the claim into one for the combination.

Upon an application for a disclaimer, the matter must be decided on the words of the specification itself, irrespective of extraneous considerations.

In cases of doubt a disclaimer should be allowed, as the refusal of the law officer to grant the application is final and irrevocable, and may be of serious consequence to the patentee; whereas, if he wrongly grant his fiat so as to extend the claim of the invention, the public will not be injured as the disclaimer will be void. (*Macr. P. C.* 116.)

584. *In re* LUCAS' PATENT. [1854]

No disclaimer can be allowed without a statement of a reason for entering it. (*Macr. P. C.* 235.)

585. *LISTER v. LEATHER.* [1858]

Those matters which manifestly form no part of an invention need not be disclaimed. (8 *El. & B.* 1034.)

586. FOXWELL v. BOSTOCK. Ch. [1864]

Where, by the operation of a disclaimer, a combination of machinery, described in an amended specification, is different from the combination of machinery described in the original specification, and for which the patent was granted; *Quære*, whether the patent is void, or the disclaimer void. Where the amount by which the disclaimer exceeds the statutory requirements as to its nature can be easily distinguished, the disclaimer is inoperative for such excess.

Semble: where the combination of machinery in an amended specification was different from the combination in the original specification, and no specification remained of the invention for which the patent was granted; and where, the combination being claimed as the invention, it was only so far ascertained by the specification, that the latter referred to certain drawings and their description, which did but describe an entire machine and the composition and working of its several constituent parts, without in any manner indicating where the improvement lay or in what it consisted:—Held, that the patent was void at law. (4 *De G., J. & S.* 298; 10 *L. T., N. S.* 144; 12 *W. R.* 723.)

Lord Westbury: “By the statute 5 & 6 Will. 4, c. 83, which introduced disclaimers, it is in effect provided that the disclaimer to be entered must not be such as will ‘extend the exclusive right granted by the said letters patent;’ words which are vague and indefinite. Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged.” (4 *De G., J. & S.* 306).

587. RALSTON v. SMITH. H. L. [1865]

The object of the 5 & 6 Will. 4, c. 83, was only to permit a disclaimer to amend the specification of a patent, by removing from it something superfluous, but not to allow the introduction

of that which would convert a description, in itself unintelligible or impracticable, into a practicable description of a useful invention.

R. took out a patent for "improvements in embossing and finishing woven fabrics, and in the machinery and apparatus employed therein." In his specification he said: "I employ a roller of metal, wood, or other suitable material, and groove, flute, engrave, mill, or otherwise indent upon it any desired design;" he caused this roller to revolve with a bowl at unequal velocities, moving the fabric transversely when fed into the machine, and by these means he proposed to calender or finish, and to emboss the fabric by one process instead of two, as then practised. He afterwards entered a "disclaimer," in which he disclaimed the words in the title, "and in the machinery or apparatus employed therein," disclaimed the word "wood" from the description of the roller, and restricted the grooves or flutes on the roller to those of a circular kind. Any other grooves would not only not produce the desired effect on the fabric but would destroy it:—Held, that the disclaimer extended the exclusive right, and was consequently bad.

Lord Chelmsford, said: "The word 'extend,' in the 5 & 6 Will. 4, c. 83, cannot be used only in its ordinary sense of 'adding to' or 'enlarging,' because the exact meaning of the term 'disclaimer' to which it is applied, is the renunciation of some previous claim actually or apparently made, or supposed to be made. It must therefore be intended to comprehend a case where the disclaimer would give the patentee a right which he could not have enjoyed under the specification as originally formed. Here the specification was conceived in general terms, embracing an infinite variety of modes of indenting upon all descriptions of rollers any desired design. The plaintiff afterwards discovered that no other rollers but those which had circular grooves, flutings or indentations around their surfaces would answer; and he therefore, by his disclaimer, limited his invention to this description of rollers only. Now as these were not specifically described in the original specification, but were merely involved in the general terms which were used,

the plaintiff had not complied with the condition of the letters patent in particularly describing and ascertaining the nature of his invention. When, therefore, by his disclaimer, he confines his claim to circular grooved rollers as his sole invention, though in one sense he may be said to narrow a right, yet he really extends it, because he thereby describes his alleged invention sufficiently to enable him now to assert a right under the patent which he never could have successfully maintained upon the original specification alone." (11 *H. L. Cas.* 223; 35 *L. J., C. P.* 49; 13 *L. T. Rep., N. S.* 1; 20 *C. B., N. S.* 28.)

588. THOMAS v. WELCH. [1866]

All the claiming clauses may be struck out of the specification of a patent by a disclaimer, if there remain in the body of the specification words sufficiently distinguishing what the invention is which the patentee claims.

An alteration, verbal merely and not substantive, by means of a disclaimer will not make a patent void. (*L. R.*, 1 *C. P.* 192; 12 *Jur., N. S.* 316; 35 *L. J., C. P.* 200.)

Operation of,

589. PERRY v. SKINNER. [1837]

Where a patent is originally voidable, but has been amended under 5 & 6 Will. 4, c. 83, by filing a disclaimer of part of the invention, that act has not a retrospective operation so as to make a party liable for an infringement of the patent, prior to the time of entering such disclaimer. Parke, B., in the course of his judgment, said: "We must engraft a modification upon the words of the act (sect. 1) in this case for the purposes of its construction, and read it as though it had been 'shall be deemed and taken as part of the said letters patent, &c., *from thenceforth*,' so as not to make the defendant a wrongdoer."

The only doubt arising in this case is from the words of the proviso; but we cannot think the legislature meant to do so unjust a thing as to restrict a party from doing that which he has a lawful right to do; and therefore, though there is some obscurity in the words of the act, we are bound to put a reasonable construction upon them, and undoubtedly the effect of it is to make the patent good for the future." (2 *M. & W.* 471; *M. & H.* 122; 1 *Jur.* 433; 1 *Web. P. C.* 250. See *sect. 39 of 15 & 16 Vict. c. 83.*)

590. CLARK v. KENRICK. [1843]

The effect of the statute 5 & 6 Will. 4, c. 83, is to render the disclaimer, when made, part of the patent and the specification. The patentee, from the moment of the disclaimer, becomes patentee of the undisclaimed part only. (12 *M. & W.* 221.)

591. STOCKER v. WALLER. [1845]

Tindal, C. J.: "The mere fact of a disclaimer being made by a party to whom a grant has been made does not necessarily import that the original patent was void; for the object of the statute was not only to enable inventors to set themselves right when the letters patent, from some cause or other, would have been held to be void, but also to remove doubts and difficulties which would otherwise hang over the heads of parties bringing actions for an infringement, by enabling them to enter a disclaimer of a part of the specification or title of the patent." Cresswell, J.: "In my opinion, the true meaning to be given to the first section of 5 & 6 Will. 4, c. 83, is, in the mode suggested by the Court of Exchequer in the case which has been referred to (*Perry v. Skinner*), by introducing the words 'from thenceforth' into the proviso. The effect of that construction is, to hold, that, from the time of the entry of the disclaimer, it shall be taken to be incorporated with the letters patent and specification, so as to affect all acts done after that period, but that it shall not have the effect of making parties

wrongdoers by relation." (9 *Jur.* 138. Reported under name of *Stocker v. Warner*, 1 *C. B.* 148.)

592. R. v. MILL. *Sci. fac.* [1850]

In an action of *scire facias*, a disclaimer, though enrolled subsequently to issue joined, is admissible as evidence for the defendant, and is to be read as part of the original specification put in by the prosecutor. *Seemle*, in actions or suits, not being proceedings by *scire facias*, and which were not pending at the time of the enrolment of a disclaimer, the disclaimer is to be deemed and taken to be a part of the patent or specification from the time of the granting of the letters patent, and not from the time of its enrolment merely. The decision in *Perry v. Skinner* questioned. (10 *C. B.* 379; 20 *L. J.*, *C. P.* 16; 15 *Jur.* 59; 1 *L. M. & P.* 695.)

593. *In re* LUCAS' PATENT. [1854]

There are exceptional cases where a disclaimer should be made retrospective, so as to give the patentee power to proceed against those who infringed before the disclaimer was filed; as, where a person, having obtained his information from the patentee, presumes upon a defect in his specification, and infringes the valuable part of his patent. (*Macr. P. C.* 235.)

594. *In re* SMITH'S PATENT. [1855]

The law officer may, should he think fit, order that an action may be brought in respect of infringements prior to the filing of a disclaimer.

Disclaimer allowed, on condition that an undertaking be given that no action shall be brought in respect of anything done prior to the hearing of the application for a disclaimer. (*Macr. P. C.* 232.)

595. TETLEY v. EASTON. [1857]

The effect of a disclaimer is merely to strike out from the specification those parts of the machine which are disclaimed; it

cannot be read as explanatory of that which remains. (2 *C. B.*, *N. S.* 706.)

596. LISTER v. LEATHER. [1857]

In a suit, pending at the time of enrolment of a disclaimer, a plaintiff cannot avail himself of it by amending his bill, he must file a fresh bill. (3 *Jur.*, *N. S.* 433.)

597. SEED v. HIGGINS. *H. L.* [1860]

A patentee claimed by his specification "the application of the principle of centrifugal force to the flyers employed in certain machinery for roving cotton and other fibrous substances," but declared that his improvements "applied solely to such part of the machinery, called the flyers, which is employed in connection with the spindle for the purpose of winding cotton." He attached drawings to his specification, and went on to say that these drawings and the specification represented "one particular and practicable mode of applying" his invention, but "I do not intend to confine myself to this particular method, but I claim as my invention the application of the law or principle of centrifugal force to the particular or special purpose above set forth, that is, to flyers used in machinery for preparing cotton." He afterwards disclaimed "all application of the law or principle of centrifugal force as being part of my invention, or as being comprised in my claim of invention contained in the specification, except only the application of centrifugal force, by means of a weight acting upon a presser so as to cause it to press against a bobbin, as described in the specification":—Held, that this disclaimer did not extend the claim, but confined it to a particular mode of applying the principle of centrifugal force, and did not claim the discovery of that principle, or the application of it, except in a particular way, and that, therefore, the patent was good. (4 *Jur.*, *N. S.* 258; 27 *L. J.*, *Q. B.* 145; affirmed in *Exch. Ch.* and *Dom. Proc.*, 27 *L. J.*, *Q. B.* 411; 8 *H. L. Cas.* 550; 30 *L. J.*, *Q. B.* 314; 6 *Jur.*, *N. S.* 1264.)

598. *In re MEDLOCK'S PATENT.* [1865]

A patent for "improvements in the preparation of red and purple dyes" thus described the process: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or near to, its boiling-point, until it assumes a rich purple colour." It was proved (and not denied by the patentee) that it was *necessary* to apply heat in order to produce the colour, and upon this ground the patent was held void. An application was now made to disclaim the first of these two methods of preparing the dyes, and the application was opposed by manufacturers who had been defendants in previous actions for infringement of the patent. Collier, S. G., granted leave to enter the disclaimer, upon the terms that the applicants should bring no action against the opposers "for any infringement of the said patent by the use or continued use, during the continuance of the said patent, of any process or processes for manufacturing or preparing red and purple dyes which is or are in use by them or either of them at the present time." The applicants declined to enter a disclaimer on these terms. (*Newton's London Jour., New Series, vol. 22, p. 69.*)

599. *CANNINGTON v. NUTTALL.* H. L. [1871]

The plain language of the operative part of a disclaimer is not to be controlled or modified by any introductory sentences with which the patentee may think fit to preface such disclaimer. (*L. R., 5 H. L. 205.*)

Lord Westbury: "The reason for a disclaimer is no part of the disclaimer itself. The *operative part* of the disclaimer begins in this way: 'I, for this reason, wish to disclaim, and do hereby disclaim.'" (*Ib. 227.*)

Practice.

600. *In re* SHARP'S PATENT. [1840]

The Master of the Rolls has no jurisdiction to remove from the records of the Court of Chancery a memorandum of alteration enrolled under the statute. (1 *Web. P. C.* 641 ; 3 *Beav.* 245 ; 2 *Carp. P. C.* 461.)

601. *R. v. MILL. Sci. fac.* [1851]

Pending a proceeding in *scire facias* to repeal a patent, the patentee disclaimed a part. The prosecutor still proceeded, and ultimately failed:—Held, that he ought to pay the costs subsequent to the disclaimer. (14 *Beav.* 312.)

602. WALLINGTON *v.* DALE. [1852]

The filing of the copy of a disclaimer is a compliance with the provisions of 5 & 6 Will. 4, c. 83, s. 1. (7 *Exch.* 888 ; 23 *L. J., Exch.* 49.)

603. *In re* HARRISON'S PATENT. [1853]

Sir R. Bethell, S. G., refused to allow a disclaimer to be entered by the assignee of a patentee who had been unsuccessful in an action for infringement against certain defendants, except upon the terms that an undertaking be given not to bring any further action against the same defendants for any alleged infringement prior to the date of the disclaimer. (*Macr. P. C.* 32.)

604. *In re* MEDLOCK'S PATENT. [1865]

A fiat had been granted by the Solicitor-General in this case to enter a disclaimer, subject to the acceptance by the applicant of certain conditions. The applicant refused to accede to these conditions, and the Solicitor-General filed a disallowance of the disclaimer. An appeal was then made to the Patent Commissioners, in the form of a petition, setting out the facts of the case, and ending with the following prayer:—

“1. That the Solicitor-General, having granted his fiat for the disclaimer, your petitioners submit that such fiat

cannot be recalled, and they pray that you will be pleased to file the said disclaimer with the fiat, so that your petitioners, not having consented to the conditions, may be enabled to try the question of their validity.

- “ 2. Or, that the said disclaimer may be referred to one of the law officers mentioned in the statute, with such instruction as to you the Commissioners of Patents may seem fit.
- “ 3. Or, that the Commissioners of Patents require a fuller statement of the case, that your petitioners may be heard by council before the Commissioners of Patents.
- “ 4. That the Commissioners of Patents will give to your petitioners such further or other relief as they may see fit.”

This petition was returned by the Lord Chancellor, indorsed “ refused.” (*Newton's London Jour., N. S., vol. 22, p. 70.*)

EXTENSION OF THE TERM OF LETTERS PATENT.

Jurisdiction of the Judicial Committee of the Privy Council.

605. *In re* SCHLUMBERGER'S PATENT. [1853]

The Judicial Committee have, under the 4th sect. of 3 & 4 Will. 4, c. 41, jurisdiction to entertain a petition, referred to them by the Crown, seeking to revoke an order in council, made upon their recommendation, upon an application by patentees for an extension of letters patent under the statute 5 & 6 Will. 4, c. 83, and to recall the warrant for sealing such letters patent. (9 *Moo. P. C. C.* 1.)

606. *In re* HONIBALL'S PATENT. [1855]

The authority conferred upon the Crown, by 5 & 6 Will. 4, c. 83, s. 2, to confirm letters patent, is discretionary in the Judicial Committee, to recommend or not a confirmation. (9 *Moo. P. C. C.* 378.)

607. *In re* BETTS' PATENT. [1862]

When a foreign and an English patent has been obtained for the same invention, and the foreign patent expires first, the Judicial Committee of the Privy Council have no jurisdiction to entertain an application of prolongation. See sect. 25 of 15 & 16 Vict. c. 83. (1 *Moo. P. C. C.*, *N. S.* 49; 9 *Jur.*, *N. S.* 137; 11 *W. R.* 221; 7 *L. T. Rep.*, *N. S.* 577.) See also 722.

608. *In re* GOUCHER'S PATENT. [1865]

The power given to the Judicial Committee by statute 7 & 8 Vict. c. 69, s. 2 (enlarging statute 5 & 6 Will. 4, c. 83, s. 4),

to recommend an extension of the term of letters patent for an invention, is exhausted, when an extension has been once recommended and new letters patent granted; and the Judicial Committee have no jurisdiction to entertain a petition for a further prolongation of the new letters patent. (2 *Moo. P. C. C.*, *N. S.* 532.)

Grounds of Extension generally.

609. *In re* ERARD'S PATENT. [1835]

Lord Lyndhurst: "In cases of this kind (extension) we expect a very strong case of hardship to be made out, as well as a strong case upon the utility of the invention. (1 *Web. P. C.* 559; 5 *Rep. Art.*, *N. S.* 58.)

610. *In re* SWAINE'S PATENT. [1837]

The invention being very meritorious, the result of a great deal of labour, care and science, and extremely useful in its effects, and the party having sustained considerable loss, the patent was extended. (1 *Web. P. C.* 559.)

611. *In re* SOUTHWORTH'S PATENT. [1837]

The misfortunes of the patentee and those connected with him in the management of the patent, together with the nature of the invention being such that it would not be likely to come into immediate use, are grounds for an extension of the term of the patent. (1 *Web. P. C.* 486.)

612. *In re* WHITEHOUSE'S PATENT. [1838]

The term of letters patent for improvements in manufacturing gas tubes, extended by the Judicial Committee, under the 5 & 6 Will. 4, c. 83, for six years, on the ground of the great merit and utility of the invention, the merit of the petitioner in patronizing an ingenious inventor, and liberally expending money to introduce the invention (the amount of profit not

being greater than the ordinary profit on capital employed on similar trades), and the annoyance, anxiety, and cost of litigation. (2 *Moo. P. C. C.* 496; 1 *Web. P. C.* 473.)

613. *In re* STAFFORD'S PATENT. [1838]

Extension of term recommended, the patentee having experienced great opposition from the existing interests, and being a loser by the invention. (1 *Web. P. C.* 563.)

614. *In re* KOLLMAN'S PATENT. [1839]

The invention being meritorious, but from circumstances beyond the control of the patentee, not sufficiently appreciated, and unproductive of reward, an extension recommended. (1 *Web. P. C.* 564.)

615. *In re* ROBERTS'S PATENT. [1839]

The violent resistance and opposition to the introduction of a meritorious invention, which has prevented the patentee from realizing a profit, is a ground for the extension of the term of the letters patent. (1 *Web. P. C.* 573.)

616. *In re* DOWNTON'S PATENT. [1839]

A Lord: "The questions are, is it a useful invention; is it beneficial to the public; is it an invention of that character which would lead us to interpose; is there ingenuity in the invention, and has the party been remunerated?" (1 *Web. P. C.* 567.)

617. *In re* JONES' PATENT. [1840]

Lord Brougham: "It is perfectly true, as has been stated, not only upon this but upon former occasions, that these applications are anything rather than matters of course. This is a very extraordinary jurisdiction which has been conferred on the Judicial Committee by the legislature, and it is to be exercised

only on the most special grounds alleged and proved in reference to each case." (1 *Web. P. C.* 579.)

618. *In re* MORGAN'S PATENT. [1843]

Lord Brougham, in delivering judgment, said: "It is by no means the course of their lordships, as has been frequently said, and by myself lately, in giving the judgment of the court in a recent case; it is by no means their course to put themselves precisely in the situation of the legislature, and never to grant an extension in a case where an act of parliament would not have been obtained. At the same time there are some limits to this. They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of parliament." (1 *Web. P. C.* 739.)

619. *In re* SOAMES' PATENT. [1843]

Lord Brougham, in delivering judgment, said: "If this case were to be disposed of upon the ground which in arguing such cases has sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent, but that, moreover, the case is to be tried here as on a bill in parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no bill would ever have passed through the two houses of parliament; but their lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect, that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which, nevertheless, might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference, which, nevertheless, had they been presented in the form of a petition to parliament, would have failed to procure

an act." The patent was extended for three years. (1 *Web. P. C.* 733.)

620. *In re* DEROSNE'S PATENT. [1844]

Lord Brougham, in delivering judgment, said: " Their lordships, in dealing with cases of this sort, have always laid down this rule and always acted upon it, that it is anything rather than a matter of course to grant an extension, under the powers of the act, of these patent rights; and they have uniformly stated this in the extensions they have granted, that the parties must show, in the first place, some invention; in the next place, a benefit to the public; and in the third place, that they have not had an adequate remuneration." (2 *Web. P. C.* 4; 4 *Moo. P. C. C.* 418.)

621. *In re* PERKINS' CASE. [1845]

Lord Brougham, in delivering judgment, said: " It must always be considered, as I have had frequent occasion to state before, but in consequence of what has been said by the learned counsel, it must be again stated, that it is by no means a matter of course that an application of this sort, *even when it is not opposed*, should be granted. We are here by the authority of the legislature, given to us to advise the Queen, to protect her from rashly and inexpediently for the public granting an extension, which formerly used to require a solemn and deliberate act of all the three branches of the legislature, involving a double inquiry, together with an opinion of the government itself. Now, it becomes our duty to examine minutely, and very often to examine minutely, where there is no party to oppose except the Crown counsel, before we report or advise for any certain period of extension, or for any extension at all." (2 *Web. P. C.* 18.)

622. *In re* PINKUS' PATENT. [1848]

Lord Langdale, M. R.: " What is usually taken into consideration as forming the ground of the species of indulgence

here asked for is, first, the merit of the invention ; secondly, the utility of the machinery which has been invented ; and, lastly, the question has been raised, whether the patentee, who has enjoyed the benefit of the patent, has received a sufficient remuneration for the merit which he has displayed." (12 *Jur.* 234.)

623. *In re* PETTIT SMITH'S PATENT. [1850]

Extension of letters patent granted for five years ; the invention being of great merit and public utility, but the patentee and his grantees had received no remuneration, in consequence of the originality of the patent being disputed at law. (7 *Moo. P. C. C.* 133.)

624. *In re* HEATH'S PATENT. [1853]

Term of letters patent extended for seven years, on the ground of the meritorious nature of the invention, and the extensive litigation the patentee had been put to in protecting his patent rights, which had prevented any remuneration. (8 *Moo. P. C. C.* 217; 2 *Web. R.* 247.)

625. *In re* PAYNE'S PATENT. [1854]

Patent for preserved meats extended for five years, on the grounds that the patentee had used every exertion in his power to introduce the invention, and had expended large sums in so doing ; but, by reason of the distrust with which the public viewed preparations of that nature, the inadequacy of the patentee's means, and his want of influence with public boards, he had been prevented from obtaining such a fair trial as would lead to the adoption by the public of his invention. (*Cit. Coryton's Law of Letters Patent*, p. 221.)

626. *In re* HONIBALL'S PATENT. [1855]

The Right Hon. Pemberton Leigh: "It has been again and again stated in this place that the grant of an extended term is anything but a matter of course ; that, in order to obtain it, a very special case must be made ; that the novelty, merit, and utility of the invention must be proved, and it must be shown

that all reasonable means have been used in order to make the invention productive ; but that, in spite of such exertions, the remuneration obtained by the inventor has either entirely failed, or has been quite disproportionate to his merits, and to the benefit conferred upon the public." (9 *Moo. P. C. C.* 393.)

627. *In re* CARDWELL'S PATENT. [1856]

The Judicial Committee of the Privy Council will not, as a matter of course, extend letters patent, even when there is no opposition, and the Crown, through the Attorney-General, does not object. (10 *Moo. P. C. C.* 490.)

628. *In re* MARKWICK'S PATENT. [1860]

The Right Hon. Lord Kingsdown, in delivering judgment, said : "The petitioner is bound to prove three points—first, the merits of the invention ; secondly, that the party interested has done all in his power to bring out the invention, and to turn it to advantage ; and thirdly, that, owing to circumstances beyond his control, he has been unable to obtain an adequate remuneration." (13 *Moo. P. C. C.* 313.)

629. *In re* NAPIER'S PATENT. [1861]

Prolongation of the term of letters patent granted to assignees, where the patentee has ceased to have any connection with the working of the patent, and the assignees were prevented from working it at a profit by reason of the discovery of the gold fields in Southern Australia, which caused a derangement and scarcity in the labour market. (13 *Moo. P. C. C.* 543.)

630. *In re* BOVILL'S PATENT. [1863]

The patentee's invention consisted of improvements upon a former patent, taken out by him in consequence of a communication by a foreigner :—Held, that as the improvements were novel and of public utility, the patentee was, in absence of adequate remuneration, entitled to an extension. (1 *Moo. P. C. C., N. S.* 348.)

631. *In re* NORTON'S PATENT. [1863]

The Master of the Rolls, in delivering judgment, said: "The grounds upon which their lordships grant extensions of patents all have reference to the inventor himself. They are, in the first place, to reward the inventor for the peculiar ability and industry he has exercised in making the discovery; in the second place, to reward him because some great benefit of an unusual description has by him been conferred upon the public through the invention itself; or, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed upon the supposition that the invention is a new and useful invention. But where the inventor intentionally delays for a great length of time attempting to put it into practice, the grounds for prolongation of the patent, which I have already mentioned, cannot be relied on by him unless it be possible for him to show some reasonable excuse for the delay. In some circumstances there might be a considerable ground of excuse arising from want of funds." (1 *Moo. P. C. C.*, *N. S.* 343; 9 *Jur.*, *N. S.* 420; 11 *W. R.* 721.)

632. *In re* M'DOUGAL'S PATENT. [1867]

Extension ought not to be granted unless the invention is of considerable merit and of public utility, and the patentee has not received adequate remuneration. (5 *Moo. P. C. C.*, *N. S.* 1; *L. R.*, 2 *P. C.* 1.)

633. *In re* PITMAN'S PATENT. [1871]

Sir J. W. Colvile, in delivering judgment, said: "The general object of the statutable jurisdiction of this committee, in respect to advising an extension of the term of the letters patent, it is hardly necessary to state, is the reward to the inventor, in cases where there has been extraordinary merit in the invention, but where, from circumstances, he has failed to reap any adequate remuneration for his invention during the currency of the term of the letters patent." (*L. R.*, 4 *P. C.* 87.)

634. *In re* HOUGHTON'S PATENT. [1871]

Prolongation of term of letters patent for seven years, the invention being a meritorious one, and of great value as a raw material for the manufacture of paper; no profits having been made either by the inventor or his assignees. (7 *Moo. P. C. C.* 309.)

*Merit of Inventor.***635. *In re* SOAMES' PATENT.** [1843]

Lord Brougham: "The merit of an importer is less than of an inventor. We are now sitting judicially, and it is an argument against the patent, that it was imported and not invented. I do not say it takes away the merit, but it makes it much smaller." (1 *Web. P. C.* 733.) "It is very fit their lordships should guard against the inference being drawn, from the small amount of any step made in improvement, that they are disposed to undervalue that in importance; if a new process is invented, if new machinery is invented, if a new principle is found out and applied so as to become the subject of a patent right, embodied in a manufacture, then, however small it may be in advance of the state of science or of art previous to the period of that step being made, that is no reason whatever for undervaluing the merits of the person who makes a discovery in science or an invention in art, because the whole history of science, from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that ever has been made—is one continued illustration of the slow progress by which the human mind makes its advance in discovery; it is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was something very nearly the same discovered or invented. Therefore, it is no argument whatever in general, if there is a new principle or a novel invention—a new process, for instance." (*Ib.* 735.)

The publication of a patented invention in a foreign work is

270 EXTENSION OF LETTERS PATENT:

to be considered on an application for an extension of the patent, but not in an inquiry as to the validity of the patent. (*Ib.* 733.)

636. *In re* DEROSNE'S PATENT. [1844]

Extension granted for six years of a patent for an invention, which was "very small in point of discovery," but useful, and of great benefit to the public. (4 *Moo. P. C. C.* 418.)

637. *In re* WOODCROFT'S PATENT. [1846]

Reference to a suggestion, previously published, of the principle upon which an invention is based does not prove want of originality unless it is shown that the invention could be easily made by it. (2 *Web. P. C.* 23.)

Lord Brougham: "I may invent a thing this year, and I may say there are various ways of exercising my invention, to no one of which I give a preference over the others. There are A., B. and C., different ways of exercising it. Ten years after that another man may, by an invention, and by experiments made under it, point out to me and to the public, who have the benefit of my invention, that one of those three ways, B. rather than A. and C., is the best mode of exercising it; but that cannot take away the merit of the inventor who invented A., B. and C., altogether. Nay, I may go further, the circumstance may arise of a new invention giving for the first time a particular use to another. For example, no one denies to Watt the great merit of the steam engine, because steam navigation was applied subsequently to his time to the use of propelling ships. I quite agree that if another man's invention is necessary in order to make the first invention useful, no doubt that takes away the merit of the first invention; but if the first invention contained in its own bosom a new mode, as well as the other two modes which are found out to be useful, it is in vain to say there is no value in the original invention." (*Ib.* 27.)

638. *In re* MUNTZ'S PATENT. [1846]

The simplicity of an invention is an element of its value. (2 *Web. P. C.* 119.)

In re BODMER'S PATENT. [1853] See **699**.

In re HEATH'S PATENT. [1853] See **649**.

639. *In re* LEE'S PATENT. [1856]

Letters patent comprised three separate subjects. Upon an application for an extension of the term of the patent, one only of the three subjects (that relating to railway breaks) appeared to the Judicial Committee to be deserving of a renewed grant. Prolongation granted under statute 15 & 16 Vict. c. 83, s. 40, for such part only of the letters patent as related to railway breaks, and not to the other subject-matters of the patent. (10 *Moo. P. C. C.* 226.)

640. *In re* BETTS' PATENT. [1861]

Utility in the practical working of an invention, and not ingenuity in throwing out the idea of the possibility of doing a thing, is that description of merit which constitutes one of the grounds for extending the term of a patent. (1 *Moo. P. C. C.* 49.)

Lord Chelmsford, in delivering judgment, said: "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the real benefactor to the public, and is entitled to claim that description of merit which constitutes one of the grounds for extending the term of a patent." (*Ib.* 61.)

641. *In re* HILL'S PATENT. [1863]

Sir J. T. Coleridge, in delivering judgment, said: "In determining whether to recommend the prolongation of a patent or not, even when the claim to a first discovery, and the beneficial nature of that discovery, are both conceded, it will be still proper to consider both the degree of merit as inventor and the amount of benefit to the public flowing directly from the invention. A monopoly limited to a certain time is properly the reward which the law assigns to the patentee for the

invention and disclosure to the public of his mode of proceeding. Whether that term shall be extended, in effect whether a second patent shall be granted for the same consideration, and the enjoyment by the public of its vested right be postponed, is to depend on the exercise of a discretion, judicial indeed, yet to be influenced by every such circumstance as would properly weigh on a sensible and considerate person in determining whether an extraordinary privilege, not of strict right, but rather of equitable reward, should be conferred. Now, one may be strictly an inventor within the legal meaning of the term—no one before him may have made and disclosed the discovery in all its terms as described in his specification—but this may have been the successful result of long and patient labour, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident or a fortunate guess; or it may have been very closely led up to by earlier, and in a true sense, more meritorious, but still incomplete experiments. Different degrees of merit must surely be attributed to an inventor under these different circumstances. The moral claim to an extension of time may in this way be indefinitely varied, according as the circumstances approach nearer to the one or the other of the above suppositions. The same principle will apply to the consideration of benefit conferred upon the public. The extent of the benefit conferred must vary in each case with the circumstances. The principal question always is, has the individual patentee, under all the circumstances, received what in equity and good sense may be considered a sufficient remuneration? On his own part, of course, there must have been no want of good faith or prudent exertion; and further, as the loss to the public may be important in the consideration, it may be necessary in some cases not to confine the inquiry to the state of things at the date of the patent, but to regard also the circumstances existing at the time when the application is made.” (1 *Mo. P. C. C., N. S.* 265.)

Utility of Invention.

642. *In re* WRIGHT'S PATENT. [1839]

The fact of the invention not having been brought into use, unless explained, is an objection to the extension of the term. But, being explained by the pecuniary difficulties and embarrassments of the patentee, extension recommended. (1 *Web. P. C.* 575.)

643. *In re* DOWNTON'S PATENT. [1839]

The sale of a patented article in considerable numbers, when its cost is three or four times as great as the common article, is strong evidence of utility. (1 *Web. P. C.* 565.)

644. *In re* JONES' PATENT. [1840]

The presumption arising from the non-user of an invention may be rebutted by showing that the nature of the invention is such that it would not be likely to come into immediate use. (1 *Web. P. C.* 577.)

645. *In re* SIMISTER'S PATENT. [1842]

The extension of the term of letters patent refused, although the profit derived from the patent article was less than the expenditure incurred upon the patent, the utility of the invention being small.

The fact of an invention, when known, not getting into general use, is a presumption against its utility. (4 *Moo. P. C.* 164; 1 *Web. R.* 721.)

646. *In re* SOAMES' PATENT. [1843]

The fact of further improvements upon the patented invention having been made, though not themselves patented, is an argument in favour of an extension of the original patent. (1 *Web. P. C.* 734.)

647. *In re* WOODCROFT'S PATENT. [1846]

No extension will be granted if want of success be owing to inutility, or unless the circumstances have ceased which prevented it being lucrative, and it is really coming into use. (2 *Web. P. C.* 29.) Lord Brougham, in the course of his judgment, said: "We cannot here weigh degrees of merit in golden scales. If there is considerable merit, with originality and some considerable usefulness to the public, that is sufficient." (*Ib.* 31.)

The success of the invention will be inquired into. (*Ib.* 32.)

In re PINKUS' PATENT. [1848] See **687**.

In re CLARIDGE'S PATENT. [1851] See **741**.

648. *In re* BERRINGTON'S PATENT. [1852]

An application on behalf of a patented knapsack was supported by very favourable reports from officers who had examined it. It was deposed that the fact of nine out of ten men in our infantry becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by the patentee, but hitherto without return. The committee, allowing their doubt as to its utility (arising from its not having been adopted by the government) to be slightly founded, in the absence of evidence of its failure, recommended its extension for five years. (*Coryton's Law of Letters Patent*, p. 225.)

649. *In re* HEATH'S PATENT. [1853]

An alteration in the mode of manufacture will not prevent extension being granted, if it does not materially detract from the merit of the original invention. (8 *Moo. P. C. C.* 223.)

650. *In re* BAKEWELL'S PATENT. [1862]

A patent, well known, had never been brought into public use during the period of fourteen years. The patentee accounted for the non-user, on the ground that the invention was of such a nature that it could only be carried out by a company, which

he had failed to form:—Held, not sufficient to rebut the presumption against the practical utility of the patent, and an extension of the term refused. (15 *Moo. P. C. C.* 385.)

Lord Chelmsford, in delivering judgment, said: “Non-user of a patent can hardly be said to be a ground why an extension of the term should be absolutely refused, but it must always amount to a very strong presumption as to the invention not being useful; of course that presumption may be rebutted, as all other presumptions may be, by evidence of the utility of the patent.” (*Ib.* 386.)

In re NORTON’S PATENT. [1863] See 691.

In re HILL’S PATENT. [1863] See 641.

651. *In re* ALLAN’S PATENT. [1867]

Application for a prolongation of the term, in the circumstances of non-user, refused by the Judicial Committee.

Where the utility of a patent has not been tested by actual employment, for a period of fourteen years, although efforts have been made by the patentee to bring it into use, it raises a very strong presumption against its practical utility, which presumption can only be rebutted by the strongest evidence. (4 *Moo. P. C. C., N. S.* 443; *L. R.*, 1 *P. C.* 507.)

652. *In re* M’DOUGAL’S PATENT. [1867]

Petition for the prolongation of a patent for “improvements in treating, deodorizing and disinfecting sewage and other offensive matter, which said improvements are also applicable to deodorizing and disinfecting in general.” The improvement consisted in the use of a substance described in the specification as composed of sulphurous and carbolic acids, in combination with magnesia and lime, such acids being in common use by the public for disinfecting purposes before and after the letters patent:—Held, not to be an invention of such merit and utility as to justify an extension, to the detriment of the public in the use of known sanitary agents. (5 *Moo. P. C. C., N. S.* 1; *L. R.*, 2 *P. C.* 1; 37 *L. J.*, *P. C.* 17.)

653. *In re* HERBERT'S PATENT. [1867]

If an invention has not been brought into practical use during the term of the letters patent, it raises a strong, though not conclusive, presumption against its utility; and unless there are circumstances to rebut such presumption, an extension of the term of letters patent will not be granted.

The fact of a patent of a valuable nature, but having a limited market, not having been so generally used as to remunerate the inventor, is sufficient to remove the presumption against the utility of the invention. (4 *Moo. P. C. C., N. S.* 300; *L. R.*, 1 *P. C.* 399.)

654. *In re* SAXBY'S PATENT. [1870]

Lord Cairns, in delivering judgment, said: "It is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would of course abstain in any case from prolonging a patent which was materially bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit. Upon that question, it is the habit of this tribunal to consider whether the invention brought before them is one of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation." (7 *Moo. P. C. C., N. S.* 84.)

Remuneration.

655. *In re* BATE'S PATENT. [1836]

A large sum of money and much time being expended on *experiment* to perfect the invention, without any return, the patent extended. (1 *Web. P. C.* 739.)

In re SOUTHWORTH'S PATENT. [1837] See 611.

656. *In re* ROBERTS' PATENT. [1839]

A patentee is entitled to deduct the expenses of taking and defending a patent, and the value of his time devoted to the invention, in estimating the profits derived from the patent. (1 *Web. P. C.* 575.)

657. *In re* KAY'S PATENT. [1839]

In estimating profits the expense of taking and defending the patent and of making experiments are to be deducted. (1 *Web. P. C.* 572.)

658. *In re* DOWNTON'S PATENT. [1839]

On application by the widow of the patentee, who died in 1839, to extend a patent granted in 1825, on the ground of inadequate remuneration having been received by him in his lifetime, owing to want of capital, an extension was granted for five years, and the petitioner's costs were ordered to be paid, the opposing party having shown no good ground for their opposition, the Attorney-General appearing for the Crown. (1 *Web. P. C.* 565.)

A Lord: "When a party has shown great ingenuity in an invention, and, from want of capital and means, has not been able to obtain an adequate return, we have over and over again extended the patent under such circumstances. . . . We generally want this proof—that they made nothing for the first seven or eight years, and it only began to be profitable during the latter years. It is no case for an extension only to show that you made 200*l.* a year for the first fourteen years, and you want to make 200*l.* a year for seven years more." (*Ib.* 566.)

659. *In re* QUARRILL'S PATENT. [1840]

The petitioner having purchased the letters patent and stock in trade at a fair price of the patentee, and sustained no loss, the application for an extension of the term refused. (1 *Web. P. C.* 740.)

The actual expenses and receipts must be shown: it is not sufficient to show generally that there has been no profit. (*Ib.*)

660. *In re JONES' PATENT.* [1840]

The insufficiency of the usual term to afford remuneration, regard being had to the nature of the invention, is a ground for the extension of the term, provided the invention be meritorious and useful to the public. *Seemle*, that it is not necessary to show a probable ground for supposing that the petitioners would be remunerated by the extension prayed. (1 *Web. P. C.* 577.)

661. *In re GALLOWAY'S PATENT.* [1843]

The expense of litigation, the cost of the patents, the expense of bringing the invention into use, and a manufacturer's fair profit, must be deducted in estimating the profit derived by the monopoly. (1 *Web. P. C.* 729.)

662. *In re DEROSNE'S PATENT.* [1844]

The term of letters patent, for refining sugar by filtration through beds of granulated animal charcoal, extended for six years, on the ground that, although the patentee had realized a very reasonable profit, he had not derived a benefit to the same extent as that derived by the public from the invention. (2 *Web. P. C.* 1; 4 *Moo. P. C. C.* 416.)

663. *In re PERKINS' PATENT.* [1845]

Lord Langdale: "The question is what remuneration has been received under the patent, as a whole, not for any particular branch of it. . . . It is not intended that a patent should be divided and subdivided, and that you are to see whether he has received compensation upon one part and not upon another. The question is, whether the patent is to be renewed, which depends, amongst other things, upon this, whether he has received reasonable compensation during the

first term for which it was granted. If there were ten branches of the patent, if he had received 10,000*l.* under one of them, although he had received nothing under the other nine, it would be very questionable whether the Judicial Committee ought to grant an extension of the patent." (2 *Web. P. C.* 9.)

Per Lord Campbell: It is desirable, before applications for extension are heard, that the balance sheet should be handed over to the Solicitor for the Treasury, to examine it beforehand. (*Ib.* 14.)

It is material to consider, on applications for extension, in what ratio the profits have increased, if they have increased from year to year. (*Ib.* 16.)

664. *In re* LOWE'S PATENT. [1846]

The patentee was unable to show, in the usual way, from his books, that he had not derived from the sale of his invention an adequate remuneration. The patentee not having sold any of his patented machines had kept no books, but he had allowed a gas company, in numerous instances, to apply his invention, for the purpose of making its utility known. The manager of the gas company deposed that he was not aware of the patentee having ever derived any benefit from his invention, and that they had not paid him anything in respect of it.

Sir S. Lushington said: "Although there has been no direct evidence given of want of profit, which is a very important part of the petitioner's case, yet the evidence does show a *prima facie* case of no profit; and their Lordships are inclined to come to the conclusion that they are satisfied with the evidence, unless the Crown has reason to be dissatisfied with it. In these applications we have never permitted the petitioner to give evidence in his own case; but, if the Crown does not intend to raise the objection, that there is no proof of want of remuneration, then their Lordships are content with the evidence as it is." Patent extended. (10 *Jur.* 363.)

665. *In re* MUNTZ'S PATENT. [1846]

Where a patentee has obtained his remuneration by the

manufacture of the patented article during the existence of the patent, it is impossible to sever the profits realized as a manufacturer from those realized as a patentee. (2 *Web. P. C.* 121.)

The patentee having made 55,000*l.* by the manufacture, extension refused, on the ground that he had been sufficiently remunerated.

Lord Brougham, in delivering judgment, said: "We cannot weigh in golden scales the proportions between manufacturer's profits, and patentee's, but we must take it in the gross, and apply our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing nor in his favour straining—we must ascertain whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration." (*Ib.* 120.)

666. *In re* HARDY'S PATENT. [1849]

In estimating the profits made under a patent, the profits arising from the sale of the patented article for exportation must be added. (6 *Moo. P. C. C.* 441.)

667. *In re* BRIDSON'S PATENT. [1852]

Application, under statute 14 & 15 Vict. c. 99, s. 6, by parties who opposed an extension of letters patent, for production and inspection of the petitioner's accounts previous to the hearing of the petition, refused, with costs. (7 *Moo. P. C. C.* 499.)

668. *In re* HEATH'S PATENT. [1853]

Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition, to the effect that not only had there been no profits but a considerable loss. (8 *Moo. P. C. C.* 222.)

669. *In re* MARKWICK'S PATENT. [1860]

The accounts produced at the hearing were unsatisfactory, owing to the non-production of the books. The Judicial Committee, in recommending a prolongation of the term of the letters patent, directed a proper account of the profits and losses of the patent, to be verified by affidavit, with an explanation accounting for the non-production of the books, to be laid before the Attorney-General, subject to which they extended the term. (13 *Moo. P. C. C.* 310.)

670. *In re* NEWTON'S PATENT. [1861]

Letters patent for an invention communicated by a foreigner resident abroad, extended for five years. The invention (machinery for letter-press printing) was of a meritorious and useful character, but of an expensive nature, and only at the latter end of the term of the letters patent brought into public use; and, although the patent had been worked at a profit, it was not, in the opinion of the Judicial Committee, sufficiently remunerative, considering the value of the invention. (14 *Moo. P. C. C.* 156; 10 *W. R.* 731.)

In taking an account of the profits and loss of the working of a patent, the patentee is entitled to charge, as part of his expenses, for loss of time in endeavouring to bring the invention into general use. (*Id.*)

671. *In re* HUTCHINSON'S PATENT. [1861]

The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence. (14 *Moo. P. C. C.* 364.)

672. *In re* BETTS' PATENT. [1861]

The account of profit and loss of the patentee in working a patent ought to be clear and precise; and it is the duty of a patentee, if engaged in any other business, or as a manufacturer

of his own invention, to keep the accounts of the patent and the manufacture separately.

If a patentee is also manufacturer of his patent article, in taking account of the profits of the patent, he is entitled to deduct his profits as a manufacturer, as also the expenses caused by litigation in protecting his patent right. (1 *Moo. P. C. C.*, *N. S.* 49; 9 *Jur.*, *N. S.* 137; 11 *W. R.* 221; 7 *L. T. Rep.*, *N. S.* 577.)

673. *In re* HILL'S PATENT. [1863]

The most unreserved and clear statement of the patentee's remuneration is an indispensable condition in an application for an extension.

The patentee was also manufacturer and sold the patented article. In his accounts he deducted two-thirds as profits from the manufacture and sale, and only credited the patent with one-third:—Held, to be an unreasonable deduction.

Although law expenses incurred by the patentee in maintaining his patent rights are allowed in deduction of his profits, yet, where the patentee compromised suits and gave up costs to which he had an apparent title, a deduction on that head will not be allowed. (1 *Moo. P. C. C.*, *N. S.* 258; 9 *Jur.*, *N. S.* 1209; 12 *W. R.* 25; 9 *L. T. Rep.*, *N. S.* 101.)

674. *In re* TROTMAN'S PATENT. [1866]

To entitle a patentee to a prolongation of the term of letters patent, he must satisfactorily establish the amount of his profits.

Licensees stand, with respect to the profits, in the same position as assignees of the patent.

A patentee did not manufacture or sell the patented article (ship anchors), but granted licences to ironsmiths to manufacture, from whom he received royalties. On an application by him for an extension of the term of the letters patent, on the ground of inadequate remuneration, the accounts produced of his own expenditure in carrying on the patent being unsatisfactory, and no accounts given of the profits derived by the licensees, a prolongation of the letters patent was refused, first,

as the patentee's accounts were unsatisfactory, and secondly, from the patentee's having so dealt with his patent rights as to deprive him of the power of showing the amount of profit derived from the working of the patent. (3 *Moo. P. C. C.*, *N. S.* 488; *L. R.*, 1 *P. C.* 118.)

675. *In re POOLE'S PATENT.* [1867]

A patentee residing in *America*, for the purpose of getting the patented article into general use in *England*, arranged with an agent in *England*, and in consideration gave him a moiety of the royalties:—Held, that in estimating the profits of the patentee derived from the patent, such moiety was to be deducted. (4 *Moo. P. C. C.*, *N. S.* 452; *L. R.*, 1 *P. C.* 514.)

Lord Romilly, in delivering judgment, said: "There is no account of what profits he (the patentee) made in the *United States*, nor do their Lordships think it material for this purpose, because the question before them is, what profits were made and what benefits were sustained by the introduction of the invention into this country." (4 *Moo. P. C. C.*, *N. S.* 456.) See **680.**

676. *In re SAXBY'S PATENT.* [1870]

Where the patentee is also the manufacturer, the profits which he makes as manufacturer, although not strictly profits of the patent, must yet be taken into consideration in estimating the amount of his remuneration. Therefore, where, on a petition for prolongation, it appeared that the patentee was at the same time the manufacturer of the patented article, and was himself necessarily engaged in fixing and putting up the patented apparatus, and that the accounts for such services were so intermixed as to render it impossible on their face to separate the items of profit received from the patent, it appearing that, on the whole, the receipts had been very large, and that even on the balance alleged there had been considerable gain to the patentee, the Judicial Committee held that such

accounts were unsatisfactory, and refused the application, but without costs. (7 *Moo. P. C. C., N. S.* 82.)

Lord Cairns, in delivering judgment, said: "It is the duty of every patentee who comes for the prolongation of his patent, to take upon himself the *onus* of satisfying this committee, in a manner which admits of no controversy, of what has been the amount of remuneration which, in every point of view, the invention has brought to him, in order that their Lordships may be able to come to a conclusion, whether that remuneration may fairly be considered a sufficient reward for his invention or not. It is not for this committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what may be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been that he has received." (*Ib.* 85.)

677. *In re CLARK'S PATENT.* [1870]

A petitioner, seeking the grace and favour of the Crown, in applying for an extension of the term of letters patent, is bound to bring his accounts before the committee in such a shape as to leave no doubt what the remuneration has been that he has received from the patent.

The petition for extension, and the accounts furnished by the petitioner (the patentee) not containing sufficiently full and accurate information in respect to the patent, or the remuneration received by him, the Judicial Committee declined to recommend a prolongation of the term.

The principle, where the statement of the remuneration received by the patentee, is on the face of the petition and accounts filed unsatisfactory, of adjudicating without reference to the merits of the invention, as acted on in *Saxby's Patent*, recognized. (7 *Moo. P. C. C., N. S.* 255.)

678. *In re HOUGHTON'S PATENT.* [1871]

The statement of accounts furnished being *primâ facie* satis-

factory, the petitioners were allowed to prove the merits of the invention before going into the accounts. (7 *Moo. P. C. C.*, *N. S.* 309.)

Lord Justice James : “ Their Lordships think that the cases of *Saxby’s Patent* and *Clark’s Patent* only go to this extent, that where there are special statements which show upon the face of the accounts, that the petitioners have, in fact, made very large profits by their invention, as was the fact in both those cases, such circumstance is sufficient for their Lordships at once to determine the application without going into the question of the merits of the invention.” (*Ib.* 311.)

679. *In re WIELD’S PATENT.* [1871]

Accounts of profits and loss filed by a patentee on his application for a prolongation of the term of letters patent being *primâ facie* unsatisfactory, the Judicial Committee directed the question of accounts to be taken before considering the merits of the invention. As the accounts were not satisfactorily explained, the application for a prolongation was refused.

The difference between the sum for which a patentee has sold his patent and that which he has paid in buying it again cannot be allowed in the accounts as one of loss, but must be regarded as a mere commercial speculation. (8 *Moo. P. C. C.*, *N. S.* 300; *L. R.*, 4 *P. C.* 89.)

680. *In re JOHNSON’S PATENT.* [1871]

When the possession of the patent has brought to the patentee the power of commanding orders as a manufacturer, it is to be taken into consideration in estimating the profits derived from the patent. (8 *Moo. P. C. C.*, *N. S.* 291.)

The Lord Justice James, in delivering judgment, said : “ It was suggested to their Lordships that they ought not to take into consideration any of the profits made in *America*, and reference was made to Poole’s patent. Their Lordships desire it to be understood that that case is not to be considered as

laying down any general rule of law. Whatever may have been the peculiar circumstances of that case, in which their Lordships, exercising their discretion, thought fit not to take into account the American profits, that is not to be considered as laying down any general rule. Their Lordships are of opinion, that where the question to be considered is, whether an invention has been sufficiently remunerated or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee, or the person who claims the right of the patentee, whether it be in one country or another." (*Ib.*)

681. *In re* CARR'S PATENT. [1873]

Circumstances showing a want of adequate remuneration, an extension of the term of letters patent granted for six years.

In estimating the profits derived from the patent, the Judicial Committee will take into consideration a deduction from the profits of the patent for the personal expenses of the patentee for the exclusive devotion of his time in bringing the patent into practical operation and public notice. (*L. R.*, 4 *P. C.* 539; 9 *Moo. P. C. C.*, *N. S.* 379.)

682. *In re* JOHNSON'S AND ATKINSON'S PATENTS. [1873]

By the ninth of the rules touching letters patent, to be observed in proceedings before the Privy Council, under 5 & 6 Will. 4, c. 83, it is provided that a party applying for an extension of a patent under sect. 4 of the said act must lodge at the council office four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the committee at the hearing:—Held, that the Judicial Committee will not enter upon the accounts, in a case for extension, unless they have been filed in accordance with the above rule. (*L. R.*, 5 *P. C.* 87.)

Objections to Extension.

683. *In re* WOODCROFT'S PATENT. [1841]

An invention as described in the specification, having succeeded at first to a limited extent for certain patterns and colours, but being inapplicable for the more elaborate patterns and brighter colours, until rendered so by means of certain improvements introduced from abroad, whereby it had become of great value, an application for the extension of the patent was refused. (1 *Web. R.* 740; 3 *Moo. P. C. C.* 171.)

684. *In re* SIMISTER'S PATENT. [1841]

Semle, that negligence on the part of the patentee in restraining infringement is a ground of opposition. (1 *Web. P. C.* 724; 4 *Moo. P. C. C.* 164.)

685. *In re* GALLOWAY'S PATENT. [1843]

The fact of great improvements having been made on the original invention, affords no objection to the extension of the term. (1 *Web. P. C.* 727.) See 630.

686. *In re* BELL'S PATENT. [1846]

Application for the extension of a patent for manufacturing lucifer matches and boxes. The want of profit arose from two circumstances; first, a defect in the composition with which the match was loaded, which was not rectified until ten years after the date of the patent; secondly, great loss had resulted from a fire which occurred on the premises, and, when the premises were rebuilt, the petitioner discovered that no insurance office would insure the premises, and that the terms of his lease obliged him to insure, and that, consequently, he was obliged to build other premises. The profits did not commence till three years before the expiration of the patent, and at the time of petition were under 700*l*. Extension refused. (10 *Jur.* 363.)

687. *In re* PINKUS' PATENT. [1848]

The non-reduction of an invention to practical operation in

such a manner as to contribute to the public service, and the absence of evidence to prove the probability of its being so reduced into practice in the future, coupled with the fact that the patentee has allowed his patent to be infringed without any assertion of his right at law, is a sufficient ground for refusing to prolong a patent. Lord Langdale, M. R., said: "Upon the effect, the utility and the merit of the patentee's contrivance, there has been considerable evidence, and also upon the supposed futility of that contrivance. What is perhaps the strongest evidence, or the evidence upon which the best reliance can be placed, is this: that, from the time when the patent was granted up to this present time, this plan has not been reduced to practical operation in any way which has been at all calculated to contribute to the public service; at this time it does not appear, at least there is no evidence whatever to show, that, as to this plan—the plan which is described in the first specification—there is now any, even the least, prospect of reducing it to practical operation." (12 *Jur.* 234.)

In re BAXTER'S PATENT. [1849] See 696.

688. *In re* PATTERSON'S PATENT. [1849]

A patentee entered into an agreement with certain parties to work his patent, but, owing to disputes between them, the invention was not prosecuted until a short time before the expiration of the term of the letters patent. In such circumstances, an extension was refused. (6 *Moo. P. C. C.* 469; 13 *Jur.* 593.)

In re CLARIDGE'S PATENT. [1851] See 741.

689. *In re* FOARDE'S PATENT. [1855]

After an assignee of a patentee had incurred considerable loss in carrying out a patent for a smoke prevention apparatus, an act of parliament passed to compel the owners of furnaces in the metropolis to construct some form of apparatus so as to consume their own smoke:—Held, on an application for a prolongation of the letters patent, that though the act of parliament might,

in effect, compel the use of the petitioner's patent, yet that such circumstance formed no objection to a renewal of the term of the letters patent, the merits of the invention and loss incurred in carrying it out being established. (9 *Moo. P. C. C.* 376.)

690. *In re* CARDWELL'S PATENT. [1856]

A patentee agreed by deed with a public company to grant them exclusive licence to use his patented machine, and also covenanted with them to obtain, at the expiration of the term, a renewal of the patent for the same purpose. Under this deed the company alone used the patent. An application by the patentee for a prolongation refused, on the ground that the agreement was contrary to public policy, and repugnant to the provisions of the statute 5 & 6 Will. 4, c. 83, relating to prolongations of letters patent. (10 *Moo. P. C. C.* 488.)

691. *In re* NORTON'S PATENT. [1863]

Where a patentee has intentionally delayed for a length of time attempting to put his invention into practice, an extension will not be recommended, unless he can show some reasonable excuse, such as want of funds, for the delay. (1 *Moo. P. C. C.*, *N. S.* 339.)

692. *In re* GOUCHER'S PATENT. [1865]

In the objections filed by the objectors, the point was not taken, that the power given by 7 & 8 Vict. c. 69, s. 2, to recommend an extension of the term of letters patent for an invention, is exhausted when an extension has been once recommended, and new letters patent granted:—Held, that the objection could be raised on the application to fix a day for hearing of the petition. (2 *Moo. P. C. C.* 532.)

In re M'INNES' PATENT. [1868] See 718.

*Conditions imposed.***693.** *In re* WHITEHOUSE'S PATENT. [1838]

The inventor, a mechanic, having assigned his interest to the petitioner, his master, the Judicial Committee, under the circumstances, made it a condition to their recommendation to the Crown to prolong the term of the patent, that the assignee of the patent should secure the inventor an annuity during the period of extension. (2 *Moo. P. C. C.* 496; 1 *Web. P. C.* 473.)

694. RUSSELL *v.* LEDSAM. [1845—1848]

Renewed letters patent were granted to the plaintiff "*upon his securing* to C. W. (the original inventor) an annuity of 500*l.* so long as the letters patent should last":—Held, that the meaning of this condition was, that a security should be given to C. W. for the annuity, but that whether it was given before or after the letters patent was immaterial; and that an averment, that the annuity was at the date of the new letters patent *secured*, was supported by proof of a deed to secure the annuity, executed before the new letters patent were granted. (14 *M. & W.* 574; affirmed in Exch. Ch., 16 *M. & W.* 633; and in House of Lords, 1 *H. L. Cas.* 687.)

There is nothing in the statute (5 & 6 Will. 4, c. 83) to fetter the discretion of the Crown in the extension of letters patent, except the length of time for which that extension is to be granted. Lord Cottenham, L. C., in delivering the judgment of the House of Lords, said: "I can find nothing in the act of parliament which authorizes the Judicial Committee of the Privy Council to impose any terms, or to make any recommendations to his Majesty with respect to the parties seeking for the grant of the new letters patent, except the fact of whether the letters patent shall be extended or not. . . . What the Judicial Committee is to report upon is merely as to matters between the public and the party applying, whether the party applying for the new letters patent has made out a case as against the public to have the old letters patent renewed. But

as to imposing any condition upon the Crown, which has otherwise the right to make the grant, there is nothing in the act to restrain the Crown from exercising any discretion it pleases." (1 *H. L. Cas.* 699.)

695. *In re* BODMER'S PATENT. [1849]

Where the executor of the surviving assignee of a patentee petitioned for an extension of the term of the letters patent, and it was established that a valuable consideration had been given for the assignment, and that the assignee had sustained considerable loss, the Judicial Committee, in granting an extension of the term, refused to impose terms upon the petitioners in favour of the patentee. (6 *Moo. P. C. C.* 468.)

Lord Brougham : " Terms are only imposed on the assignee where the inventors and patentees have made nothing by their invention." (*Ib.* 469.)

696. *In re* BAXTER'S PATENT. [1849]

Application for the extension of a patent for an improved method of printing in colours. The petition was opposed by the apprentices of the patentee, on the ground that they had served their time with the petitioner under the expectation that, on the expiration of the patent, they would be able to exercise the trade themselves; and that they had not been properly taught any other trade by the patentee, and, therefore, that they would be unable to gain their livelihood :—Held, that, if this defence had been founded in fact, the Judicial Committee would have put the petitioner under terms; but, as it was proved that the apprentices had received such instruction as to enable them to get employment in another branch of the trade, no condition was imposed on the patentee. (3 *Jur.* 593.)

697. *In re* HARDY'S PATENT. [1849]

The inventor and patentee of improvements in manufacturing iron axletrees for railway carriages had lost largely by the patent, but his assignees had lately made considerable profits, and from their position in the trade, were likely to command a

very large sale of the patented article. The invention was of high merit, and of great service to the public safety. In such circumstances, a prolongation of the term was granted to the assignees for four years, upon condition, first, that the assignees secured to the patentee half the profits derived from the sale; and, secondly, that the patented article should be sold by the assignees to the public, at a certain fixed price. (6 *Moo. P. C. C.* 441; 13 *Jur.* 177.)

698. *In re* PETTIT SMITH'S PATENT. [1850]

In granting prolongation, the Judicial Committee imposed a condition, that the Commissioners for executing the office of High Admiral should have the right of manufacturing such invention, for the service of her Majesty, without any licence from the patentee. (7 *Moo. P. C. C.* 133.)

699. *In re* BODMER'S PATENT. [1853]

Where letters patent (for improvements in machinery, tools or apparatus for cutting, planing, turning, drilling and rolling metals) embraced several subjects, one only of which, namely, the rolling of metals, had been worked out, and that part of the patent was affected by subsequent patented improvements by the same patentee, and could not be effectually used without such subsequent improvements; the Judicial Committee, before recommending an extension of the term of the first patent, put the petitioner upon terms of disclaiming all the parts of the original patent not worked out, and restricted the prolongation to the unexpired term of the subsequent patents. (8 *Moo. P. C. C.* 282.)

700. *In re* SCHLUMBERGER'S PATENT. [1853]

A patentee having obtained an extension warrant neglected to get the patent sealed. A subsequent petition to the Crown, by a foreigner, to revoke this warrant was dismissed, on condition of the payment by the patentee of the petitioner's costs, and that no action should be brought for any infringements

between the date of the warrant and the subsequent petition. (9 *Moo. P. C. C.* 1.)

701. *In re* CARPENTER'S PATENT. [1854]

The Judicial Committee, in granting an extension of the patent, which was extensively used in the Royal Navy, refused to annex a condition allowing the Crown the use of the patent, for the public service, without licence from the patentee. (2 *Moo. P. C. C., N. S.* 191 (*n.*).)

702. *In re* NORMANDY'S PATENT. [1855]

Patentee, formerly in partnership with J. & W., by a deed of dissolution stipulated that J. & W. should have the exclusive right of granting, in certain cases there provided, licences for manufacturing the patent article. In recommending an extension of the term of the letters patent, the Judicial Committee imposed a condition upon the patentee to secure to J., in whom the interest under the deed of dissolution then vested, the same interest in the new letters patent as related to the granting of licences as was provided by the deed of dissolution, but refused to allow J. to substitute new licences for those granted under the original letters patent, in the event of the original licensees declining to renew their licences from him under the new grant. (9 *Moo. P. C. C.* 452.)

703. *In re* MARKWICK'S PATENT. [1860]

An extension granted to the assignee, upon condition of an annuity being secured to the patentee. (13 *Moo. P. C. C.* 310.)

704. *In re* LANCASTER'S PATENT. [1864]

Patent for improvements in the manufacture of fire-arms. The patentee had received large sums of money from government, for expenses of experiments, and by way of bounty and reward, but from the nature of the patent had not, in the opinion of the Judicial Committee, received sufficient remuneration for his invention, and in granting an extension, their

Lordships refused to impose a condition in the new grant, that the Crown should be at liberty to use the invention for the public service without licence from the patentee. (2 *Moo. P. C. C.*, *N. S.* 189.)

705. *In re* MALLET'S PATENT. [1866]

A patentee, who was not a manufacturer, granted a licence to a manufacturing firm to manufacture the patented article, which, by agreement between them, was of an almost exclusive character. In granting a prolongation of the term of the letters patent, the new letters patent were directed to be made upon condition that licences should be granted by the patentee to the public upon terms similar to the one already granted. (4 *Moo. P. C. C.*, *N. S.* 175 ; *L. R.*, 1 *P. C.* 308.)

706. *In re* HERBERT'S PATENT. [1867]

Petition for prolongation of term of letters patent by patentee, together with the assignees of a moiety of the patent. After the presentation of the petition, and before the hearing, the patentee died, having by his will appointed his widow executrix and residuary legatee. Extension granted to the assignees, on condition that they held the moiety of the patent in trust for the widow of the patentee. (4 *Moo. P. C. C.*, *N. S.* 300 ; *L. R.*, 1 *P. C.* 399.)

707. *In re* PITMAN'S PATENT. [1871]

Sir J. W. Colvile, in delivering judgment, said: "It has been the practice of this tribunal, in cases in which an application of this kind (extension) on the part of the assignee has been granted, to impose conditions, whereby a proportion, at least, of the benefits to be derived from the patent should go to the original inventor: *In re Russell's Patent.*" (*L. R.*, 4 *P. C.* 87.)

Questions of Validity.

708. *In re ERARD'S PATENT.* [1835]

A patent will not be extended which is palpably bad, but their Lordships only require a *primâ facie* case to be made as to the validity of the patent. (1 *Web. P. C.* 557, note (a).)

709. *In re KAY'S PATENT.* [1839]

Extension of letters patent about to expire granted, pending a suit involving the question of their validity, where the judgment of the court cannot be obtained before the expiration of the patent. It is sufficient to establish a *primâ facie* case of the validity of a patent on an application for an extension. (1 *Web. R.* 568; 3 *Moo. P. C. C.* 24.)

710. *In re GALLOWAY'S PATENT.* [1843]

The new letters patent are granted subject to the same objections as the old, and the questions of novelty and utility will not be minutely entered on. (1 *Web. P. C.* 725.)

711. *In re ROBINSON'S PATENT.* [1845]

The use of an invention in England prior to the date of letters patent granted for Scotland will invalidate the Scotch patent; and the Judicial Committee accordingly refused to confirm a Scotch patent, the invention being used in England before the date of the Scotch patent. (5 *Moo. P. C. C.* 65.)

712. *In re WOODCROFT'S PATENT.* [1846]

Lord Brougham, in delivering judgment, said: "In all cases where there is a disputed right as to the validity of the patent, and where the validity of the patent itself must come in question, two things are to be considered. First, is the case to prove the invalidity of the patent, to prove the patent void, clear, past all ordinary and reasonable doubt; or, secondly, does the case hang so doubtful, that their Lordships would retire from its consideration, and not, because it is not necessary, decide the question here. In the former instance, namely, where it is a

clear case, or nearly a clear case, their Lordships will not grant an extension ; first, because they do not see merits, and, secondly, because they will not put the parties against whom the patent right is granted and is sought to be extended, to the vexation and trouble and expense either of bringing a *scire facias* to repeal the letters patent, or of sustaining an action for infringement. But where the matter hangs very doubtful, where there is conflicting evidence, where upon the construction of the specification or the patent, or in any other way, questions of law or questions of fact, as it may be, shall arise, their Lordships have not been used to refuse to exercise their discretionary powers, vested in them by the legislature, of recommending an extension, merely because elsewhere the validity of the patent may reasonably be contested. . . . Nothing is decided here in granting the extension as to the validity of the patent. All objections to it are saved, of course, and if an extension should be granted of an invalid patent, that would be done which would be only nugatory and not hurtful, except in the way I have described of the expense to the parties; that is, this only would be done, that an invalid patent would be extended for so many years, and if the courts of law held it to be invalid, that extension would operate nothing in favour of the patentee." (2 *Web. P. C.* 30.)

713. *In re PINKUS' PATENT.* [1848]

Lord Langdale, M.R.: "On an occasion of this kind, this court has, in no very direct way, occasion to consider whether the patent is or is not valid at law. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it." (12 *Jur.* 234.)

714. *In re HEATH'S PATENT.* [1853]

The circumstance of there being *lis pendens*, respecting the validity of the letters patent, is no objection to the grant of an

extension of the original letters patent. (8 *Moo. P. C. C.* 217; 2 *Web. P. C.* 247.)

715. *In re* BETTS' PATENT. [1862]

If it can be clearly shown that the patent sought to be extended is bad for want of originality, the Judicial Committee will not entertain the application. *Aliter*, if at most, a doubtful question as to the validity of the letters patent can be raised. (1 *Moo. P. C. C., N. S.* 49.)

Lord Justice Turner, in the course of the argument, said: "A sufficient *primâ facie* case has been shown by the judgment of the House of Lords, in favour of the validity of this patent. It is not the practice of this tribunal, in applications of this kind, to go into the question of the validity or invalidity of the letters patent." (*Ib.* 52.)

716. *In re* HILL'S PATENT. [1863]

Sir J. T. Coleridge, in delivering judgment, said: "Their Lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent which is manifestly bad; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of want of novelty and want of utility, so far as they affect the validity of this patent. Indeed, the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account; and in their Lordship's judgment they are right in that contention." (1 *Moo. P. C. C., N. S.* 262.)

717. *In re* M'DOUGAL'S PATENT. [1867]

Sir W. Erle: "It is not the duty of the Judicial Committee upon such an application (extension) to adjudicate upon the validity or invalidity of the patent itself, but they must, in

deciding whether the above conditions have been established, ascertain the meaning of the specification." (5 *Moo. P. C. C.*, *N. S.* 4.)

718. *In re M'INNES' PATENT.* [1868]

The subject-matter of an invention was the employment of a metallic soap, composed of well known chemical substances in common use, which the specification described as applicable for coating of iron and wood to prevent the fouling of ships' bottoms, and for other useful purposes. Prolongation of the term of such letters patent refused on the ground, first, that it would be detrimental to the public interest; secondly, that adequate remuneration (2,835*l.*) had been received. (5 *Moo. P. C. C.*, *N. S.* 72.)

Sir W. Erle said: "Although this tribunal does not adjudicate upon the validity of a patent, yet in a case where the validity is doubtful, their Lordships exercise a discretion in recommending, or otherwise, the Crown to prolong the term." (*Ib.* 76.) "Their Lordships taking into consideration, with reference to the public interest, that the individual substance, for the application of which the patent is sought to be prolonged, is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion, that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it is. On the whole, therefore, their Lordships are of opinion, that they ought not to recommend her Majesty, under such circumstances, to grant a prolongation." (*Ib.* 78.)

In re SAXBY'S PATENT. [1870] See **654.**

Extension of Patent for an Invention also patented Abroad.

719. *In re* BODMER'S PATENT. [1853]

The provisions of sect. 25 of the statute 15 & 16 Vict. c. 83, enacting that letters patent obtained in the United Kingdom for patented foreign inventions are not to continue in force after the expiration of the foreign patent, apply only to patents granted in the United Kingdom subsequent to the passing of that statute. (8 *Moo. P. C. C.* 282.)

720. *In re* AUBÉ'S PATENT. [1854]

Section 25 of the 15 & 16 Vict. c. 83, enacts "that no letters patent for or in respect of an invention for which any such patent or like privileges shall have been obtained in any foreign country, and which shall be granted in the United Kingdom, from the expiration of the term for which such letters patent or privilege was granted or was in force, shall be of any validity." The 16 & 17 Vict. c. 115, s. 7, declared and enacted, that new letters patent granted by way of prolongation, should be granted according to the provisions of the 15 & 16 Vict. c. 83.

Application was made under the 5 & 6 Will. 4, c. 83, and 2 & 3 Vict. c. 69, by the assignees of a patentee for extension of an English patent for a foreign importation patented in France. At the date of the application the French patent had expired:—Held, dismissing the petition, that as the foreign patent had expired, no renewed grant would be valid by sect. 25 of the 15 & 16 Vict. c. 83, as sect. 7 of the 16 & 17 Vict. c. 113, made an extended patent a new patent, within the provisions of sect. 25 of the 15 & 16 Vict. c. 83. (9 *Moo. P. C. C.* 43.)

721. *In re* NEWTON'S PATENT. [1862]

A patent (for an invention communicated by a foreigner abroad) was taken out in *England*, and the inventor a few weeks afterwards obtained letters patent for the same invention in the United States of *America*. An application made for prolongation of the English patent before the American patent

had expired, refused. (15 *Moo. P. C. C.* 176; 9 *Jur., N. S.* 109.)

The Right Hon. Dr. Lushington, in delivering judgment, said: "Their Lordships have considered the cases bearing upon this point which have previously been decided by the Judicial Committee upon former occasions, and they are of opinion, that those cases were all rightly decided; and they have no intention of departing from the principles there laid down. It appears, however, to their Lordships, that the decision of this case rests upon a very narrow principle indeed. The patents in *England* and the United States of *America*, were granted almost simultaneously, and though this case does not come within the letter of the statute, it appears to their Lordships to come within the true spirit of it, and their Lordships are of opinion that, in the circumstances, they, in the exercise of their discretion, ought not to advise her Majesty to grant a prolongation of the patent." (15 *Moo. P. C. C.* 180.)

722. *In re BETTS' PATENT.* [1862]

In 1849, letters patent were granted in *England* to B., a British subject. In 1850, a patent was granted in *France*, for the same invention, to the patentee for fifteen years, and another in *Belgium*, to a party on his behalf, for ten years. The Belgian patent expired before the English patent, and before application was made for a prolongation of that patent:—Held, that the Judicial Committee had jurisdiction to entertain an application for the prolongation of the English patent. (1 *Moo. P. C. C., N. S.* 49; 9 *Jur., N. S.* 137; 11 *W. R.* 221; 7 *L. T. Rep., N. S.* 577.)

Lord Chelmsford, in delivering judgment, said: "The earlier part of the 25th section (15 & 16 Vict. c. 83) clearly applies only to cases where patents have been granted in foreign countries before the grant of the patent in the United Kingdom, and the words in the proviso, 'any such patent or like privilege,' must be taken to refer to the entire description of the patents mentioned in the foregoing part of the section, and to no others. This construction renders the section con-

sistent throughout, and applicable in every part of it to the same subject. Where a patent is taken out in a foreign country before a patent for the same invention in the United Kingdom, the latter patent is to terminate at the same time as the foreign patent. Where the term in the foreign patent has expired, any grant of letters patent in the United Kingdom made after that period is to be of no validity." (1 *Moo. P. C. C.* 59.)

723. *In re HILL'S PATENT.* [1863]

A patent was granted in *England* before the passing of the statute, 15 & 16 Vict. c. 83. A patent for a similar invention had been granted in *France* to another person prior to the English patent, but it did not satisfactorily appear that the English patentee had any previous knowledge of the foreign invention. The French patent had not expired at the time of the application for prolongation:—Held, that, although the case did not fall strictly within the terms of the 25th section of that statute, yet that the policy which the legislature there indicated, was to guide the committee in the exercise of their discretion, that policy being, to prevent, in the case of inventions made and patented in any foreign country, the continuance of a monopoly in *England* by means of a patent granted subsequently here, and after the time when the discovery shall have become public property in the foreign country, and that the prolongation of an existing patent fell within such rule. (1 *Moo. P. C. C.*, N. S. 258; 9 *Jur.*, N. S. 1209; 12 *W. R.* 25; 9 *L. T. Rep.*, N. S. 101.)

724. *In re POOLE'S PATENT.* [1867]

The 15 & 16 Vict. c. 83, s. 25, does not deprive the Judicial Committee of the Privy Council of the power to entertain an application for an extension of the term of letters patent taken out first in *England*, though a patent has been obtained for the same invention in a foreign state; and the foreign patent would expire before the expiration of the prolonged patent.

Secus, if the patent was first obtained abroad by a foreign subject, and afterwards taken out in *England*. (4 *Moo. P. C. C.*, *N. S.* 452; *L. R.*, 1 *P. C.* 514.)

Lord Romilly, in delivering judgment, said: " Their Lordships are of opinion that this clause of the statute (sect. 25) must apply to a case where a patent has been previously obtained in a foreign country. And it is obvious, from various considerations, that that must be the meaning of the clause, for, if not, an English-born subject who took out a patent in this country for an invention invented here, could not venture to take out a patent in a foreign country if the patent in the foreign country was of shorter duration than in this country, as, for instance, in Belgium, where the term appears to be ten years, as it would absolutely preclude his ever applying for a continuation of the patent here, inasmuch as the patent for the same invention would previously have expired in the foreign country." (4 *Moo. P. C. C.*, *N. S.* 458.)

725. *In re* NORMAND'S PATENT. [1870]

A patentee, a foreigner, patented his invention first in *England* and afterwards in *France*, which latter patent, at the date of the application for a prolongation of the English patent, had a year to run:—Held, by the Judicial Committee, that they could not recommend the Crown to extend the term upon the chance of the French patent being extended:—Held, further, that if the French patent had expired there was no power in the committee to recommend an extension of the English patent. (6 *Moo. P. C. C.*, *N. S.* 477.)

726. *In re* WINAN'S PATENT. [1871]

Upon the construction of sect. 25 of 15 & 16 Vict. c. 83:—Held, that that section does not apply where an English patent is taken out in this country before a patent for the same invention is obtained in a foreign country. A patent by American subjects was taken out in this country, and shortly afterwards in *America* and *France* for the same invention. After the expiration of the French patent, and within a few months of the expiration of the American patent,

application was made for a prolongation of the English patent. Such application refused, as the Judicial Committee would not, on the ground of general policy, recommend a renewal of the English patent after the French patent had been allowed to expire. (8 *Moo. P. C. C.*, N. S. 306.)

727. *In re* JOHNSON'S PATENT. [1871]

The Lord Justice James, in delivering judgment, said: "Their Lordships are satisfied to adopt the rule as laid down in *Betts' Patent*, which is one in which the matter underwent the fullest consideration, and they are satisfied that the decision in that case was a right decision, namely, that an English patentee obtaining a patent abroad for his invention, in addition to his English patent, that the English patentee is in no sense to be prejudiced either with respect to his original patent, or with respect to any application which he may be advised to make for a renewal of it. Their Lordships are also of opinion, that an English patentee who has obtained a patent from abroad, may make out a case for a prolongation of his patent, but they must have regard to all the circumstances of the case. They must have regard to the antecedent circumstances, the effect of which the legislature itself has thought of so much importance as to make it absolutely impossible for the Crown in some cases to grant a renewal of a patent, or even to extend a patent beyond the duration of the foreign patent, whether the invention is in its origin and domicile a foreign invention or an English invention, and that difference their Lordships think they must have regard to in considering the application." (8 *Moo. P. C. C.*, N. S. 287; *L. R.*, 4 *P. C.* 79.)

728. *In re* BLAKE'S PATENT. [1873]

Petition for the extension of the term of letters patent. A patent was first taken out in *America*, then in *England*, and two days subsequently in *France*. The French patent was allowed to drop:—Held, that although the Judicial Committee had jurisdiction under the 25th section of the Patent Law Amendment Act, 1852, to entertain the application, yet, on

the ground of public policy, as the French patent had been allowed to expire, they would not recommend an extension of the term. The court followed the decision in the case of *Winan's Patent*. (9 *Moo. P. C. C.*, *N. S.* 373; *L. R.*, 4 *P. C.* 535.)

Sir Barnes Peacock, in delivering judgment, said: "The word 'such' in the proviso in the 25th section of the statute 15 & 16 Vict. c. 83, has already received a judicial construction, the word 'such' being held to apply to a patent taken out in a foreign country before the grant of letters patent in *England*. (*In re Betts' Patent*.) Their Lordships, therefore, think the meaning is, that where a patent is taken out in a foreign country, before the grant of letters patent in *England*, and the foreign patent has expired, then that the patent in *England* should cease to be in force, and that where one 'such' patent, or the old patent, has been obtained abroad, then the English patent shall be determined at the expiration of the earliest of the letters patent granted in a foreign country." (*L. R.*, 4 *P. C.* 537.)

The Petitioner.

729. *In re* WRIGHT'S PATENT, *Ex parte* SHUTTLEWORTH. [1837]

Extension recommended in favour of the parties having the legal estate, without imposing any conditions with reference to the equitable claim of other parties connected with the patentee. (1 *Web. P. C.* 561.)

In an application for extension by an assignee, the title of the petitioner must be strictly proved, although no notice of intention to dispute the title is contained in the objections. (*Ib.*)

730. *In re* SOUTHWORTH'S PATENT. [1837]

The new letters patent must be granted to the party in whom the subsisting patent is legally vested. (1 *Web. P. C.* 487.)

731. *In re* DOWNTON'S PATENT. [1839] *In re* HEATH'S PATENT. [1853]

An extension of a patent may be granted to the administratrix of the patentee. (1 *Web. P. C.* 565; 8 *Moo. P. C. C.* 217.)

732. *In re* MORGAN'S PATENT. [1843]

Lord Brougham, in delivering judgment, said: "When applications are made to their Lordships for the extension of a patent term, that is to say, of a monopoly, under letters patent by assignees, to whom the interest of the patentee has been parted with, and in whom it is vested, their Lordships have always been used to consider, that by taking into their view and favourably listening to the application of the assignee, they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent." (1 *Web. P. C.* 737.)

733. *In re* GALLOWAY'S PATENT. [1843]

In an application by an assignee, his title must be strictly proved. (1 *Web. P. C.* 725.)

734. *RUSSELL v. LEDSAM.* [1845]

The power of the Crown to extend letters patent is not confined to *grantees*, but extends to *assignees*, and such renewed letters patent, granted to the *assignee*, are good by the statute 5 & 6 Will. 4, c. 83, independently of the 7 & 8 Vict. c. 69. (14 *M. & W.* 574; judgment affirmed in Exch. Ch., 16 *M. & W.* 633; and in H. of L., 1 *H. L. Cas.* 687.)

Sect. 4 of 5 & 6 Will. 4, c. 83, enacts that "if any person who now hath or shall hereafter obtain any letters patent as

aforesaid," shall advertise, &c., and petition, the Crown may grant an extension of the patent.

Parke, B., in delivering the judgment of the court, upon the construction of this section, said: "The ordinary sense of the word 'obtaining,' which alone would probably be taken to mean the original obtaining from the Crown, is, we think, explained by the context to mean the becoming possessed of it either by original grant, by assignment, or by *any other title*. We feel a difficulty in adopting the explanation of these words, 'as assignee,' given by some of the judges in the case of *Spilsbury v. Clough*, who suppose that they are meant to refer to an assignee of a foreign invention who obtains a patent here; for the *assignee* is distinguished from the *grantee*, and one who obtains letters patent as assignee, as distinguished from grantee, must take by *assignment* the *letters patent*, not the *invention*. Besides, the importer, who is not necessarily the *assignee* of a foreign invention, and very seldom is, may have letters patent granted to him. The act is certainly penned so as to leave the construction open to doubt, but our opinion is, that the power of renewal is not confined to grantees, but extends to assignees, and the legislature may reasonably be supposed to have intended to compensate the assignee as well as the patentee for labour bestowed and capital expended, without adequate remuneration, in bringing a useful invention to perfection, as they clearly have done by a substitute statute." (14 *M. & W.* 588.)

735. *In re* HARDY'S PATENT. [1849]

Extension of a patent granted to an assignee upon certain conditions. (6 *Moo. P. C. C.* 441; 13 *Jur.* 177.)

736. *In re* BODMER'S PATENT. [1849]

The extension of a patent may be granted, on petition, to the executor of the surviving assignee for valuable consideration of a patentee. (6 *Moo. P. C. C.* 469.)

737. *In re* BERRY'S PATENT. [1850]

Extension of letters patent granted for six years, where the invention was of considerable commercial value, and the importers had embarked a large capital upon machinery in trying to introduce it to general use, and incurred considerable loss in so doing. (7 *Moo. P. C. C.* 187.)

Lord Brougham, in delivering judgment, said: "Their Lordships have considered this case with the more attention, inasmuch as it is not very clear that it may not be considered the first case, in which we have ever granted an extension, solely upon the ground of importation. The patent law is framed in a way to include two species of public benefactors: the one, those who benefit the public by their ingenuity, industry, and science, and invention and personal capability; the other, those who benefit the public, without any ingenuity or invention of their own, by the importation of the results of foreign inventions. Now the latter is a benefit to the public incontestably, and, therefore, they render themselves entitled to be put upon somewhat, if not entirely, the same footing as inventors. In this case, certain parties have by their adventurous spirit, and by the outlay of capital, benefited the public in the proportion of the value of the foreign invention in question, which, but for that adventurous spirit and outlay of capital, would not have been available to the people of this country. That, therefore, is to be considered as a solid claim to the exercise of the *quasi* legislative power which the statute vests in this committee." (*Ib.* 189.) See also **635**.

738. *In re* PETTIT SMITH'S PATENT. [1850]

The person who has the legal estate in letters patent has the prior right to petition for an extension. In the present case the new letters patent were granted to the trustees of a joint-stock company, although the patentee joined in the petition. (7 *Moo. P. C. C.* 133.)

739. *In re* NOBLE'S PATENT. [1850]

An equitable assignee is entitled to appear with the legal

assignees of a patent, on a petition for a prolongation of the letters patent, if the name of such equitable assignee appears, with the other petitioners, in the advertisements required by sect. 4 of the statute 5 & 6 Will. 4, c. 83, and Rule 2, made in pursuance thereof. (7 *Moo. P. C. C.* 191.)

740. *In re* COOK & WHEATSTONE'S PATENT. [1851]

Semble, a company may obtain a renewal of letters patent. Extension was in this case refused on the grounds of sufficient remuneration; Lord Langdale, however, said: "If the company's speculation had been clearly made out to be a losing concern, it would perhaps have been matter for consideration whether there was not good ground for renewal." (38 *Lond. Jour.* 223.)

741. *In re* CLARIDGE'S PATENT. [1851]

The importer of an invention from abroad is an inventor within the meaning of the statute 5 & 6 Will. 4, c. 83, and entitled to apply for an extension of the term. But the Judicial Committee will look with jealousy into the merits of the invention imported.

Application for an extension by the trustees of a joint-stock company (the assignees of the patentee) refused; the invention imported having been in common use in *France*, and no great risk or expenditure incurred by the patentee or his assignees in introducing it to the public. (7 *Moo. P. C. C.* 394.)

Jervis, C. J., objected to the prolongation on the ground that the rule in granting letters patent is to limit the number of grantees to twelve. (*Ib.* 395.)

Mr. Pemberton Leigh, in the course of the argument, said: "No doubt extensions have been granted to assignees, but it is too strong to say that the assignees are to be treated with the same indulgence as patentees." (*Ib.*)

742. *In re* SCHLUMBERGER'S PATENT. [1853]

An alien resident abroad, who was interested in an English patent by a foreign inventor, and who had also considerable

dealings in this country in respect of sales of the patented machine and in granting licences for the use of such patent, held, in the circumstances, to have such a *locus standi* as to entitle him to petition the Crown to revoke an order in council for granting an extended term of an English patent, and to recall the warrant for sealing such patent. (9 *Moo. P. C. C.* 1.)

743. *In re* NAPIER'S PATENT. [1861]

The Judicial Committee have power, under statute 7 & 8 Vict. c. 69, s. 4, to grant an extension of the term of letters patent to the assignee of the patentee (in this case a public company), when the patentee has ceased to have any connection with the working of the patent. (13 *Moo. P. C. C.* 543; 9 *W. R.* 390.)

744. *In re* NEWTON'S PATENT. [1861]

Extension granted to a petitioner who had obtained the letters patent as agent and trustee for a foreign inventor. (14 *Moo. P. C. C.* 156.)

745. *In re* BOVILL'S PATENT. [1863]

The patentee had been involved in debt arising from extensive litigation in defending his patent rights, and had, moreover, mortgaged his letters patent, and entered into a deed of arrangement or inspectorship under the Bankruptcy Act with his creditors. The petition was presented by the patentee, and certain mortgagees and others claiming liens on the letters patent. In the circumstances, their Lordships granted the extension of the patent to the patentee alone. (1 *Moo. P. C. C.*, *N. S.* 348.)

746. *In re* NORTON'S PATENT. [1863]

Petition by assignee of patentee, who was dead, for prolongation of letters patent, dismissed by reason, (1) that the assignee had never taken any effectual steps to apply the invention to a useful and beneficial purpose; and (2) as the application for extension, though by the assignee, was in reality on

behalf of a joint-stock company, who purchased the letters patent for the purpose of trading with it, and with others founded upon it, and not for any purpose by means of which any benefit can be derived by the original inventor. (1 *Moo. P. C. C., N. S.* 339.)

The Master of the Rolls, in delivering judgment, said : “ Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use.” (*Ib.* 344.)

In re HERBERT'S PATENT. [1867] See 706.

747. *In re* NORMAND'S PATENT. [1870]

An assignee of the patentee, who had taken an assignment of four-fifths of the patent within a few months of the expiration of a patent, which had only just been brought into use, for a small consideration, was not entitled to any extension. (6 *Moo. P. C. C., N. S.* 477.)

748. *In re* PITMAN'S PATENT. [1871]

Sir J. W. Colvile, in delivering judgment, said : “ There are, no doubt, cases in which their Lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit, as it may be said, of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general rule which their Lordships entertain in applications on the part of assignees, is, as was stated by Lord Brougham, in

Morgan's Patent, that, by so doing, 'they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent.' " (8 *Moo. P. C. C., N. S.* 297.)

The Petition.

In re BRIDSON'S PATENT. [1852] See 667.

749. *In re* PITMAN'S PATENT. [1871]

As the recommendation to the Crown for the prolongation of the term of letters patent is a matter of discretion in the Judicial Committee, it is imperatively necessary that the petition for such prolongation should state fairly and fully everything relating to the patent: an omission to do so is fatal to the application.

Where the petition omitted to state that the patent was, in fact, a communication from a foreigner living abroad, who had previously to the English patent patented the same invention in *America*, and that the American patent had expired, though afterwards renewed in *America*, the Judicial Committee, in the circumstances, refused the application. (8 *Moo. P. C. C., N. S.* 293.)

750. *In re* JOHNSON'S PATENT. [1871]

A clear statement should be made, in the petition, of every matter applicable to the patent, the term of which it is desired should be extended. (*L. R.*, 4 *P. C.* 83.)

Amendment of the Petition.

751. *In re* HUTCHINSON'S PATENT. [1861]

Material facts, showing the title of the petitioner, were dis-

closed in evidence, which were omitted to be stated in the petition for prolongation. In such circumstances the hearing was postponed, and the petition directed to be amended by stating those facts. (14 *Moo. P. C. C.* 364.)

Time to present Petition—Prosecuting with effect.

752. *In re* MACINTOSH'S PATENT. [1836]

A petition was lodged in January, 1836, for the prolongation of a patent which expired in June, 1837. Application postponed on the ground that the profits accruing in the meantime might materially affect the question of extension. (1 *Web. P. C.* 739.)

753. *In re* BODMER'S PATENT. [1838—1840]

By 5 & 6 Will. 4, c. 83, s. 4, it is provided, "that no extension shall be granted if the application shall not be made and prosecuted *with effect*, before the expiration of the term originally granted in such letters patent:"—Held, by the Judicial Committee, that the petition for such prolongation must be brought to a hearing before the expiration of the letters patent, and that the pendency thereof is not sufficient to bring it within the intent and meaning of the proviso.

Where, therefore, the petitioner had been prevented prosecuting his petition before the expiration of the letters patent, by the conduct of parties objecting, and from the circumstance of the Judicial Committee not being sitting, and the period for which such letters patent had been originally granted, had, in the meantime, expired, the Judicial Committee, feeling themselves bound by the terms of the act of parliament, dismissed the petition, though no laches or neglect could be imputed to the petitioner; but the 5 & 6 Will. 4, c. 83, s. 4, having been repealed by the 2 & 3 Vict. c. 67, their Lordships, upon a fresh petition, granted an extension of the letters patent for seven years, under that act, on the ground that the invention was an

ingenious one, and that it did not appear that the patentee had received any remuneration until within the three years previous to the expiration of the patent. (2 *Moo. P. C. C.* 471; 1 *Web. P. C.* 740.)

754. *In re KAY'S PATENT.* [1839]

Letters patent being about to expire, an application for an extension will be heard during the pendency of legal proceedings as to the validity of the patent. (3 *Moo. P. C. C.* 24.)

755. *LEDHAM v. RUSSELL.* [1848]

An application for a prolongation of letters patent is "prosecuted with effect" within the terms of the statute, if the party applying obtain the report of the Judicial Committee of the Privy Council before the expiration of the original patent. (1 *H. L. Cas.* 687.)

756. *In re HUTCHINSON'S PATENT.* [1861]

Rule 3 of the Privy Council, made pursuant to the statute, 5 & 6 Will. 4, c. 83, relating to letters patent for inventions, provides that a petition under sections 2 and 4 of that statute, must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

A petitioner inserted the last advertisement of his intention to petition for a prolongation on the 24th of *May*, but did not present his petition until the 5th of *June* following. The registrar refused to receive the petition as being too late. Upon a special application for that purpose, it appearing that the delay arose from a mistake of the petitioner's agent, an order was made admitting the petition. (14 *Moo. P. C. C.* 364.)

*Rules.***757.** *In re* BODMER'S PATENT. P. C. [1839]

The rules enacted for practice in patent cases, under the 5 & 6 Will. 4, c. 83, must be observed in an application for a prolongation under 2 & 3 Vict. c. 67. (2 *Moo. P. C. C.* 471.)

In re JOHNSON & ATKINSON'S PATENT. [1873] See **682**.

*Advertisements.***758.** *In re* DEROSNE'S PATENT. [1844]

When the patentee resides abroad, and the invention is carried on under licensees, the advertisements should be inserted in papers circulating in the places where the manufacture is actually carried on. (2 *Web. P. C. C.* 2; 4 *Moo. P. C. C.* 416.)

759. *In re* PERKINS' PATENT. [1845]

The advertisements should be proved before the case is heard. The advertisements having been inserted in London papers only, a witness was allowed to be called to prove that the patent apparatus was manufactured in London and not elsewhere. (2 *Web. P. C. C.* 8.)

760. *In re* NOBLE'S PATENT. [1850]

To entitle an equitable assignee to appear with the legal assignee of a patent on a petition for a prolongation of the letters patent, the name of such equitable assignee must appear, with the other petitioner, in advertisements required by sect. 4 of the statute 5 & 6 Will. 4, c. 83, and Rule 2, made in pursuance thereof. (7 *Moo. P. C. C.* 191.)

Per Lord Brougham: If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation. (*Ib.* 194.)

In re HUTCHINSON'S PATENT. [1861] See **756**.

*Caveats.***761. *In re* SMITH'S PATENT. [1850]**

An application by the Lords of the Admiralty to enter a caveat and be heard against a petition for extension, such caveat not having been filed in proper time, refused; as the Attorney-General watches the interests of the government. (7 *Moo. P. C. C.* 133.)

762. *In re* LOWE'S PATENT. [1852]

The Judicial Committee will not permit a party to be heard in opposition to an application for a prolongation of the term of letters patent, unless a caveat has been entered in his own name. Where a patent agent had entered a caveat in his own name, but in reality as the agent of several other persons as well as on his own behalf, it was held that his counsel could only be heard for him, and could only ask such questions as respected his interest. Any one of the public has a right to enter a caveat and be heard in opposition at the hearing. (8 *Moo P. C. C.* 1.)

763. *In re* SCHLUMBERGER'S PATENT. [1853]

An alien residing abroad, who presents a petition to oppose the extension of a patent under which he, as a licensee, had had considerable dealings in this country, need not prove in a formal manner what his interest in the letters patent is. Whether an alien, living abroad, has a right, as such, to inform the Crown, by petition, as to any matters touching letters patent, *quære*. (2 *Eq. R.* 1.)

764. *In re* HUTCHINSON'S PATENT. [1861]

Where the Judicial Committee made an order to receive a petition which had not been presented in accordance with Rule 3 of the Privy Council, made pursuant to the statute 5 & 6 Will. 4, c. 83, and a caveat had been entered:—Held, that as the party filing the caveat was interested in sustaining the objection to the reception of the petition, notice of the application must be served on him. (14 *Moo. P. C. C.* 364.)

*Inspection.***765.** *In re* BRIDSON'S PATENT. [1851]

Application, under 14 & 15 Vict. c. 99, s. 6, by parties who opposed an extension, for production and inspection of the petitioner's accounts previously to the hearing of the petition, refused, with costs. (7 *Moo. P. C. C.* 499.)

*Counsel.***766.** *In re* ERARD'S PATENT. [1835]

In all unopposed petitions for the extension of letters patent the Attorney-General should attend on behalf of the Crown. (1 *Web. P. C.* 557.)

767. *In re* WOODCROFT'S PATENT. [1840]

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose. (3 *Moo. P. C. C.* 172 (n.).)

768. *In re* SMITH'S PATENT. [1850]

The Attorney-General represents the government and the public. (7 *Moo. P. C. C.* 133.)

In re LOWE'S PATENT. [1852] See **762.**

*The Grant.***769.** *In re* KAY'S PATENT. [1839]

The renewal grant of letters patent becomes invalid, if, after extension, the original patent is held to be bad. (1 *Web. P. C.* 571.)

In re GALLOWAY'S PATENT. [1843] See **710.**

770. *RUSSELL v. LEDSAM.* [1845]

Original letters patent, for a term of fourteen years, were

dated on the 26th of February, 1825, and renewed letters patent were dated on the 26th of February, 1839:—Held, that the day of the date must be reckoned inclusively, and that the former term expired on the 25th of February, 1839, and consequently the renewed letters patent were granted after the original letters patent had expired. Renewed letters patent, granted under 5 & 6 Will. 4, c. 83, s. 4, are not void if dated after the expiration of the term for which the original letters patent were granted, but may be granted by the Crown after the expiration of that term, provided the preliminary steps which the fourth section of the act requires to be taken by the patentee were complied with before that term ended. See 2 & 3 Vict. c. 67. (14 *M. & W.* 574; 14 *L. J., Exch.* 353; affirmed in *Exch. Ch.*, 16 *M. & W.* 633; and in House of Lords, 1 *H. L. Cas.* 687.)

In re WOODCROFT'S PATENT. [1846] See 712.

771. *In re* SMITH'S PATENT. [1847]

An application for renewed letters patent, to combine the substance of two patents, held by the petitioner, refused. (30 *Lond. Jour.* 451.)

772. *In re* PORTER'S PATENT. [1853]

Improvements effected upon the invention, for which the original patent was granted, by the nephew of the applicant for extension, were amalgamated with the original patent for the extended term. (*Coryton's Law of Letters Patent*, p. 217.)

773. *In re* HEATH'S PATENT. [1853]

Term of letters patent extended for seven years, in preference to a shorter period, on the ground of there being *lis pendens* respecting the validity of the patent, which would probably delay the enjoyment of the term of extension. (8 *Moo. P. C.* 217; 2 *Web. R.* 247.)

774. *In re* BODMER'S PATENT. [1853]

Where letters patent comprised several subjects, one only of

which had been worked out, and this part of the patent was affected by subsequent patented improvements by the same patentee; this portion of the patent only was extended, and the grant was restricted to the unexpired term of the subsequent patents. (8 *Moo. P. C. C.* 282.)

775. *In re* HONIBALL'S PATENT. [1855]

The statute 5 & 6 Will. 4, c. 83, s. 2, applies to confirmation of letters patent for an extended term, as the grant of such extended term is a grant of new letters patent, which are subject to the same conditions, and open to the same objections, and entitled to the same advantages as original letters patent. (9 *Moo. P. C. C.* 378; 2 *Web. P. C.* 201.)

In re LEE'S PATENT. [1856] See 639.

776. *In re* BETTS' PATENT. [1861]

The prolongation of a patent is, by 5 & 6 Will. 4, c. 86, and 16 & 17 Vict. c. 115, the same as a new grant. (1 *Moo. P. C. C.*, *N. S.* 49; 9 *Jur.*, *N. S.* 137; 11 *W. R.* 221; 7 *L. T. Rep.*, *N. S.* 577.)

777. *In re* BOVILL'S PATENT. [1863]

Letters patent were granted in 1849 for a patent for *England*, and in the year 1853 for *Ireland* and *Scotland*. Upon an application for a prolongation of the three patents, it was objected that the prior use of the English patent rendered the Scotch and Irish patents void. Such objection overruled, on the ground, that the statute 15 & 16 Vict. c. 83, s. 18, providing for a single patent for the United Kingdom, applied in the circumstances to this case, and was not affected by the 53rd section of that act. (1 *Moo. P. C. C.*, *N. S.* 348.)

778. *BOVILL v. FINCH.* [1870]

Three separate original letters patent were granted to the inventor for England, Scotland and Ireland respectively. The Scotch patent was void for want of novelty, and afterwards a prolongation of the terms of the three original patents was

granted by one and the same letters patent under the great seal of the United Kingdom, pursuant to 15 & 16 Vict. c. 83:—Held, that the grant of prolongation was divisible, and operated as if there had been separate grants by separate instruments for the three countries, so that the prolongation of the English patent was not rendered void by the invalidity of the Scotch patent. (39 *L. J.*, *C. P.* 277; *L. R.*, 5 *C. P.* 523.)

779. *In re* JOHNSON'S & ATKINSON'S PATENTS. [1873]

Two cognate patents, having different terms to run, extended so that both should expire on the same day. (*L. R.*, 5 *P. C.* 87.)

Revocation of Grant.

780. *In re* SCHLUMBERGER'S PATENT. [1853]

Patentees applied under the statute 5 & 6 Will. 4, c. 83, for an extension of the term of letters patent, and the Judicial Committee recommended a prolongation for six years, which recommendation was confirmed by the Crown by an order in council, and a warrant issued for sealing the letters patent. No step was taken by the patentees to procure the sealing of the new letters patent, and, after a delay of nearly three years, a party interested in opposing the renewal petitioned the Crown to revoke the order in council and the warrant to seal. It did not appear that the petitioner, or the public, had suffered any loss by the laches of the patentees. The Judicial Committee, to whom the petition was referred, considered the laches not of sufficient magnitude to deprive the patentees of all benefit of the renewed patent; but made it a condition, before dismissing the petition, that the patentees should pay the petitioner a gross sum for costs and give an undertaking not to prosecute for any infringement which might have occurred from the date of the order in council to the date of dismissal of the petition. (9 *Moo. P. C. C.* 1.)

*Costs.***781. *In re* WESTRUPP & GIBBIN'S PATENT. [1836]**

Lord Lyndhurst: "My opinion on the subject of costs is this: if a party entitled to oppose does come and oppose, and opposes successfully, if we do not give costs we shall discourage persons coming to protect the interests of the public. We have the power to give costs in any matter referred to us, and, sitting here as a Judicial Committee, we can give costs under the general act, not under the Patent Act." (1 *Web. P. C.* 556).

782. *In re* MACINTOSH'S PATENT. [1837]

The Judicial Committee give costs of opposition when the petitioner abandons his application for extension. (1 *Web. P. C.* 739.)

783. *In re* DOWNTON'S PATENT. [1839]

Costs will be given to the petitioner where there is no ground for the opposition. (1 *Web. P. C.* 567.)

784. *In re* MUNTZ'S PATENT. [1846]

Where the petitioner had fairly and honestly stated his case, both the things against and the things for him, in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration. (2 *Web. P. C.* 122.)

785. *In re* BRIDSON'S PATENT. [1852]

Costs given to all the opposers upon petitioners abandoning petition before hearing. When the petition is abandoned, it is not necessary that the opposers should serve the petitioners with notice of their intended application to the court for costs of opposition. (7 *Moo. P. C. C.* 499.)

786. *In re* HORNBY'S PATENT. [1853]

On a petition for prolongation of letters patent, a day was fixed for hearing. Objections were lodged against an extension. Before the hearing the petitioners abandoned the prosecution of the petition. In such circumstances costs of opposition allowed to opposer. (7 *Moo. P. C. C.* 503.)

In re SCHLUMBERGER'S PATENT. [1853] See **700.**

787. *In re* MILNER'S PATENT. [1854]

The Judicial Committee will exercise a discretion as to the allowance of an opposer's costs upon an abandoned petition for extension of letters patent.

A gross sum allowed for costs of opposers, instead of referring their costs to taxation.

An affidavit of merits by the petitioner upon the question of costs, rejected, as no copy had been served upon the opposers. (9 *Moo. P. C. C.* 39.)

788. *In re* JONES' PATENT. [1854]

Where there were two opponents to an application for a prolongation of a patent upon substantially the same grounds of objection, the Judicial Committee, upon a successful opposition, allowed a gross sum for the costs of both parties. Opponents' costs directed to be taxed at 100*l.*, and divided between the opponents. (9 *Moo. P. C. C.* 41.)

789. *In re* HONIBALL'S PATENT. [1855]

The Right Hon. Pemberton Leigh: "It is of great importance that parties should not be discouraged from bringing important facts to the knowledge of the court by fear of the costs which they may have to pay, even if their opposition be successful; and upon this ground, in *Westrupp & Gibbins' Patent*, the parties opposing were allowed their costs. But we are not satisfied with the manner in which this opposition has been conducted. Much expense has been occasioned by relying upon patents for inventions which have really no resemblance

to this, and witnesses have been produced to whose testimony, as we have already intimated, we cannot give the smallest credit." No costs allowed to the opponents. (9 *Moo. P. C. C.* 394.)

790. *In re HILL'S PATENT.* [1863]

Upon the dismissal of a petition for prolongation, the Judicial Committee, to avoid the expense of a formal taxation, allowed the petitioner the option of paying a gross sum of 1,000*l.* to the opponents for the costs of their successful opposition; such sum to be apportioned by the Registrar of the Privy Council among the several opponents, or in the alternative, dismissed the petition with costs generally. (1 *Moo. P. C. C., N. S.* 258.)

791. *In re WIELD'S PATENT.* [1871]

When two sets of opponents really represent the same kind of opposition, one set of costs, to be apportioned between them, will be allowed, unless the petitioner should prefer to tax the costs of all parties. (8 *Moo. P. C. C., N. S.* 300.)

Sir J. W. Colvile: "Their lordships have considered the question of costs, and they are inclined to adhere to the rule that has been laid down, almost from the first application under the act giving them jurisdiction in patent cases, that in the exercise of their power to grant costs it is certainly not desirable to refuse the costs of a fair opposition, since it is rather in the interest of this tribunal to encourage *bonâ fide* oppositions, in order that the court may be put into possession of all that can be alleged against the continuance of the patent." (*Ib.* 304.)

792. *In re JOHNSON'S PATENT.* [1871]

Where there were several opponents; on dismissing the petition a lump sum was awarded the opponents, to be divided *pro ratâ* for costs. (8 *Moo. P. C. C., N. S.* 282.)

CONFIRMATION OF LETTERS PATENT.

Grounds of and Objections to,

793. *In re* WESTRUPP & GIBBINS' PATENT. [1836]

An especial and strong case must be made out to justify the interposition of the Judicial Committee, and if the petitioner has a remedy by disclaimer or memorandum of alteration, the confirmation will not be granted.

Lord Lyndhurst said: "The act could never be intended to apply to a case where two patents have been taken out for the same thing, that the subsequent patentee should have a right to come to the court, to apply to have the exclusive benefit of the invention, adversely to the rights and interests of the former patentee. It must have been meant to apply to a very different case. You are aware it is discretionary with us, particularly when you have another remedy; you may apply to the Attorney-General for a disclaimer." (1 *Web. P. C.* 555.)

794. *In re* HEURTELOUP'S PATENT. [1836]

Where it appeared, on a petition for confirmation, that part of the patentee's invention formed the subject of an expired French patent, but that it had never been used or known in *England*, otherwise than by a description in a book published in *France*, a copy of which was in the British Museum, notice of the day of hearing was directed to be given to the French patentee, and, on an affidavit that such notice had been sent through the Post Office, directed to Paris, confirmation was recommended. (1 *Web. P. C.* 553.)

795. *In re* ROBINSON'S PATENT, *Ex parte* POW. [1845]

Application for the confirmation of a Scotch patent, for an invention used in England prior to their date, refused, on the

ground that "the act of parliament was meant to meet a totally different case." (5 *Moo. P. C. C.* 65.)

796. *In re* STEAD'S PATENT. [1846]

The petition for confirmation must admit the invalidity of the patent as the ground of the jurisdiction of the Judicial Committee.

A person who desired to have his patent confirmed ought not, before his petition is heard, to bring an action for infringement, as the two proceedings are contradictory; the one admits the invalidity of the patent, the other seeks relief because a valid patent is infringed. (2 *Web. P. C.* 147.)

Dr. Lushington, in delivering judgment, said: "The second section of the statute referred to (5 & 6 Will. 4, c. 83), confers upon the Judicial Committee the discretionary power of advising her Majesty to confirm letters patent in cases where they are satisfied, in the manner required by the enactments of that section, that the patentee believed himself to be the first and original inventor, and that such invention or part thereof had not been publicly and generally used before the date of the letters patent. The intention of the statute was, that the patentee might, if circumstances rendered it fitting, in the judgment of the Judicial Committee, be protected against any prior invention not publicly and generally used, where he had no reason to believe that such prior invention existed. We apprehend that this section must necessarily be construed to confer the power of giving to the patentee that which he did not possess before the passing of the statute, or, in other words, of curing that which before the statute would have constituted an invalidity. If the patent were valid by the law as it existed before the passing of the statute it could hardly be necessary to confirm it. The case to be remedied was not that of a patentee discovering a prior invention wholly unused and wholly unknown up to the date of the letters patent, but it was applicable to the case of a patentee discovering a prior invention so known that the patent might be invalidated on that ground, though not publicly and generally used. The statute was

framed to protect against circumstances which constituted an invalidity, though the patentee had, so far as his knowledge went, every reason to believe himself to be the original inventor." (*Id.* 146.)

797. *In re* CARD'S PATENT. [1848]

Upon an application for a confirmation of letters patent, it was proved, that the patent article was not publicly and generally known prior to the letters patent; but that some persons had systematically used an article, identical with the patent article, for several years prior to the grant of the letters patent, and that the subject of the patent was little more than an application of a well-known article in trade:—Held, that it was not a case to which the statute was intended to apply. Confirmation refused. The patentee must show, that he believed himself the first and original inventor. (6 *Moo. P. C. C.* 207; 2 *Web. P. C.* 161; 12 *Jur.* 507.)

Lord Campbell, in delivering judgment, said: "The discretionary power that is entrusted by the legislature to the Judicial Committee, which we are now asked to exercise, is a very extraordinary power, and ought to be very cautiously exercised. By the law, as it stood prior to the statute 5 & 6 Will. 4, c. 83, it was necessary, for the validity of a patent, that the invention should be new, as well as that it should be useful; and if it could be proved, that the invention had been practised publicly by any person before the letters patent were granted, the patent was invalid. That law led to hardship in many cases, because it often happened that after experiments had been tried, and a certain progress made in the invention, and the experiments proving abortive, they were subsequently abandoned, some other ingenious man, *de novo*, took up the invention, and completed the process, by which a great benefit was conferred upon the community, whereupon he obtained a patent for his invention; but as soon as he began to reap the fruit of his invention, his patent was infringed, and when he brought an action for such infringement, the former abortive experiments were brought up as proof that the invention was

not new. Some doubt existed, in Westminster Hall, whether, if the experiment, although it had been, to a certain degree, successful, had been abandoned, it would vitiate the after-acquired patent; but to remove all doubt upon the subject this enactment was resorted to by the legislature, that, although there may have been a general knowledge of the invention, if it was not actually carried out, and had been abandoned, that such knowledge should not vitiate the patent which perfected and rendered beneficial the original discovery." (6 *Moo. P. C. C.* 212.) "In a case where it appears that an invention has been carried on to a certain degree, and abandoned, the act of parliament may, most beneficially, be acted upon. But their lordships are of opinion, that a case of this sort, where the invention was used before the patent was considered beneficial by those who carried it out, and was proved to be beneficial by the persons so using it, never having been abandoned, but used by them down to the time at which this application is made, is a case to which the act of parliament never was intended to apply, and that, therefore, this application ought to be refused." (*Ib.* 215.)

798. *In re* LAMENAUDE'S PATENT. [1850]

A patent will not be confirmed where the invention has been used in public a few days before the date of the letters patent.

The statute 5 & 6 Will. 4, c. 83, s. 2, applies only to a case of invention abandoned, and not in use at the time of the patent, and which has not been publicly and generally used. The fact of the person, who has publicly used the invention immediately prior to the date of the patent, consenting to the confirmation of the patent, will not induce the Judicial Committee to exercise their discretionary jurisdiction. (2 *Web. P. C.* 164.)

Lord Campbell, in the course of the argument, said: "For years before I left the bar, in almost every patent case there was the plea of no novelty, and then that was supported by going back for many years in order to find some forgotten experiments that had been made. The object of this act was to prevent that being done." (*Ib.* 167.)

Lord Brougham: "It is quite clear that the invention having been used up to the time of the confirmation, did not come within the statute of James, 'which others at the time of issuing out the letters patent did not use.' It was never meant by this section to repeal the statute of James. I go upon the words of the statute without imposing into the case the least personal recollection of the object of the statute, which I have no right to do. I go upon the obvious meaning of the statute. The words are very general, but we must put a reasonable construction upon them." (*Ib.* 164.)

799. *In re* HONIBALL'S PATENT. [1855]

In 1852, the assignee of a patentee obtained an extension of letters patent originally granted in 1838. In 1854, it was determined at a trial at law, in an action for infringement, that the letters patent were invalid by reason of the prior use and sale of the patent article. Upon an application by the assignee of the patentee to the Judicial Committee for a confirmation, under the 2nd sect. of the statute 5 & 6 Will. 4, c. 83, of the new letters patent, it was proved that the patentee was not the first inventor, and that the principle had been discovered ten years before the date of the original patent, but that the invention, though publicly known, had not been generally used at the date of the grant of the original letters patent, and that the patentee had notice not only of the original invention, but of the use of such invention. In such circumstances the Judicial Committee refused to recommend the Crown to confirm the letters patent.

Two conditions are required from a petitioner applying for a confirmation, to establish to the satisfaction of the Judicial Committee: first, that before the date of the letters patent (the subject of the application), the invention was not publicly and generally used; and second, that the grantee of such letters patent believed himself the first and original inventor. (9 *Moo. P. C. C.* 378; 2 *Web. P. C.* 201.)

The Right Hon. Pemberton Leigh, in delivering judgment, said: "It is not very easy to define what is the exact meaning

of the expression ‘publicly and generally used,’ contained in the section. No patent is likely to be taken out for a process or machine already in public and general use in the ordinary sense of those words ; but certainly we cannot consider the use of the invention on board a single ship, however public, or for whatever length of time, as a general user ; and though negative evidence in its nature can hardly be very conclusive, and that produced by the petitioner applies only to a particular firm, we should be inclined to hold, if it were necessary to decide the point, that we were satisfied that the invention had not been generally, though it has been publicly, used at the date of the original letters patent.” (9 *Moo. P. C. C.* 389.) “It appears to us to be clear, on the context of this clause, that the expression ‘first and original inventor’ was intended to mean a person who could claim the merit of the first invention, without reference to the user. But however that may be, we think that, according to the doctrine laid down by Lord Lyndhurst in *Westrupp & Gibbins’ Patent*, a party cannot be permitted to shelter himself under wilful ignorance, but must be fixed with knowledge not only of what he did know, but of that which he would have known if he had made the inquiries which it was incumbent upon him to make.” (*Ib.* 390.)

Effect of,

800. *STEAD v. CAREY.* [1845]

By an act of parliament, reciting that letters patent had been granted to A. ; that the specification was enrolled within six months, instead of being enrolled within four months after the date thereof as required by the letters patent ; that the letters patent contained a proviso for making them void, if they should become vested in, or in trust for more than twelve persons ; and that certain persons had agreed to form themselves into a company for working the patent ; powers were given for the formation of a company, and enabling the patentee to assign the patent to them, or to licence them to work it. A subsequent

section, reciting the non-enrolment of a specification within due time, and that such non-enrolment had arisen from inadvertence and misinformation, and that it was expedient that the patent should be rendered valid to the extent hereinafter mentioned, enacted, that the letters patent should, during the remainder of the term, be considered, deemed, and taken to be as valid and effectual to all intents and purposes as if the specification so enrolled by A., within six months after the date thereof, had been enrolled within four months :—Held, that the confirmation of the patent was unconditional, and was not dependent on the formation of a company. (1 *C. B.* 496; 9 *Jur.* 511; 14 *L. J., C. P.* 177.)

801. *In re* CARD'S PATENT. [1848]

The confirmation of letters patent is absolute and conclusive evidence that the invention is new. (6 *Moo. P. C. C.* 207; 2 *Web. P. C.* 161.)

802. *In re* LAMENAUDE'S PATENT. [1850]

Lord Brougham: "The confirmation granted under the second section is, in fact, the grant of a new patent curing all defects arising from prior use; the other party cannot bring a *scire facias* after it." (2 *Web. P. C.* 165.)

803. *In re* HONIBALL'S PATENT. [1855]

The authority conferred upon the Crown, by sect. 2 of the 5 & 6 Will. 4, c. 83, to confirm letters patent, is discretionary in the Judicial Committee, to recommend or not a confirmation. (9 *Moo. P. C. C.* 378; 2 *Web. P. C.* 201.)

The Right Hon. Pemberton Leigh, in delivering judgment, said: "The power given to the Crown is to provide an extraordinary remedy for extraordinary cases; to supersede the ordinary rules of law at the expense of the public, in favour of an individual, to give force and validity by a *quasi* legislative authority to a grant of monopoly actually void, and to exclude from the use of the invention not only the other subjects of her

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Majesty in *England*, but even the first and original inventor who had actually brought it into public though not into general use, before the first patent was taken out. That this is the effect of a confirmation is perfectly clear, though it appears from Lord Lyndhurst's observations in the case of *Westrupp & Gibbins*, that such was not the intention of the framer of the act, nor its effect as it was originally introduced into, and as it left, the House of Lords. Every judge who has had to consider the effect of this provision has felt, and we entirely share that feeling, that the jurisdiction is one which is to be most cautiously and sparingly exercised." (9 *Moo. P. C. C.* 391.)

The Petition.

804. *In re* LAMENAUDE'S PATENT. [1850]

The name of the first inventor should be mentioned in the petition, if known, and, if the name is not known, it should be so stated; but if the inventor is known, notice should be given to him. (2 *Web. P. C.* 166.)

In re STEAD'S PATENT. [1846] See 796.

Affidavits.

805. *In re* STEAD'S PATENT. [1846]

Two petitions were presented, the second being supplementary to, and stating what had taken place subsequent to the presentation of, the first. The affidavits made by the petitioner in support of the first petition, gave a general history of his invention, of the communication from abroad on which it was founded, and of his attempts to introduce it into this country; and those in support of the second petition stated the proceedings at law which had taken place since presentation of the first petition, the publications adduced at the trial as impeaching the novelty of the invention, and the title of the

petitioner. The counsel for the opponents objected to the affidavits being received as proof of the matters contained in them, the intention being that such affidavits should be received in addition to other evidence, because the applicant having made a good case might be the only person who knew the real case:—Held, that the affidavits were required to show that the petitioner believed certain facts to be true; and that the opponents could prove their own case by other evidence. (2 *Web. P. C.* 143.)

Costs.

806. *In re* WESTRUPP & GIBBINS' PATENT. [1836]

Lord Lyndhurst: "If a party entitled to oppose does come and oppose, and opposes successfully, if we do not give costs we shall discourage persons coming to protect the interests of the public. We have the power to give costs in any matter referred to us, and, sitting here as a Judicial Committee, we can give costs under the general act, not under the Patent Act." (1 *Web. P. C.* 556.)

807. *In re* HONIBALL'S PATENT. [1855]

Opposition to an application for extension or confirmation of letters patent is rather encouraged by this court than otherwise, and upon a successful opposition the opposer's costs will, in general, be allowed. (9 *Moo. P. C. C.* 378; 2 *Web. R.* 201.)

SALE AND ASSIGNMENT OF LETTERS PATENT.

808. CARTWRIGHT *v.* AMATT. [1799]

A. by indenture (reciting that a suit was depending between him and B. respecting certain patents, and that the same could not be assigned without hazard of defeating the suit) granted absolutely the said patents, together with some others, to C., excepting, however, until the determination of the above-mentioned suit, such patents as should be necessary to support A.'s legal title. Then followed a covenant that A., upon the determination of the suit, should assign the excepted patents to C., and that until such assignment A. should stand legally possessed of the same:—Held, that the legal interest in the excepted patents vested in C. upon the determination of the suit, without assignment. (2 *B. & P.* 43; *Dav. P. C.* 240.)

809. HESSE *v.* STEVENSON. [1803]

An act of parliament, empowering a bankrupt patentee, his executors, administrators and assigns, to assign the right under letters patent to a greater number of persons than allowed by the letters patent, and declared to be a public act, does not enable either the bankrupt or his assigns to make a better title than they could before the act.

When a patentee becomes bankrupt, his patent right vests in the assignees. (3 *B. & P.* 565; *Dav. P. C.* 244.)

Lord Alvanley, C. J., in delivering judgment, said: “Next it is contended, that the nature of the property in this patent was such that it did not pass under the assignment; and several cases were cited in support of this proposition. It is said, that although by the assignment every right and interest, and every right of action, as well as right of possession and possibility of interest, is taken out of the bankrupt and vested in the assignees, yet that the fruits of a man's own invention

do not pass. It is true, that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes do not pass, nor could the assignees require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate. But if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass in the same manner as any other property acquired by his personal industry." (3 B. & P. 577.)

810. *Ex parte* GRANGER. [1812]

A patentee, having mortgaged his right under his patent, continued in the *notorious use* of the invention until his bankruptcy. The Lord Chancellor was inclined to think the right passed to the assignees under the statute, but directed a case for the Court of King's Bench, which was never argued. (*Godson on Patents*, 2nd ed. p. 225.)

811. *BLOXAM v. ELSEE*. [1827]

Where an act of parliament secured to certain persons, for a further term, the benefit arising from a patent for making a machine, with a proviso, that it should become void, if they should transfer or assign their interest therein to any persons exceeding the number of five; and two of the patentees became bankrupt:—Held, that the assignment of their interests to their assignees for the benefit of creditors, though the number exceeded twenty, was not within the proviso. (9 D. & R. 215; 6 B. & C. 169; see 15 & 16 Vict. c. 83, s. 36.)

812. *DUVERGIER v. FELLOWS*. H. L. [1830]

Where a bond was given for payment of 10,000*l.*, with a condition that the money should be paid on the obligee's procuring subscriptions for 9,000 shares in a company to be formed of many persons, for the purpose of becoming assignees of a patent, and carrying on the patent process; and the patent

contained a proviso, that it should be void if assigned to more than five persons:—Held, that the obligee must be presumed to know of that proviso, and that as the bond was subject to a condition for the performance of an illegal act, it was void. (10 *C. B.* 826; affirmed in *H. L.*, 1 *C. & F.* 39.)

It was also held in the House of Lords that the plaintiff was equally incapable of recovering on the bond, whether he knew or did not know the terms of the letters patent. (1 *C. & F.* 39.)

813. LOVELL v. HICKS. [1836]

Agreement for the purchase of part of the profits of a patent, which turned out to be a mere bubble, set aside as having been obtained by fraud and misrepresentation, and so much of the purchase-money as had been paid under the agreement ordered to be repaid. (2 *Y. & C.* 46.)

814. M'ALPINE v. MANGNALL. *Ex. Ch.* [1846]

A voluntary assignment by a patentee of letters patent, to trustees for the benefit of creditors, more than twelve in number, is not such an assignment as will avoid the patent. (3 *C. B.* 496; 15 *L. J., C. P.* 298.)

815. PAYNE v. BANNER. *Ch.* [1846]

A patentee agreed to give one-fourth share of a patent to B., in consideration of 50*l.* then paid, and of 150*l.* to be paid in several sums at various times; and of a sum of 300*l.* to be paid by a particular day, to be applied in taking out foreign patents. The 300*l.* was not paid, and the foreign patents were, consequently, not obtained:—Held, that time was the essence of the contract, and that the patentee was entitled to rescind it, notwithstanding he had accepted payment of the other sums at other times than those which were fixed by the agreement. (15 *L. J., Ch.* 227.)

HILL v. MOUNT. [1856] See 302.

816. HALL v. CONDER. *Ex. Ch.* [1857]

By an agreement between the plaintiff and defendants, after reciting that the plaintiff had invented a method for preventing

boiler explosions, and that he had obtained a patent for the use of the same, and that he was desirous of disposing of half his interest in such patent, to which he declared he had full right and title, and that he had applied to the defendants to purchase such half of his interest in such patent, the plaintiff, for certain considerations, agreed to make over, and did accordingly make over, to the defendants the above-mentioned half of the said patent:—Held, that by this agreement the plaintiff did not profess to sell, nor did the defendants profess to buy, a good and indefeasible patent right, but only the moiety of the patent, such as it was; and that, as there was no express or implied warranty of title or quality, it was no answer to an action for the price of the said moiety of the patent, to plead that the invention was wholly worthless, and of no public utility, and not new, and that the plaintiff was not the first and true inventor. (2 *C. B.*, *N. S.* 22; 3 *Jur.*, *N. S.* 366; 26 *L. J.*, *C. P.* 138; affirmed on appeal, 2 *C. B.*, *N. S.* 53; 3 *Jur.*, *N. S.* 963; 26 *L. J.*, *C. P.* 288.)

817. SMITH v. NEALE. [1857]

The defendant made the following written proposal to the plaintiff, who accepted it verbally:—"First, that the patent should be conveyed to myself and any friend of yours, in trust for 'The Ladies' Guild,' subject to the following conditions."

The conditions related to the remuneration of the plaintiff, and the payment of the stamp duty on the patent.

Willes, J., in delivering judgment, said: "Such a contract involves no warranty that the invention was new, or was a manufacture within the statute of James, but merely that her Majesty had granted to the plaintiff the letters patent which she proposed to assign. In short, the defendant in this case, as in *Hall v. Conder*, contracted for the use of the plaintiff's right such as it was, without regard to whether it could be sustained upon litigation or not; and there is nothing unreasonable or uncommon in such a bargain." (2 *C. B.*, *N. S.* 67; 3 *Jur.*, *N. S.* 516; 26 *L. J.*, *C. P.* 143.)

DUNNICLIFF v. MALLETT. [1859] See 984.

818. WALTON v. LAVATER. [1860]

The sale of a moiety of a patent right conveys an interest *pro tanto* in the patent. (8 *C. B.*, *N. S.* 162; 6 *Jur.*, *N. S.* 1251; 29 *L. J.*, *C. P.* 275; 3 *L. T. Rep.*, *N. S.* 272.)

819. KERNOT v. POTTER. Ch. [1861]

P. agreed to purchase from K. a patent for purifying paraffine, and to work it during fourteen years, "in case it could be so long worked at a profit," and to pay a royalty of one-third of the difference between the marked price of crude paraffine and the price it sold at. It turned out, that although it could be worked at a profit, yet deducting the royalty reserved there would be a loss:—Held, that the agreement was at an end. (30 *Beav.* 343.)

820. ELLWOOD v. CHRISTY. [1864]

The executors of a patentee having obtained probate of their testator's will, assigned his patent to another person, but the probate was not registered till after the assignment:—Held, that the assignment was valid. (10 *Jur.*, *N. S.* 1079; 13 *W. R.* 54; 11 *L. T. Rep.*, *N. S.* 342; 17 *C. B.*, *N. S.* 754; 34 *L. J.*, *C. P.* 130.)

821. LEWIN v. BROWN. [1866]

The declaration stated that a petition had been presented by the plaintiffs, at the request of the defendant, for the granting to the defendant of a patent, that the plaintiffs had filed a provisional specification, at their own expense, upon condition that the defendant should complete the specification within six months, and that afterwards it was agreed that the defendant should sell to the plaintiffs his rights in respect of the said patent for the sum of 5*l.*, to be paid by the plaintiffs to the defendant on their having completed, at their own expense, the said patent; that it thereupon became necessary, in order to enable the plaintiffs to complete the said patent in pursuance of the said agreement, that the defendant should sign and seal a complete specification; that the plaintiffs tendered to the defendant a

complete specification for his signature. Breach, that the defendant would not sign it:—Held, that the defendant was bound, under this agreement, to sign the specification. (14 *W. R.* 640.)

822. DAW v. ELEY. Ch. [1867]

A patent was taken out in *France*, in 1858, by A., who, in 1861, obtained letters patent for his invention in *England*. The English patent was assigned by A. to B. In 1866 the French patent was declared void, on the ground of the nonpayment by A. of the fees imposed upon patentees by the French law:—Held, that B., as assignee of the English patent, was bound by the decision respecting the French patent; for, “it is the business of every one who takes an assignment of a foreign patent—having sect. 25 before him—to see that the foreign patent is kept up in its full validity.” (*L. R.*, 3 *Eq.* 496; 36 *L. J.*, Ch. 482.)

823. SMITH v. BUCKINGHAM. [1870]

By an agreement between the plaintiff and defendant, after reciting that the plaintiff had lately invented an improved composition or material to be employed in waterproofing or rendering woven fabrics impervious to moisture, for which he had duly obtained provisional protection, and had obtained a certificate of protection; it was agreed between them for the considerations therein mentioned, and in consideration of a further sum of 350*l.* to be paid on the completion of the necessary specification and grant of the letters patent, to transfer and make over to the defendant all his interest in the invention or improvement thereof, and all benefit to be derived from the provisional protection, or from any letters patent to be thereafter granted for the invention. In an action on this agreement to recover the 350*l.*, the defendant pleaded that the plaintiff had not invented an improved composition or material to be employed in waterproofing or rendering woven fabrics impervious to moisture:—Held, the plea was bad. (18 *W. R.*, 314; 21 *L. T. Rep.*, N. S. 819.)

REGISTRATION.

824. *In re* GREEN'S PATENT. [1857]

A patentee, in 1853, assigned his patent, but the assignees omitted to register it. In 1855 the patentee assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterwards. The court, in 1857, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs, under the 38th sect. of 15 & 16 Vict. c. 83. (24 *Beav.* 145.)

825. CHOLLETT *v.* HOFFMAN. [1857]

To a declaration for the infringement of a patent, brought by an alleged assignee (by deed) of the patent, the defendant pleaded, by denying the assignment, *modo et formâ*. On the trial, it appeared that an instrument of assignment had been executed by the patentee, but that it had not been registered under 15 & 16 Vict. c. 83:—Held, that as, by sect. 35, the original patentee is, until the entry of the registration, to be deemed and taken to be the sole and exclusive proprietor of the patent, the defendant was entitled to a verdict, although the objection was not specified in the notice of objections delivered by him. (7 *Ell. & B.* 686 ; 3 *Jur.*, *N. S.* 935 ; 26 *L. J.*, *Q. B.* 249.)

826. *In re* MOSEY'S PATENT. [1858]

Under the 38th sect. of the 15 & 16 Vict. c. 83, the court can, on motion, expunge an entry fraudulently made in the Register of Proprietors of Patents; it can direct any facts relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them.

A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already

granted a licence, to work and use, to A. B.'s assignment was first registered:—Held, that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register, that the licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered. (25 *Beav.* 581; 6 *W. R.* 612.)

ELLWOOD *v.* CHRISTY. [1864] See 820.

827. *In re* HORSLEY & KNIGHTON'S PATENT. [1869]

The court will, on the motion of the persons aggrieved, correct an entry in the Register of Proprietors of Patents, which purports to affect the right of persons not parties to the deed registered. One of two joint patentees by deed assigned his interest in the patent to a third person, and released to him all the rights of action, &c. against him of both the patentees, and the deed was set out completely in the Register of Proprietors:—Held, that the other patentee was entitled, under the 38th section of the Patent Law Amendment Act, to have the entry struck out. (*L. R.*, 8 *Eq.* 475; 39 *L. J.*, *Ch.* 157.)

There is no right of appeal against an order made by the Master of the Rolls to expunge an entry in the register. (*L. R.*, 4 *Ch.* 784; 17 *W. R.* 1000.)

828. HASSALL *v.* WRIGHT. *Ch.* [1870]

W., a patentee, agreed with H. that H. should be the sole manufacturer under the patent. This agreement was embodied in a deed, which was prepared by the solicitor of W., H. employing no legal adviser. The deed was not registered in accordance with the Patent Law Amendment Act, 1852, s. 35, until after bill filed. Subsequently W. granted a right of manufacture to M. who had full notice of the previous agreement with H. The grant to M. was also unregistered:—Held, that, under the circumstances, W. could not avail himself of an objection based upon the non-registration of the agreement with H., and that as the grant to M. was also unregistered, M. also was not entitled to take the objection. *Semble*, that the subsequent registration had relation back to the date of the agreement. (40 *L. J.*, *Ch.* 145.)

LICENCES AND ROYALTIES.

829. TAYLOR *v.* HARE. [1805]

A., having obtained a patent for an invention of which he supposed himself the inventor, agreed to let B. use it upon payment of a certain annual sum secured by bond; this sum was paid for several years, when B., discovering that A. was not the inventor, but that it was in public use before A. obtained his patent, brought an action for money had and received, to recover back the amount of the annuity paid:—Held, that he could not recover. (1 *B. & P. (N. R.)* 260.)

830. PROTHEROE *v.* MAY. [1839]

The grant of an exclusive licence to use a patent does not invalidate the patent itself, although the patent may be vested in twelve persons; and it is wholly immaterial to its validity, in what number of persons such a licence is vested, whether exclusive or not. Such a licence would not be invalid if the districts or district covered by the licence included the whole extent of the patent. (5 *M. & W.* 675; 1 *Web. P. C.* 414.)

831. CHANTER *v.* LEESE. Ex. Ch. [1839]

By an agreement, not under seal, between the plaintiff and A., B. and C. of the one part, and the defendant of the other part, reciting that the plaintiff had obtained a patent for an improvement in furnaces, and was solely interested in another patent invention; that the plaintiff and A. had obtained a patent for another invention; the plaintiff and B. for another; and the plaintiff and C. for another; it was agreed between the parties, that, for the considerations therein mentioned, it should be lawful for the defendant, *exclusively* to use, manufacture and sell any or all of the said patent inventions, within certain limits,

during the continuance of the several patents, on certain terms specified in the agreement. In an action on this agreement by the plaintiff alone, to enforce one of such terms, the defendant set out the plaintiff's patent for the improvements in furnaces, and pleaded that it was not, at the time of the grant, a new invention, whereby the grant was void, which the plaintiff, at the time of making the agreement, well knew:—Held, that the plea was a bar to the action. (4 *M. & W.* 295; 1 *H. & H.* 224; affirmed on appeal; 5 *M. & W.* 698.) See 848.

832. CHANTER v. DEWHURST. [1844]

Action for the price of a licence granted by the plaintiffs to the defendants. The licence was in writing, but not under seal. The defendants having received the licence, kept it, and used the invention, but, when called upon to pay the price agreed upon, objected to pay for it, on the ground that it was void, as not being under seal. By the terms of the letters patent, all persons were commanded not to make, use or put in practice the said invention, &c. without the licence, consent or agreement of the patentee, his executors, &c. “in writing, under his or their hands and seals, first had and obtained,” upon pain of a contempt of the royal command, and of being answerable to the plaintiffs in damages:—Held, first, that the defendants, having obtained the licence they had bargained for, and kept it, were bound to pay for it; and secondly, that the licence was not void as not being under seal. (12 *M. & W.* 823; 13 *L. J., Exch.* 198.)

833. CHANTER v. JOHNSON. [1845]

Parke, B.: “The licence was rejected at the trial, for want of a stamp, and the question, therefore, arises whether any stamp was necessary. The defendants say the instrument is a deed, and ought to be stamped as such; but that is not so: it does not purport to be sealed and delivered as a deed; it rather resembles an award, or a warrant of a magistrate, which, though under seal, are not deeds.” New trial ordered. (14 *M. & W.* 411.)

834. TIELENS v. HOOPER. [1850]

By indenture, the plaintiff granted to the defendant, for a term of years, the exclusive licence to use a patent upon payment of certain sums by way of royalty. The indenture contained a covenant for payment of the royalty, and also the following:—"And it is hereby agreed that if it shall happen in any year during the continuance of the term that royalties or sums of money hereinbefore covenanted to be paid shall not amount to the sum of 2,000*l.* sterling, then, and in every such case, and as often as the same shall so happen, the defendant shall, within fourteen days after the expiration of any year in which it shall so happen, pay to the plaintiff such a sum of money as with the royalty hereby reserved will amount to 2,000*l.* for that year; *or* if the defendant shall, at any time, make default in payment of such sum of money aforesaid, within the time appointed for payment, then it shall be lawful for the plaintiff, by writing signed by him, and endorsed on the said indenture or duplicate thereof, to declare that the said indenture and the powers and licence thereby granted shall cease and determine:"—Held, that this was not an absolute covenant on the part of the defendant to pay 2,000*l.* a year during the term, but an alternative covenant, enabling the plaintiff to put an end to the licence on non-payment of that sum by the defendant. (5 *Exch.* 830.)

835. WARWICK v. HOOPER. [1850]

The plaintiffs, the assignees of a patent, granted a licence to the defendant to use the patent upon the terms of his paying an annual rent of 2,000*l.*, to be made up at the end of each year, and reserved to themselves the power of determining the licence in the event of default being made in payment of this rent. The defendant failed in paying the rent; but the plaintiffs, notwithstanding, for several years allowed the defendant to use the patent, and received from him a less annual sum than that stipulated. At length, however, they determined the licence, having, subsequently to the expiration of the previous year, received from the defendant payments on the footing of the

reduced rent:—Held, that, by so doing, the plaintiffs had elected not to treat the previous breach as a forfeiture of the licence, and that consequently they were not entitled to an injunction restraining the defendant from using the patent. (3 *Mac. & G.* 60.)

836. BOWER v. HODGES. [1853]

A., the patentee of machinery for making iron pipes, granted by deed to B. and his assigns the exclusive licence to manufacture them, B. paying a royalty of so much for every ton manufactured or sold by him or his assigns, and to account. B. subsequently assigned his interest in the licence to the plaintiff, who transferred it to M. & R. in trust for the defendants; and the defendants covenanted with the plaintiff to perform the covenants made by B. to A. in the first deed. It was held, that the covenant to account was no qualification of the covenants to pay the royalties, but merely auxiliary to it.

Maule, J.: “You cannot say there is any particular form for passing a licence, but licensing a person and his assigns is licensing him and all whom he may licence. . . . A licence is not really assignable. The assignment acts only as an estoppel between the parties.” (22 *L. J., C. P.* 198.)

837. JONES v. LEES. [1856]

A covenant, by a licensee for the residue of a term of fourteen years, of patented improvements in machinery for slubbing fibrous substances, not to make or use any slubbing frames whatever without the invention applied to them, is not void as a covenant in restraint of trade. (1 *H. & N.* 189; 2 *Jur., N. S.* 645; 26 *L. J., Exch.* 9.)

838. SCHLUMBERGER v. LISTER. [1860]

Declaration for the infringement of a patent. Plea, that administrator of the patentee granted a licence to S. and A. to use the patent, who assigned the same to the defendant. Replication on equitable grounds, that the deed of licence was of even date with another deed between the administrator of

the patentee, six other persons and S. and A.; and by the latter deed it was witnessed that S. and A. should not manufacture or sell machines under the licence out of Great Britain and Ireland, and that by another deed between S. and A. of the one part, and the defendant of the other part, the defendant covenanted that he would perform all the covenants in the first deed contained, to be performed on the part of S. and A. The replication then alleged breaches of the covenant by the defendant in making and selling machines out of Great Britain and Ireland. Replication held bad on demurrer. (2 *Ell. & Ell.* 870; 29 *L. J.*, *Q. B.* 157; 6 *Jur.*, *N. S.* 1336; 9 *W. R.* 138; 3 *L. T. Rep.*, *N. S.* 549.)

KERNOT v. POTTER. [1862] See **1227**.

THE GROVER AND BAKER SEWING MACHINE COMPANY v. MILLARD. [1862] See **859**.

839. CROSSLEY v. DIXON. *H. L.* [1863]

D. agreed verbally with C. to be supplied by C. with machines constructed according to patents of which C. was the owner, and to pay royalties for the use of such machines, and for the use of any machines supplied to him by anybody else which embodied the principle of C.'s patent:—Held, that this verbal agreement must be treated as a licence. (10 *H. L. Cas.* 293; 9 *Jur.*, *N. S.* 607; 32 *L. J.*, *Ch.* 617; 11 *W. R.* 716; 8 *L. T. Rep.*, *N. S.* 260.)

840. THOMAS v. HUNT. [1864]

A licence to A. to manufacture a patent article is an authority to his vendees to vend it without the consent of the patentee. (17 *C. B.*, *N. S.* 183.)

841. GOUCHER v. CLAYTON. *Ch.* [1865]

The patentee of an invention for improved beaters for thrashing machines, granted a licence to the defendants, to make, manufacture and sell machines, as described in the specification, for a term of years, and during the same period

to apply the invention to other machines made, or to be made, paying a royalty of 1*l.* for every thrashing machine manufactured by them, and the like sum for every machine made, or to be made, to which the invention should be wholly or in part applied by them; and the defendants covenanted to affix royalty plates to every new and altered machine which should be manufactured or applied by them:—Held, that the defendants were not intended to pay royalty merely on every thrashing machine, but that the true construction of the licence was, that they were to pay on all beaters manufactured by them according to the patent, and applied to machines originally, or by way of renewal. (11 *Jur.*, *N. S.* 462; 13 *L. T. Rep.*, *N. S.* 115.)

842. HENDERSON v. MOSTYN COPPER COMPANY. [1868]

The plaintiff being possessed of a patent, granted to the defendants the exclusive licence to work it in a certain district, by a deed by which the latter covenanted to pay certain royalties, and to give every information the better to enable the patentee to support the letters patent; and the patentee covenanted for quiet enjoyment of the patent by the defendants, and that, “in case any person should work the patented processes, the patentee would, at his own costs, commence and carry on all such actions, &c. as should be necessary to establish the validity of the patent, and to put a stop to the working of the patented processes by such person; and that, in case the patentee should fail or neglect so to establish or maintain the validity of the patent, and to put a stop to the working of the patented processes by such other person, he (the patentee) would not call upon the defendants, nor should the defendants be liable thenceforth to pay any royalty, until the patentee should, by authority of law, or otherwise, have restrained such person from working under the letters patent:”—Held, that the condition for suspension of payment of the royalties did not come into operation until the patentee had notice of an infringement, and until after the lapse of a reasonable time to allow him an opportunity of instituting proceedings to restrain it. (*L. R.*, 3 *C. P.* 202.)

843. KNOWLES v. BOVILL. [1870]

The plaintiff was the holder of a licence to use a patented invention from the patentee. The patentee intending to apply for a prolongation of this patent, and also for a patent for a new invention of a similar description, the plaintiff agreed to give him 150*l.* for the free use for ever of the former patent, as well as for the free use for three years of the new patent which the patentee was about to take out. The money was paid to the patentee, but he died almost immediately afterwards, and in consequence of his death no application was ever made for a renewal of the former patent or the grant of one for the new invention. The plaintiff brought an action against the patentee's executors to recover back the money, on the ground that the consideration for it had totally failed:—Held, that he was entitled to maintain the action on the ground that, on the true construction of the contract between the parties, he had bought the right to have an application for the patents made, not merely the right to have the benefit of it if it should happen to be made, and the consideration had therefore totally failed. (22 *L. T. Rep.*, *N. S.* 70.)

844. BETTS v. WILLMOTT. Ch. [1871]

Where the owner of a patent manufactures and sells the patented article in a foreign country as well as in England, the sale of the article in one country implies a licence to use it in the other. But if he has assigned his patent in either country, the article cannot be sold so as to defeat the rights of the assignee. (*L. R.*, 6 *Ch.* 239; 19 *W. R.* 369.)

845. CLARK v. ADIE. Ch. [1873]

A patentee who grants a licence cannot, without derogating from his grant, publish advertisements and circulars which have the effect of deterring usual customers or the public from dealing with his licensee. (21 *W. R.* 456; affirmed on appeal; 21 *W. R.* 764.)

ESTOPPEL.

846. OLDHAM *v.* LANGMEAD. [Before 1789]

In an action by the assignee of the patentee against the patentee, the latter is estopped from showing that it was not a new invention against his own deed. (Cit. in *Hayne v. Maltby*, 3 *T. R.* 439.)

Lord Kenyon, C. J.: "The patentee has conveyed his interest in the patent to the plaintiff, and yet in violation of his contract he afterwards infringed the plaintiff's right, and then attempted to deny his having had any title to convey; but I was of opinion that he was estopped by his own deed from making that defence." (*Ib.* 441.)

847. HAYNE *v.* MALTBY. [1789]

A., fraudulently asserting that he had a right to a patent machine, covenanted with B. that he should use it in a particular manner, in consideration of which B. covenanted that he would not use any other; in an action by A. on the covenant, B. is not estopped by his covenant from pleading in bar to the action that the invention was not new, or that the patentee was not the inventor; but he may thus show that the patent was void. (3 *T. R.* 438.)

Lord Kenyon, C. J., said: "The facts of this case are shortly these; the plaintiffs, pretending to derive a right under a patent, assigned to the defendant part of that right on certain terms: and notwithstanding the facts now disclosed show that they have no such privilege, they still insist that the defendant shall be bound by his covenant, though the consideration of it is fraudulent and void. This is not to be considered as a covenant to pay a certain sum in gross at all events; but to use a

machine in a particular way, in consideration of the plaintiffs having conferred that interest on the defendant, which they professed to confer by the agreement. Now, in point of conscience, it is impossible that two persons can entertain different ideas upon the subject. But it is said that, though conscience fails, the defendant is estopped in point of law from saying that the plaintiffs had no privilege to confer. But the doctrine of estoppel is not applicable here. . . . In the case of *Oldham v. Langmead*, the patentee has conveyed his interest in the patent to the plaintiff, and yet in violation of his contract he afterwards infringed the plaintiff's right, and then attempted to deny his having had any title to convey: but I was of opinion that he was estopped by his own deed from making that defence. But there is no similarity between that and the present case. Neither does this resemble the case of landlord and tenant; for the tenant is not *at all events* estopped to deny the landlord's title; the estoppel only exists *during the continuance of his occupation*; and if he be ousted by a title paramount, he may plead it." (3 *T. R.* 438; *Dav. P. C.* 156.)

848. *BOWMAN v. TAYLOR.* [1834]

Where a licence to use certain patent machines is granted by indenture, in which it is recited that the grantor has invented the machines, and has obtained letters patent for the sole use of the invention, and enrolled the specification, parties to the deed are estopped from pleading, either that the invention is not a new invention, or that the grantor was not the first inventor, or that no specification was enrolled. (4 *N. & M.* 264; 2 *A. & E.* 278.)

CHANTER v. LEESE. [1839] See 831.

849. *NEILSON v. FOTHERGILL.* Ch. [1841]

Lord Cottenham, L. C.: "The case of *Hayne v. Maltby* appears to me to come to this—that although a party has dealt with the patentee and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot

recover without giving the other party the opportunity of disputing his right, and that if the defendant successfully dispute his right, that notwithstanding he has been dealing under a contract, it is competent to the defendant so to do. That is exactly coming to the point which I put, whether, at law, the party was estopped from disputing the patentee's right, after having once dealt with him as the proprietor of that right; and it appears from the authority of that case, and from the other cases, that from the time of the last payment, if the manufacturer can successfully resist the patent right of the party claiming the rent, that he may do so in answer to an action for the rent for the use of the patent during that year." (1 *Web. P. C.* 290.)

850. BAIRD v. NEILSON. H. L. [1842]

N. obtained a patent for the application of the principle of smelting iron by the use of heated air applied to furnaces. B. obtained a licence from him to use this process, on the payment of 1s. per ton on the iron thus smelted. Disputes, and then litigation, arose between them, and it was agreed by an instrument in writing, dated 11th of November, 1833 (which recited the previous circumstances), that both parties should withdraw their law processes; that,—“in consideration of the present payment of 400*l.* to be accepted by N. in full of 1s. per ton on the whole iron smelted from the erection of B.'s works up to the 11th of November current, and in consideration of the payment of 1s. per ton upon the whole iron which shall be smelted from the 11th of November current until the expiry of the letters patent, by the use of heated air in any of the modes heretofore applied, or in any other mode falling under the said patent,”—N. should grant to B. a licence, which further on in the agreement was described to relate to “the application or use of heated air in any of the modes heretofore practised at B.'s works, or in any other mode falling under the description in the said patent, or in the specification thereof.” N. afterwards instituted a suit to compel B. to perform this agreement. B. instituted a cross suit to suspend N.'s proceedings, on the ground that the process of smelting by heated air, used at B.'s

works, did not fall within the patent:—Held, by the Lords, affirming the decree of the Court of Sessions, that, after this agreement, B. could not set up such a defence to the claim of N. (8 *C. & F.* 726.)

851. CUTLER v. BOWER. [1848]

By an indenture reciting a deed, whereby the plaintiff licensed the defendant to use his patent during a term, paying a certain royalty, and also reciting a subsequent contract of defendant with plaintiff for purchase of half the patent, subject to the former deed but with benefit to defendant of half the royalty, plaintiff, in pursuance of the contract, and in consideration of 2,200*l.* to be paid to him by defendant, assigned the patent to a trustee, subject to the previous indenture, and in trust to apply the sums accruing from licences to use the patent and likewise to apply the royalties, for or under the direction of plaintiff and defendant respectively, in specified proportions, and to stand possessed, as to one moiety of the letters patent, for plaintiff, as to the other, for defendant. Plaintiff covenanted that, for and notwithstanding anything done, &c. by him, the patent was valid, and should be held and enforced by the trustee without lawful let, &c. by plaintiff, or any claiming under him, or by his act or default. And defendant covenanted with plaintiff to pay him the 2,200*l.* by instalments. To a declaration for non-payment of such instalments, defendant pleaded that plaintiff was not the first inventor; by reason whereof the patent, before the supposed breach of covenant, was void. Replication, estoppel:—Held, on general demurrer, that the plea was bad. For,

1. No eviction was stated; and, in fact, the matter pleaded did not go to the whole consideration; since, even if the patent was void, the first executed deed would have bound the defendant, by estoppel, to payment of the royalty; and, by the latter deed, he became entitled to half the royalty.

2. That the covenant to pay the 2,200*l.* was an independent covenant, and capable of being enforced whether the plaintiff's covenants were performed or not. (11 *Q. B.* 973; 17 *L. J.*, *Q. B.* 217; 12 *Jur.* 721.)

852. PIDDING v. FRANKS. [1849]

Where the court directs an action, instead of granting an injunction, against the equitable assignee of the sole licensee of a patent, it will not exact from the defendant any admission as to the validity of the patent. (1 *Mac. & G.* 56.)

853. HILLS v. LAMING. [1853]

By articles of agreement under seal, reciting that letters patent had been granted to the defendant for improvements in purifying gas, and other letters patent had been granted to the plaintiff for an improved mode of manufacturing gas, and that disputes had arisen between the parties as to their respective rights under the letters patent to the use of oxides of iron for the purpose of purifying gas, and that a *scire facias* had been sued out by the plaintiff to repeal the letters patent granted to the defendant, and that another patent for purifying coal gas by oxides of iron had been applied for by the defendant, and that other letters patent had been sued out by the plaintiff; and that in order to put an end to their differences the parties had entered into that agreement: the defendant covenanted with the plaintiff, and the plaintiff agreed, that the defendant should have the exclusive use of the inventions granted to the plaintiff, so far as the same related to the purification of gas by the hydrated oxides of iron, paying therefor certain royalties; that the plaintiff should have the exclusive use of the inventions granted to the defendant so far as the same related to the purification of gas by anhydrous oxides of iron, paying therefor certain royalties; that, for the purpose of that agreement and the determination of the amount of royalties it should be assumed that the defendant was entitled to the exclusive use of anhydrous oxides, and the plaintiff entitled to the exclusive use of hydrous oxides. The agreement also provided, that, in case of any breach of certain stipulations, the party so doing should pay to the other a certain sum as liquidated damages. In an action to recover that sum the defendant pleaded the plaintiff's patents were not valid, that the inventions were not new, and that the plaintiff was not the first inventor:—Held, that the pleas were bad,

inasmuch as the defendant was estopped by the agreement from disputing the validity of the patents. (9 *Exch.* 256; 23 *L. J.*, *Exch.* 60.)

854. LAWES v. PURSER. [1856]

Declaration for money payable by the defendant to the plaintiff, due by agreement, in respect of manure manufactured or sold by the defendant pursuant to the plaintiff's permission, such manure having been manufactured by the use of an invention mentioned in letters patent granted to the plaintiff. Plea, that at the time of the agreement, and since, the letters patent were void; that the defendant was, before and at the time of the agreement, entitled as of right, and without permission of the plaintiff, to use the invention and sell the manure; and there was not any consideration for the agreement:—Held, that the declaration was upon an executed consideration, and that the plea was no answer. (6 *Ell. & B.* 930; 3 *Jur.*, *N. S.* 182; 26 *L. J.*, *Q. B.* 25.)

855. BESSEMAN v. WRIGHT. [1858]

To an action by a patentee upon a licence for the use of his patent, the licensee may not plead that the patent is void for want of utility or novelty, the contract between them not being for the exclusive use of the patent. Crompton, J., said: "I had doubts whether I was right at chambers when I refused leave to add this plea, but now I am satisfied that I was right. In *Chanter v. Leese* the bargain was for an exclusive right, which could not be given; but here the plaintiff only says, as against me you may use this patent; but he says nothing as against the rest of the world. (6 *W. R.* 719.)

856. SMITH v. SCOTT. [1859]

To a declaration by a patentee against a licensee by deed, the defendant is estopped to plead that the said invention was worthless and of no public utility, and was not new as to the public use thereof in England, and that the plaintiff is not the first inventor; and that the defendant never got any benefit under

the deed in regard to the said invention, and, at the time of the making of the deed the plaintiff knew the matters aforesaid and the defendant did not, nor is the plea good as a plea of fraud. (6 *C. B.*, *N. S.* 771; 5 *Jur.*, *N. S.* 1356; 28 *L. J.*, *C. P.* 325.)

857. WALTON v. LAVATER. [1860]

Where, in an action for infringement, the plaintiff is the assignee of a patent taken out by the defendant, the latter is estopped from denying the novelty of the patent. (3 *L. T. Rep.*, *N. S.* 272.)

858. NORTON v. BROOKES. [1861]

If a patentee, in consideration of a royalty, grants to another a licence to use the patent invention, and the latter uses it, he cannot plead, as a defence to an action for the royalty, that the invention was not new, or that the patentee was not the first inventor. (7 *H. & N.* 499; 8 *Jur.*, *N. S.* 155; 10 *W. R.* 111.)

859. THE GROVER & BAKER SEWING MACHINE CO. v. MILLARD. Ch. [1862]

The fact of a patent having been found invalid at law, upon proceedings between the patentee and third parties, is no answer to a suit, based upon the same patent, for an injunction and consequent relief against a licensee who has covenanted to pay royalties, and in selling the invention, contrary to his covenant, without payment of the royalties. (8 *Jur.*, *N. S.* 714.)

860. NEWALL v. ELLIOTT. [1863]

In an action for the infringement of a patent, the plaintiff, to a plea that he was not the first and true inventor, replied, that on another charge by the plaintiff against the defendant of infringement of the same patent, the question was referred to arbitration by consent, and the arbitrator found that the letters patent were not illegal and void:—Held, that the record did not show an estoppel. (9 *Jur.*, *N. S.* 359.)

861. CROSSLEY v. DIXON. Ch. [1863]

While a person is using, under a licence, a patent machine and paying a royalty for its use, or the use of its principle embodied in any other machine, he cannot, in a proceeding against him for non-payment of royalties in respect of the use of another machine alleged to embody the principle of the patent invention, set up as a defence that the patent is not valid. He can only be allowed to contend that the second machine does not embody the principle of the patent. (10 *H. L. Cas.* 293; 9 *Jur.*, *N. S.* 607; 32 *L. J.*, *Ch.* 617; 11 *W. R.* 716; 8 *L. T. Rep.*, *N. S.* 260.)

862. TROTMAN v. WOOD. [1864]

One who makes a patent article under a licence from the inventor, cannot, in an action against him for royalties, set up any objection to the novelty or utility of the invention, or the validity of the specification; but, if the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other and more natural one would make it good, it is competent to him to insist that the latter is the true construction. (16 *C. B.*, *N. S.* 479.)

863. CHAMBERS v. CRICHLEY. Ch. [1864]

Upon the dissolution of a partnership between the plaintiffs and the defendant, the defendant assigned to the plaintiffs all his interest in a patent which formed part of the assets:—Held, that the defendant could not afterwards set up the invalidity of the patent as against the plaintiffs. (33 *Beav.* 274.)

864. DANGERFIELD v. JONES. Ch. [1865]

A licensee, on a bill for an injunction to restrain the infringement of a patent, may, after his licence has been determined, dispute the validity of the patent. (13 *L. T. Rep.*, *N. S.* 142.)

865. GOUCHER v. CLAYTON. Ch. [1865]

Judgment was given by consent before declaration filed in an action by a patentee against the members of a partnership

firm for an infringement, and the defendants immediately took a licence to use the invention. A suit to restrain a subsequent alleged infringement having been brought by the patentee against the defendants at law and two fresh partners:—Held, that the defendants in equity were not estopped by the judgment at law from disputing the validity of the patent. (11 *Jur.*, *N. S.* 107; 34 *L. J.*, *Ch.* 239; 13 *W. R.* 336; 11 *L. T. Rep.*, *N. S.* 732.)

866. AXMANN v. LUND. Ch. [1874]

The plaintiff and defendant had worked in partnership an alleged patent, the property of the defendant:—Held, that the plaintiff by so doing had not debarred himself from disputing the patent after the termination of the partnership. (22 *W. R.* 789.)

JOINT OWNERS OF PATENTS.

BLOXAM *v.* ELSEE. [1827] See 811.

DUVERGIER *v.* FELLOWS. H. L. [1830] See 812.

867. RIDGWAY *v.* PHILIP. [1834]

A., the patentee of an engine, and B. were partners under the firm of A. & Co. C. purchased the licence of erecting such engines in Cornwall. D. contracted with A. & Co. to erect an engine in Cambridgeshire. A. informed D. that B. and C. were his partners, and C., on being applied to, said it was correct. During the making of the engine, C. frequently came to inquire how the work went on. D. sued B. & Co. for a breach of the contract, when C. proved his limited interest in the patent. The jury having found that C. was not a partner, the court refused a new trial. (1 *C. M. & R.* 415; 5 *Tyr.* 131.)

868. LOVELL *v.* HICKS. [1837]

Joint owners of a patent, for a particular process used in carrying on a trade, are answerable *in solido* for the losses occasioned in relation to the patent by the frauds of their co-adventurers. (2 *Y. & C.* 481.)

PROTHEROE *v.* MAY. [1839] See 830.

869. ELGIE *v.* WEBSTER. [1839]

By an agreement in writing, W. agreed with E. to advance him a sum of money for the purpose of manufacturing and perfecting certain inventions; and it was agreed that if the inventions should become of public or private use, W. should be entitled to one third of the profits of the invention. The agreement contained an express promise on the part of E. to repay

the sum of money advanced by W. :—Held, in an action brought by W. to recover the money thus advanced, that this agreement did not constitute a partnership between the parties with respect to that sum. (5 *M. & W.* 518.)

M'ALPINE v. MAGNALL. Ex. Ch. [1846] See 814.

870. *BEWLEY v. HANCOCK.* Ch. [1856]

An agreement was entered into between four persons who were interested in patents and inventions relating to gutta percha, that all patents taken out, or in the course of being taken, or intended to be taken out, or that might at any time thereafter be taken out by any or either of them, or on account of and for the benefit of any or either of them in relation to the preparation and application of gutta percha, or the manufacture of any article therefrom, should be assigned to trustees, and held for their common benefit. Subsequently one of the parties took out a patent for “improvements in apparatus and machinery for giving shape and configuration to plastic substances,” and refused to assign the patent to the trustees, alleging that it was not comprised in the agreement:—Held, that the patent, so far as it related to gutta percha, was subject to the trusts of the agreement, and that it could not be treated as not being so, because it was for machinery which might be applied to the manufacture of articles of gutta percha, and was not for the manufacture of any such articles. (6 *De G., M. & G.* 391; 2 *Jur., N. S.* 289.)

871. *OSBORNE v. JULLION.* [1856]

O. agrees in writing with J. to work certain patents, the property of J., upon an experiment, and a specified result to the satisfaction of O. to be expressed in writing, and the patents to be assigned to O. The experiment is successful, but by reason, as the plaintiff alleges, of the neglect of J., a great loss is incurred; but O. neither expresses this satisfaction in writing, nor calls for an assignment; and after the lapse of several years files a bill for a dissolution of the agreement, on the ground of a *quasi* partnership, and claiming a lien on the patents, for a sale, account, receiver and injunction. A demurrer for want

of equity to such bill allowed in the usual way except as to discovery sought. (4 *W. R.* 767; 26 *L. J.*, *Ch.* 6.)

WALTON *v.* LAVATER. [1860] See 818.

872. HANCOCK *v.* BEWLEY. *Ch.* [1860]

Where a patent is vested in trustees upon trust for several tenants in common or joint tenants, *quære*, whether any one of them is at liberty to work the patent on his own account. (*John.* 601.)

CHAMBERS *v.* CRICHLEY. *Ch.* [1864] See 863.

873. MATHERS *v.* GREEN. *Ch.* [1864-5]

A., B. and C. were co-patentees of an improvement upon a prior invention of which C. was the sole patentee. B. and C. having worked the joint patent:—Held, that, inasmuch as A. could not use the improvement profitably without the consent of C. as owner of the prior patent, A. was entitled to a third of the profits made by B. and C. from the use of the joint patent as an improvement on the prior patent. (34 *L. J.*, *Ch.* 298.)

The above decision of the Master of the Rolls was reversed by the Lord Chancellor (Cranworth) on the ground that there is no principle of law, in the absence of contract, which can prevent any person not prohibited by statute from using any invention whatever; and no implied contract, where several persons jointly obtain letters patent, that no one of them shall use the invention without the consent of the others, or if he does, that he shall use it for their joint benefit. *Semble*, where letters patent have been granted to more than one person, the court will not admit parol evidence to show that the patent is the property of one or more to the exclusion of any of the others. (35 *L. J.*, *Ch.* 1; 11 *Jur.*, *N. S.* 845; 14 *W. R.* 17; 13 *L. T. Rep.*, *N. S.* 420.)

GOUCHER *v.* CLAYTON. *Ch.* [1865] See 865.

LEWIN *v.* BROWN. [1866] See 821.

In re HORSLEY & KNIGHTON'S PATENT. *Ch.* [1869]
See 827.

874. *Ex parte* MACMILLAN, *In re* WHITTAKER. Ch. [1871]

W., being in difficulties, mortgaged to M. certain patents, to secure advances previously made for the purpose of developing the patents, and paid him, out of the proceeds of the patent, 6*l.* a week :—Held, that this payment did not constitute a partnership between W. and M. (24 *L. T. Rep.*, *N. S.* 143.)

AXMANN *v.* LUND. Ch. [1874] See 866.

INFRINGEMENT.

*Generally.***875. GALLOWAY v. BLEADEN.** N. P. [1839]

Tindal, C. J.: An infringement is "a copy made after and agreeing with the principle laid down in the patent." (1 *Web. P. C.* 523.)

876. WALTON v. BATEMAN. N. P. [1842]

The doing any of the acts specified in the prohibitory clauses of the letters patents is an infringement. (1 *Web. P. C.* 616.)

877. MUNTZ v. FOSTER. N. P. [1844]

Tindal, C. J., told the jury, that "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification, which has been enrolled by the plaintiff." (2 *Web. P. C.* 99.)

878. RUSSELL v. LEDSAM. Ex. Ch. [1845]

Parties who use an invention, letters patent for which have expired, before such letters patent have been renewed, are not guilty of infringement. (14 *M. & W.* 574; affirmed in Exch. Ch., 16 *M. & W.* 641.)

879. STEAD v. ANDERSON. [1847]

To prove infringement, it must be shown, that there is a substantial resemblance to the plaintiff's invention, in particulars to which his exclusive right extends. (2 *Web. P. C.* 155.)

880. CROWL v. EDGE. [1850]

Where the enrolled specification of a patent was not identical with the invention for which the patent had been granted, but of a more extensive nature, in an action on the case for infringing the plaintiff's patent in a particular not included in the patent but in the specification, a verdict for the defendant was held right, and the rule for a new trial discharged. (39 *L. O.* 443; *M. Dig.* 194.)

881. CALDWELL v. VANVLISSENGEN. Ch. [1851]

Turner, V.-C., in the course of his judgment, said: "What previous user will invalidate a patent, and what user (if any) can be permitted in contravention of the patent right, are different questions, depending on wholly different considerations; the one upon the extent of previous knowledge, the other upon the effect of the grant." (9 *Hare*, 428; see *sect.* 28 of 15 & 16 *Vict. c.* 83.)

882. UNWIN v. HEATH. H. L. [1855]

Crowder, J.: "For the purpose of considering the question of infringement, the invention must be assumed to be new, and well described in the specification." (25 *L. J.*, *C. P.* 10.)

883. In re BAKEWELL'S PATENT. [1862]

This was an application by the patentee for a prolongation of the term of letters patent. Lord Chelmsford, in delivering judgment, said: "There was a patent granted to Mr. *Bonelli*, which the petitioner asserts to have been an infringement of his patent. Mr. *Bonelli*, it appears, has obtained a private act of parliament, incorporating a company, which has been established for the purpose of carrying out his invention. Their Lordships do not mean to say that this private act of parliament would be actually a bar to any proceedings on the part of Mr. *Bakewell*, supposing the term of the patent were enlarged, for an infringement of the patent by *Bonelli*, but it certainly would interpose very considerable difficulty in the way of such action, and I am not at all aware of any such action

in which a party has obtained a verdict for the infringement of a patent where the party proceeded against has been working that which is said to be an infringement under the authority of an act of parliament." (15 *Moo. P. C. C.* 388.)

884. BETTS v. WILLMOTT. Ch. [1871]

Where a patentee in England has an agency abroad, the sale of the article patented, either abroad or in this country, carries with it the right to use it everywhere, unless such use has been limited by agreement. (*L. R.*, 6 Ch. 239.)

885. SAXBY v. HENNETT. [1873]

Two patents for the same inventions were applied for on the 20th and 23rd July, 1867, respectively. The patent applied for on the 23rd July was sealed before that applied for on the 20th July, but each patent was dated as of the day of application:—Held, that, under the 15 & 16 Vict. c. 83, s. 24, the patents took effect as upon the days on which they were applied for respectively, and therefore acts done by virtue of the patent applied for on the 23rd July were infringements of the patent applied for on the 20th July. (*L. Rep.*, 8 Ex. 210; 42 *L. J.*, Ex. 137; 28 *L. T. Rep.*, N. S. 639.)

886. BANCROFT v. WARDEN. Ch. [1873]

Demurrer to a bill stating that defendants imported barks and sold them to dyers, who used them in infringement of the plaintiff's patent, overruled. (*Romilly's Notes to Cases*, 103.)

By Working and Making.

887. JONES v. PEARCE. N. P. [1832]

Action for the infringement of a patent for an improved method of making carriage wheels on the principle of suspension. A wheel upon the same principle, but of different construction, had been made by Mr. Strutt prior to the date of

the patent. Patteson, J., in summing up the case to the jury, said: "The defendant has constructed a wheel, whose construction is on the suspension principle. That alone would not make it an infringement of the plaintiff's patent, because the suspension principle might be applied in various ways; but if you think it is applied in the same way as according to the plaintiff's patent it is applied, then the want of two or three circumstances in the defendant's wheel, which are contained in the plaintiff's specification, would not prevent the plaintiff's recovering in this action for an infringement of his patent. It would be quite a different thing if it was shown that the defendant had his communication long before with Mr. Strutt, and had taken up Mr. Strutt's invention in Derbyshire, and had constructed something like Mr. Strutt's without any knowledge of the plaintiff's patent, and had actually borrowed it from Mr. Strutt's, which was good for nothing; it would be the hardest possible thing to say that this was an infringement of the plaintiff's patent. . . . The terms of the patent are, 'without leave or licence, make,' &c; now if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement, or as a model." (1 *Web. P. C.* 124.)

888. *MACNAMARA v. HULSE.* N. P. [1842]

If an invention, for which a patent is granted, would, if put into practice, be useful, an action for the infringement of the patent may be maintained, although the plaintiff's invention has never been put into actual use, except by the defendant, when he infringed the patent. (*Car. & M.* 471.)

889. *GIBSON v. BRAND.* [1842]

Tindal, C. J., in delivering judgment, said: "The breach alleged in the declaration is that the defendant infringed the patent, by making and putting in practice the plaintiff's invention; and the evidence is, that he gave an order in England,

which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendant. This is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures to be made, may be well said to have made them himself." (11 *L. J., C. P.* 183; 4 *M. & G.* 196; 1 *Web. P. C.* 631.)

890. MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships." The patentee described his invention as consisting in making the said plates of an "alloy of foreign zinc," and of "best selected copper;" the metals being melted together in certain stated proportions. Tindal, C. J., told the jury that if the defendant had "actually made any small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent." (2 *Web. P. C.* 101.)

891. CALDWELL v. VANVLISSENGEN. Ch. [1851]

The exclusive rights under an English patent will be enforced against foreigners while in *England*, in the same way and to the same extent as it would against British subjects. Therefore, in a case in which the foreign owners of a ship caused to be made in their own country, and attached to their vessel, a steam screw propeller, the manufacture and user of which was unrestrained by law there, but restricted in England by a patent, and afterwards sent the vessel with a cargo for the purpose of trade to *England*, the use of the steam propeller was restrained by injunction while the vessel should be within the waters covered by the English patent. (16 *Jur.* 115; 21 *L. J., Ch.* 97.)

892. SMITH v. DAVIDSON. [1857]

The Lord President said: "This is a case not very common, —one of contemporaneous invention. The jury have found in

effect that the pursuer and defenders were each of them original inventors of improvements in their department of trade,—that their inventions were substantially the same,—and that they were contemporaneous inventors. The pursuer obtained a provisional specification on 14th Nov. 1853, before which time the defender Davidson, acting independently, had perfected his invention. He used his own invention from and after that day. The provisional protection did not, during its currency, disable him or disentitle him from using his own invention, and the question is, whether the giving out of letters patent disentitles him to continue the use of it under pain of being liable as an infringer of the patent It is contended that the defender is still entitled to use his own invention without being liable as an infringer, because the patent could not prevent him doing what he was doing before it was granted, and because at most it could only prevent him using the pursuer's invention, but not his own. These are the grounds on which the argument is maintained, and the case presented to us for decision. The first of these grounds admits of two answers—First, if the 14th Nov. 1853, be taken to be the true and legal date of the letters patent, as I think it must, there was nothing done by Davidson before that date which amounted to use of his invention, and therefore it cannot be a hardship to prevent him doing what he was not doing before that date. Therefore, if he is now to be limited to the condition he was in before the date of the letters patent, that is a condition in which he was *not* using the invention for the purpose of trade. Second, although the use of the invention during the subsistence of the provisional protection does not expose the user to prosecution as an infringer, there is nothing in the statute from which we can infer that it enables him to continue such user after the letters patent are given out. The case of the defenders, therefore, must rest on the other ground, that Davidson was using, not the pursuer's invention, but truly his own invention; and that view is supported by the fact which is found by the jury, that he was an original inventor, that this machine was made by him, and that he was using that machine till the 1st February, 1854. He also founds on an inference to be deduced from the terms of the letters patent,

which limit the monopoly of the pursuer to the use of his own invention. That raises a question of novelty and importance. Cases were put to us of extreme hardship as tests of the principle. An invention, it was said, which had been used by the inventor for a length of time, might be put a stop to by a party taking out letters patent, and therefore, such a result was not to be implied in a grant of monopoly of this kind. In this particular case we are not compelled to deal with a question of that kind, because the use of the machine had not commenced at the date of the letters patent; but still the principle is involved. After all the consideration I have been able to give to this case, I am of opinion that the argument so maintained on the part of Davidson is not sound in law. When a patent is validly granted—is held in law to be a valid patent—then I think that the party who obtains the patent is held to be the owner of that invention described in the letters patent. It is held in law to be his invention. A monopoly of it is given to him as being his invention, because he is the party who has given to the public that invention. He has given it to the public under the condition that he shall obtain a monopoly, and so it comes to be his invention in that sense. The discovery is not the thing the public have an interest in; what they have interest in is that they shall have the benefit of that invention. A party may live and die, taking the knowledge of his invention with him, but the disclosure of the invention and the means by which it shall be put in use, are the conditions on which he obtains a monopoly of it from the public, and the party who comes forward and complies with that condition, being himself the true inventor, gets the right to the monopoly of that invention. It becomes his invention in law. The consequence is that his monopoly must be protected, and although there may be others who have made the discovery, but who have not brought it to the same perfection, and have not made their bargain with the public in regard to it, they cannot disturb the integrity of the monopoly of the party who first makes his bargain with the public. . . . A separate inventor who comes after him does not borrow the invention if he is truly original in his invention. But that will not entitle him to use

such invention against the interests of the patentee ; and if this defender, who was an inventor before the date of the patent, but had not then brought his invention to perfection or made it public, is not entitled to use it merely because he can say he did not take it from the patent, what circumstances would follow ? May not any person take the invention from the defender, using his invention, and not the invention of the patentee, and so the patent may be altogether destroyed by a growth of users springing from this other source of invention ? To allow this, therefore, would be to destroy the validity of the monopoly. I see no ground for the defender's doctrine, from the policy of the statute, from the history of this monopoly, or from the terms of the letters patent. On the contrary I think that the true reading of all is, that by giving the public the benefit of the invention, that invention, and everything that is substantially the same with it, and which was not public before the date of the patent, is the invention of the patentee, and that no person has right to destroy his monopoly by using machinery or improvements substantially the same with his." (19 C. S. 697.)

893. LISTER v. LEATHER. [1857]

Lord Campbell, C. J., in delivering the judgment of court, said : " The patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, without licence, would be an infringement ; but, with licence, that also would be lawful." (8 Ell. & B. 1017.)

894. HILLS v. THE LIVERPOOL UNITED GASLIGHT COMPANY. Ch. [1862]

A patent was granted for an invention for the purification of gas by means of precipitated or hydrated oxides of iron. The specification was held to include such precipitated or hydrated oxides only as were obtained by artificial means. The use of a natural substance, such as bog ochre, containing precipitated

oxide of iron, so long as it was used in its native condition, was held not to be an infringement of the patent; but upon this substance being re-oxidized or renovated in the manner described in the specification, or in any other manner, it was brought into the condition of being one of the plaintiff's patented purifying materials, that is, a hydrated or precipitated oxide artificially obtained, the use of which became an infringement. (32 *L. J.*, *Ch.* 28 ; 9 *Jur.*, *N. S.* 140 ; 7 *L. T. Rep.*, *N. S.* 537.)

895. NEWALL v. ELLIOTT. [1864]

The plaintiff's patent was for "improvements in apparatus employed in laying down submarine electric telegraph wires." The specification, after describing the nature of the apparatus employed, claimed: "First, coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of rings in combination with the cone, as described." The defendants put up on board a ship, in this country, an apparatus consisting of an external cylinder round a coil, and an internal cylinder capable of being so altered as to form a mechanical equivalent to a cone. There was also a ring on board similar to the plaintiff's rings. In this the defendants did no more than they had done before the patent for the purpose of safe carriage; and there was no further evidence that they did it now for any other purpose:—Held, first, that this was no infringement of the patent; secondly, that the patent, being limited to the United Kingdom, the Channel Islands, and the Isle of Man, could not be infringed by any act done on board an English vessel at Malta, or on the high seas. (10 *Jur.*, *N. S.* 954; 13 *W. R.* 11; 10 *L. T. Rep.*, *N. S.* 792.)

Martin, B., in the course of his judgment, said: "I apprehend it is a perfectly clear rule of patent law that when a patent is taken out for a combination, it does not prevent the public from using anything that was used before. A patent for a combination may be a good patent, but if there has been used before any portion of that which constitutes the combination, the public have a perfect right to use it." (10 *Jur.*, *N. S.* 957.)

Bramwell, B.: "If a man fits up on board a ship a part of a machine, and he has the other part there, so that he may apply the whole of the patented machine when he gets out of England, he may infringe the invention." (*Ib.* 958.)

896. GOUCHER v. CLAYTON. Ch. [1865]

Though the manufacture in this country of the several parts of a patented machine, and the exportation of those parts, may not be an infringement of a patent for a new combination of machinery, when the parts exported are old, it is otherwise where the parts exported are new, and are claimed as new. (11 *Jur.*, *N. S.* 462; 13 *L. T. Rep.*, *N. S.* 115.)

897. BETTS v. NEILSON. H. L. [1865-71]

The plaintiff was patentee of a substance for making capsules to cover the mouths of bottles so as to render them air-tight. A brewer in Scotland, to which country the patent did not extend, sent to an English port for shipment to his foreign customers bottles of beer covered with similar capsules made abroad:—Held, that since the capsules, during the time of the bottles being in England, were answering the purpose for which they were intended, of preserving the liquor, there was a user of the invention in England which ought to be restrained by injunction. (6 *N. R.* 221: affirmed by Lords Justices, 11 *Jur.*, *N. S.* 679; 34 *L. J.*, *Ch.* 537; 13 *W. R.* 1028; 3 *De G.*, *J. & S.* 82; 12 *L. T. Rep.*, *N. S.* 719: affirmed on appeal to the Lord Chancellor, *L. Rep.*, 3 *Ch.* 429; 37 *L. J.*, *Ch.* 321; 18 *L. T. Rep.*, *N. S.* 159: affirmed on appeal to the House of Lords, *L. R.*, 5 *H. L.* 1; 40 *L. J.*, *Ch.* 317; 19 *W. R.* 1121.) Wood, V.-C., said he could well conceive a case in which there would be no user in England, as for instance, foreign tools, infringing an English patent, packed up in boxes and lying inert, or transhipped in course of transit in an English harbour. (6 *N. R.* 222.) Turner, L. J., in the course of his judgment, said: "The case of *Caldwell v. Vanvliссengen* may be in some respects distinguishable from the present, but I think that it disposes of the present question. . . . Now, the distinction attempted to be drawn between that case and the present is this, that

in that case there was an active use of the patented article, and here it is said, and I have no doubt truly said, that the use of the patented article is passive and not active. But it does not appear to me that the question whether the user is active or passive can have any bearing on the question whether the patented article is used or not." (3 *De G., J. & S.* 87.) Lord Chelmsford, L. C., said: "I do not appreciate the distinction which was pressed upon me in argument, between an active and a passive use of a thing, and the difference suggested on that ground between this case and that of *Caldwell v. Vanvliessen*." (*L. R.*, 3 *Ch.* 439.) Lord Colonsay, in the course of his judgment in the House of Lords, said: "It might be a question, if a Bavarian merchant shipped beer protected by such capsules, part of a general cargo, in a vessel which merely called at a port in England, whether, while the vessel was in the English port or in the English waters, it would be an infringement of the patent." (*L. R.*, 5 *H. L.* 23.)

898. DIXON v. THE LONDON SMALL ARMS COMPANY. [1875]

The plaintiff was the assignee of several letters patent for "Improvements in breech-loading fire-arms." The defendants, under a contract with the Secretary of State for War, manufactured and delivered, according to the terms of the contract, certain rifles (which were accepted from the defendants by the Secretary at War for the public service), and in so doing infringed the plaintiff's patent:—Held, that the contract being for the sale of articles for the defendant's own profit, and not as manufacturers of them as servants of the Crown, the principle laid down in *Feather v. The Queen* did not apply, and the defendants were liable for the infringement. (*L. R.*, 10 *Q. B.* 130.)

By Vending.

899. MINTER v. WILLIAMS. [1835]

Semble, the mere exposing an article, manufactured by a patent process, for sale is not an infringement of the letters

patent. (1 *Web. P. C.* 135; 5 *Nev. & M.* 647; 4 *Ad. & Ell.* 251; 1 *H. & W.* 585.)

900. GIBSON v. BRAND. N. P. [1841]

Action for the infringement of a patent. The declaration, after the usual averments, assigned as a breach, "that the defendant directly or indirectly made, used, and put in practice the said invention." Tindal, C. J., said to the jury: "If they (the defendants) have themselves sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale may be considered as a using of the invention within the terms of the declaration." (1 *Web. P. C.* 630.)

901. MUNTZ v. FOSTER. N. P. [1844]

The making of a patent article for sale, although it was in fact never sold or even offered for sale, is an infringement. (2 *Web. P. C.* 101.)

902. HIGGS v. GODWIN. [1858]

The invention for which the patent was granted was "treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes." In the specification the patentee said: "for the purpose of precipitating the animal and vegetable matter contained in the sewage water, I prefer to employ hydrate of lime, commonly termed 'slacked lime.'" The patentee claimed "the precipitation of animal and vegetable matter from sewage water by means of the chemical agent hereinbefore described:"—Held, that the defendant, by using the patented process, not with the object of making a saleable mercantile article, but merely to purify the water, did not infringe the plaintiff's patent. (*Ell. Bl. & Ell.* 529; 5 *Jur., N. S.* 97; 27 *L. J., Q. B.* 421.)

903. WALTON v. LAVATER. [1860]

The importation and sale of a patented article is evidence of an infringement. Erle, C. J., in delivering his judgment, said: "The next point contended for is, that there has been no infringement by the defendant, because he had only sold the articles, the sale, moreover, being only a sale of articles imported from abroad. I have heard the arguments of the learned counsel on both sides, derived from the original statute, which uses the words 'working and making,' and from the form of the expression in the letters patent prohibiting the making, using, or putting in practice the invention, and the words granting to the patentee the privilege to 'make, use, exercise and vend.' All these words are capable of some of the constructions which have been contended for; but it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented, or of the infringement, it would be sufficient evidence of infringement that the defendant had imported and sold." (29 *L. J., C. P.* 279.) Keating, J.: "What we have to see is, whether there has been such a use of the article as would constitute an infringement within the meaning of the statute. And it seems to me that the selling an article and converting it into money is about the most effectual use that can well be made of it." (*Id.* 280.) See also *Betts v. Neilson*, 897.

904. OXLEY v. HOLDEN. [1860]

The manufacture of a patent article for the purpose of sale, and offering it for sale, although no sale is actually effected,

is a user of the invention. (8 *C. B.*, *N. S.* 666; 30 *L. J.*, *C. P.* 68; 8 *W. R.* 626; 2 *L. T. Rep.*, *N. S.* 464.)

905. THOMAS v. HUNT. [1864]

A licence to A. to manufacture a patent article is an authority to his vendees to sell it without the consent of the patentee. (17 *C. B.*, *N. S.* 183.)

906. ELMSLIE v. BOURSIER. Ch. [1869]

The importation into this country and sale here, of goods manufactured abroad, by a process patented in this country, is an infringement of the patent. (39 *L. J.*, *Ch.* 328; *L. Rep.*, 9 *Eq.* 217.)

907. BETTS v. WILLMOTT. Ch. [1870]

A patentee cannot maintain a suit against a retail dealer who unwittingly sells articles which are an infringement of his patent, provided such retail dealer gives full information as to the persons from whom he obtained the articles complained of, and promises not to retail any more. (18 *W. R.* 946: affirmed on appeal, *L. Rep.*, 6 *Ch.* 239; 19 *W. R.* 369.)

908. WRIGHT v. HITCHCOCK. [1870]

Held, that the defendants had infringed the plaintiff's patent, by buying and selling in large quantities, articles manufactured by a process which was an infringement of the plaintiff's patent. Upon this point Kelly, C. B., said: "Undoubtedly the statute (21 Jac. 1, c. 3) only authorizes the grant of patents for the exclusive 'working or making' of articles of new manufacture. . . . Now, in the first place, although the statute does not contain the word 'vend,' we may naturally look at the construction put upon the statute by the language of the patents which have been granted for more than two centuries, and which we find expressly give to the patentee the exclusive right of, among other things, using and *vending* the article patented. . . . If it is necessary to decide the point, I am clearly of opinion that if a man takes out a patent for a new manu-

facture, by means of which an article can be made for a price considerably less than by any means theretofore employed, and another buys and sells that article, I do not say upon a single occasion, because each case ought to be determined with reference to its own circumstances, but in the way of his trade, buying and selling the article in large quantities, knowing it to have been manufactured by means of certain machinery, which machinery is *de facto*, though he may not know it, the same as that of the patentee, such buying and selling is an infringement of the patent rights of the patentee." (39 *L. J.*, *Exch.* 103.) Martin, B., said: "I can understand that if a man took out a patent for the manufacture of flour by means of a new apparatus, and the flour produced was the identical thing produced by another mill, then there would be great difficulty in holding a sale of the flour to be an infringement of the patent. But there is here a great improvement in the article manufactured by the machinery; and it was made more quickly and cheaper than before." (*Ib.* 104.) Pigott, B.: "It must be a question for the jury upon the circumstances of the case. If a man bought the flour in large quantities and sold it for a profit, that would go far to show that he was taking the benefit of the use of the manufacture, and was infringing the patented invention. But if he merely bought a small quantity, not knowing where it came from, for his own use, he might not be infringing the patent." (*Ib.* 106.)

*By working or making a new and material part of an
Invention.*

909. HILL v. THOMPSON. [1818]

In a patent for a combination of processes altogether new, leading to one end, any use made of any of the ingredients singly, or any use made of such ingredients in partial combination, some of them being omitted, or any use of all or some of such ingredients in proportion essentially different from those specified, and yet producing a result equally beneficial with the

result obtained by the proportions specified, will not constitute an infringement. (8 *Taunt.* 391; 2 *B. Moo.* 448; 1 *Web. P. C.* 242.)

JONES *v.* PEARCE. N. P. [1832] See 887.

910. GILLET *v.* WILBEY. N. P. [1839]

Coltman, J., in summing up the case to the jury, said: "The plaintiffs must make out to your satisfaction that the whole of the improvements were new, and that some of them had been pirated. It is not necessary that they should use them all, but they must be shown to be all new, and if they are all new, and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." (9 *Car. & P.* 336.)

911. NEWTON *v.* GRAND JUNCTION RAILWAY COMPANY.
[1846]

Pollock, C. B.: "It was argued that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But, in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part, for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement." (5 *Exch.* 334.) Alderson, B.: "If the invention consists of something new and a combination of that with what is old, then, if an individual takes for his own and uses that which is the new part of the patent, that is an infringement of it." (*Id.* 335.)

912. SELLERS v. DICKINSON. [1850]

Pollock, C. B. : "There may be an infringement by using so much of a combination as is material, and it would be a question for the jury whether that used was not substantially the same thing." (5 *Exch.* 324.) "I think it may be laid down as a general proposition (if a general proposition can be laid on a subject applicable to such a variety of matters as patent law—matters, indeed, incommensurable with each other, for the same doctrine which would apply to a medicine would scarcely apply to a new material or a new metal), that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent." (*Ib.* 326.)

913. THE ELECTRIC TELEGRAPH COMPANY v. BRETT.
[1851]

The breaches alleged in the declaration were that the defendant had used and counterfeited the *said invention*; the evidence was, that the defendant had used or counterfeited *part* only. The specification described nine several improvements:—Held, that the declaration, in speaking of the *said invention*, was to be understood as charging the using or counterfeiting of the said *nine* improvements, and that it was sufficiently proved by showing that *one* of them had been used. (10 *C. B.* 838; 15 *Jur.* 579; 20 *L. J., C. P.* 123.)

914. NEWTON v. VAUCHER. [1851]

A. obtained a patent for an improvement in packing hydraulic and other machines, by means of a lining of soft metal, and thereby of rendering certain parts of such machines air and fluid tight. B. afterwards discovered that soft metal had the property of diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact of machines in rapid motion and subject to pressure, and he embodied the

application of that discovery to machines in a patent:—Held, that the application of the soft metal by B. differed essentially from that of A., and that there was no infringement. (6 *Exch.* 859.)

915. SMITH v. THE LONDON AND NORTH WESTERN RAILWAY COMPANY. [1853]

Action for the infringement of a patent for “an improved wheel for carriages of different descriptions.” The patentee stated, in his specification, that the “said improved wheel is manufactured wholly of bar iron, by welding wrought-iron bars together into the form of a wheel, whereby the nave, spokes, and rim, when finished, will consist of one solid piece of malleable iron.” The specification then described the manner in which the invention was carried out. In the claim, the patentee stated that the new invention consisted in the circumstance that the centre boss, or nave, arms, and rim of the said wheel being wholly composed of wrought or malleable iron, “welded into one solid mass, *in manner hereinbefore described.*” The defendants used a wheel, made by welding pieces of wrought iron so as to form a single compact piece of wrought iron; the mode of forming the nave was the same as that in the specification; the mode of forming the rim was different:—Held, that it appearing that the mode of forming the nave was a material, new, and useful part of the invention, the use of it by the defendant was an infringement of the patent. (2 *Ell. & B.* 69; 17 *Jur.* 1071.) Campbell, C. J., in delivering the judgment of the court, said: “Where a patent is for a combination of two, three, or more old inventions, a user of any of them would not be an infringement of the patent; but, where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent.” (2 *Ell. & B.* 76.)

916. MOREWOOD v. TUPPER. [1855]

A patent was taken out for causing sheets of metal to be passed through molten zinc in such a way as to secure their

complete immersion. This was effected by the sheets passing between rollers in contact with metal kept molten in a suitable pot. Another mode was by causing the sheets to be passed under a bar placed below the surface of molten metal, in combination with certain guides. *Quære*, whether a bar alone, when so placed for the purpose of ensuring complete immersion by passing sheets of metal under it, is the proper subject of a patent. *Semle*, per Parke, B., that if the patent is good for the bar alone, the use of the bar by the defendants, though for a purpose different from that of the plaintiff's, is an infringement. (3 C. L. Rep. 718.)

917. BOVILL v. KEYWORTH. [1857]

A patent obtained for a new combination of a blast and an exhaust in connection with a mill, in which only the *lower* stone rotates, is infringed by the use of the same combination in connection with a mill in which the *upper* stone rotates. (7 Ell. & B. 725.) Campbell, C. J., in delivering the judgment of the court, said: "Supposing the patent to be for a combination, consisting of several parts, for one process, we are of opinion that the defendants are liable in this action for having used a material part of the process, which was new, for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process as specified." (*Ib.* 737.)

918. DE LA RUE v. DICKENSON. [1857]

The specification of a patent for an invention of "improvements in the manufacture of envelopes" described a machine in which a piece of paper was held upon a platform whilst the flaps of the envelope were folded, and concluded by claiming "the so arranging machinery that the flaps of envelopes may be folded thereby as herein described:"—Held, that a machine in which the flaps of an envelope were folded might be an infringement of the patent, although the envelope was not held down during the operation of folding.

The specification of a patent for an invention with a similar title described and claimed "the application of gum or cement to the flaps of envelopes by apparatus acting in the manner of surface-printing:"—Held, that an apparatus for applying the gum might be an infringement, although it acted only in part in the manner of surface-printing according to the description contained in the specification. (7 *Ell. & B.* 738; 3 *Jur., N. S.* 841.)

919. FINLAY v. ALLAN. [1857]

An inventor patented improvements on fire-grates, of which the principal feature was an overhanging door of novel construction, causing a double draught. In his specification he claimed as part of the invention secured to him by the patent the "application and use" of a detent link or holder of a peculiar form to retain the door in its position, but which was proved to have been previously used and applied to grates without overhanging doors:—Held, that the use of a similar detent link, when applied to an overhanging door, but which did not produce a double draught, was not an infringement of the patent. (19 *Dec. of Crt. of Sess., 2nd Series*, 1087.)

920. LISTER v. LEATHER. Ex. Ch. [1858]

A valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. (8 *Ell. & B.* 1004: affirmed in Ex. Ch., *Id.* 1031.) Williams, J., in delivering the judgment of the Court of Exchequer Chamber, said: "It was argued before us, on behalf of the appellants, that, if a patent be taken out for a combination of *a*, *b* and *c*, it could not be infringed by using a combination of *b* and *c* only. We are of opinion that the answer to this inquiry turns altogether upon what *a*, *b* and *c* are, how they contribute to the object of the invention, and what relation they bear to each other. Cases may possibly be suggested where the use of *b* and *c* might not be an infringement of the patent; but more

easily cases may be put where the use of *b* and *c* would be an infringement of the patent. Whether in this case it was so or not would depend upon the facts of the case, and may be more a question of fact for the jury than of law for a court of appeal. But the facts are not before us; and we think the court below was right in deciding that the use of a subordinate part of a combination might be an infringement of the patent if the part so used was new (by which we understand new in itself, or in its effects, not merely in its application) and material." (*Ib.* 1033.)

921. THE PATENT BOTTLE ENVELOPE COMPANY *v.* SEYMOUR.
[1858]

The plaintiff obtained a patent for "improvements in the manufacture of cases or envelopes for covering bottles," and in the specification the invention was stated to consist "in an arrangement of apparatus by which lengths of rush, straw or other suitable material may be readily tied together, so as to form cases or covers to protect bottles from breakage when packed." It then proceeded: "For this purpose I take equal lengths of rush, straw or other suitable material, and confine them at one end within a ring or cap, which I then place over the neck end of a mould or mandril, corresponding in form to the bottle for which the case or cover is intended. The mould is fixed to a frame," &c. The defendant made bottle envelopes out of similar materials somewhat differently applied, placing them upon a model of a bottle or mandril, and fastening the material in a manner somewhat like the plaintiff's method:—Held, that the use of the mandril, which was admitted to have been long commonly used for producing given forms of pliable materials, and the application of which to work previously untried materials or to produce new forms, was held not to be the subject of a patent, was not an infringement of the plaintiff's patent. (5 *C. B.*, *N. S.* 164; 5 *Jur.*, *N. S.* 174; 28 *L. J.*, *C. P.* 22.) Willes, J., in delivering the judgment of the court, said: "The infringement of any part of a patent process is actionable, if that part is of itself new and useful, so as that it might be the subject-matter of a patent, and is used by the

infringer to effect the object, or part of the object, proposed by the patentee." (5 *C. B.*, *N. S.* 172.)

922. THOMAS v. FOXWELL. [1858]

Evidence may be admitted of an infringement by an imitation of a material part of a general combination, notwithstanding the disclaimer of the mechanical parts separately, of which the combination consists, and although there be no separate and specific claim in respect of the part imitated, while there are separate and distinct claims in respect of other subordinate combinations. The jury ought not to find for the plaintiff upon the plea of not guilty, unless they are convinced that the defendant has imitated a part of the plaintiff's combination, both substantial and new, and for the same purpose. (5 *Jur.*, *N. S.* 39.)

923. SEED v. HIGGINS. *H. L.* [1860]

The plaintiff claimed by his specification and disclaimer the application of centrifugal force in the particular manner described in the specification. The particular manner described was by the use of "a weight." The defendant employed a machine similar in many respects, but, though using weight, or pressure occasioned by weight, as a force, did not use "a weight:"—Held, that this did not amount to an infringement of the plaintiff's patent. (8 *H. L. Cas.* 551.)

924. M'CORMICK v. GRAY. [1861]

A patent for a reaping machine, the several parts of which are not claimed, is not infringed by the manufacture of the blade or cutter similar to that prescribed in the specification, which does not of itself constitute a machine; but the patent may be infringed by a person who subsequently makes the cutter into a machine which is identical, or an imitation of the plaintiff's machine. (31 *L. J.*, *Ex.* 42; 7 *H. & N.* 25.) Martin, B. (*dubitante*), said: "I think it a very arguable question whether, if a man has invented a machine consisting of several parts, one of which when in the machine effects a

cutting purpose, it would be competent for a manufacturer to manufacture that very part so as to make any person who put it into a machine and sold it, liable to an action for an infringement of the patent." (31 *L. J.*, *Ex.* 47.)

925. LISTER v. EASTWOOD. [1864]

Where a patent is for a combination, a person who takes a new and material part of the combination, but does not apply it to a similar or analogous purpose to that to which it was applied in the patent, does not infringe the patent. (9 *L. T. Rep.*, *N. S.* 766.)

GOUCHER v. CLAYTON. Ch. [1865] See **896**.

926. WHITE v. FENN. [1867]

If a patent be taken out for an invention by means of a combination, the use of a subordinate part of the combination is no infringement of the patent, unless such part is new and material. (15 *W. R.* 348; 15 *L. T. Rep.*, *N. S.* 505.)

927. PARKES v. STEVENS. Ch. [1869]

Action for the infringement of a patent for "improvements in the manufacture of railway station and other lamps." The specification declared the invention to consist in the production of "a glaze lamp, the frame of which shall throw little or no shadow, and yet at the same time possess the requisite strength, and also facilities for lighting and cleaning." The patentee claimed only "the arrangement and combination of parts hereinafter described and represented in the drawings:"—Held, that the use by the defendant of a sliding spherical door, which, although its advantages were altogether collateral to the objects of the invention, was a feature in the plaintiff's lamps, and described in his specification, was no infringement of the plaintiff's patent. (*L. R.*, 8 *Eq.* 358; 38 *L. J.*, *Ch.* 627.) Sir W. M. James, V.-C.: "The patent being for the arrangement and combination of parts so as to form an entire lamp, and not being for, or claiming to be for, any particular part, the last question arises, is the introduction into a lamp, which is not alleged in any other respect to have adopted any part

of the plaintiff's arrangement and combination, of a sliding door an infringement? The plaintiff's counsel have contended that it is, on the authority of the case of *Lister v. Leather*. The authority of that case has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination. The marginal note, if read hastily, is calculated to give some colour to that contention. But if the judgment be read, it will be found to give no warrant whatever for such, I must call it, baseless notion. The law is summed up thus: The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—is it really and substantially a part of the invention?" (*L. R.*, 8 *Eq.* 366.) His lordship, having held that the substitution of the sliding door in question would not in itself support a patent, continued: "To say that a patent for an entire combination is a valid patent for a part, when that part would not have itself been patentable, is, in my judgment, a *reductio ad absurdum* of the supposed principle of *Lister v. Leather*." (*Ib.* 368.) Judgment affirmed on appeal. (*L. Rep.*, 5 *Ch.* 36.)

Hatherley, L. C., however, said: "If this door was plainly and manifestly a new part, forming part of the whole combination, it ought not to be taken." (*Ib.* 39.)

928. *WRIGHT v. HITCHCOCK.* [1870]

The plaintiff obtained a patent "for the invention of improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The specification described the invention as relating "to a peculiar manufacture of frills, ruffles, or trimmings, and to a peculiar combination of mechanism to be applied to a sewing machine for producing the same." The specification described how the fabric was folded or crimped

by a reciprocating knife, and the folds stitched by a sewing machine. The patentee claimed—"First, the general construction, arrangement and combination of machinery, apparatus, or means for producing crimps or plaited frills or trimmings in a sewing machine, as hereinbefore described. Secondly, the application and use of a reciprocating knife for crimping fabrics in a sewing machine, substantially as hereinbefore described. Thirdly, the peculiar manufacture of crimped or plaited frills or trimmings, as hereinbefore described and illustrated by figure 8 of the drawings:"—Held, first, that the essential improvement, introduced by the plaintiff, was the use of a reciprocating knife, and that the patent did not apply simply to its use in combination with a sewing machine, and therefore, that the use of the reciprocating knife, separately from a sewing machine, was an infringement of the patent. (*L. R.*, 5 *Ex.* 37; 39 *L. J.*, *Exch.* 97.)

929. CANNINGTON v. NUTTALL. H. L. [1871]

Per Lord Westbury: If there is a patent for a combination of machinery, originally directed to one purpose, and a person afterwards adopts that combination in order to make it minister to another and additional purpose, his doing so constitutes an infringement of the patent. (*L. Rep.*, 5 *H. L.* 205.)

Colourable Imitation—Equivalent—Evasion.

930. BOVILL v. MOORE. N. P. [1816]

A person who uses the same means in substance as a patentee of a machine, though the form of the machine be different, commits an infringement. It will be the same in substance if the principle be the same in effect. Referring to this, Gibbs, C. J., said: "I remember that that was the expedient used by a man in Cornwall, who endeavoured to pirate the steam-engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watts':—where you looked for the head, you found the feet, and where you looked for the feet, you found the head; but it turned out that he had taken

the principle of Boulton and Watts' engine." (*Dav. P. C.* 405.)

931. HILL v. THOMPSON. [1818]

Dallas, J., delivering the judgment of the Court of Common Pleas, said: "A slight departure from the specification for the purpose of evasion only, would, of course, be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the defendant has, or has not, been essentially or substantially different." (1 *Web. P. C.* 242; 8 *Taunt.* 391; 2 *B. Moore*, 448.)

932. FORSYTH v. RIVIERE. N. P. [1819]

Action for the infringement of a patent for the application of detonating powder to the discharge of firearms. Drawings were annexed to the specification "exhibiting several constructions (of locks) which may be made and adopted, in conformity to the foregoing plan and principles, out of an endless variety which the subject admits of." The defendant applied the principle of the invention by using a lock of a different construction to any shown in the annexed drawings. Verdict for the plaintiff. (1 *Web. P. C.* 97; 1 *Carp. P. C.* 401.)

933. WEBSTER v. UTTER. [1824]

Action for the infringement of a patent for an improvement on the patent percussion gun-lock, by the addition of a bolt, sliding or moving in a groove, by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer; the defendant's lock had a spring in the bolt, and the jury, upon the evidence of mechanics that a spring in a bolt was the same thing as a bolt sliding in a groove, found that there had been an infringement. (*Gods. Pat. Law*, 232.)

934. R. v. LISTER. [1826]

The application of steam to heat iron rollers is an infringement of a patent in which hot irons were inserted into hollow rollers, the final process in both being the same, viz., the applying heat to the fibres of wool during the operation of

spinning it, by making the slivers pass between the rollers so heated. (*Web. P. L.* 80.)

935. COCHRANE v. BRAITHWAITE. N. P. [1830]

The essential part of an invention being that a necessary degree of compression should be produced in a quantity of air : —Held, that if this could be effected by narrowing the outlet as well as by a weighted valve, both were covered by the words “any other known means of producing the required resistance.” (3 *Lond. Jour., C. S.* 42.)

JONES v. PEARCE. N. P. [1832] See **887**.

936. MINTER v. WELLS. N. P. [1834]

The invention claimed being the application of the self-adjusting leverage to the back and seat of a chair, any combination of that to the same subject is an infringement. (1 *Web. P. C.* 130.)

937. RUSSELL v. COWLEY. N. P. [1834]

The specification having described the invention to consist in welding iron in the manufacture of tubes by circular pressure through dies or holes, the welding produced by passing the iron through grooved rollers, though not so perfect, is an infringement. (1 *Web. P. C.* 463.)

938. MORGAN v. SEAWARD. N. P. [1836]

Alderson, B., in summing up the case to the jury, said : “Upon that subject (infringement) the question would be simply, whether the defendant’s machine was only colourably different, that is, whether it differed merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee. . . . You are to look to the substance and not to the mere form, and if it is in substance an infringement, you ought to find that it is so. If in principle it is not the same, but really different, then the defendants cannot be said to have infringed the patent.” (1 *Web. P. C.* 171.)

939. JUPE v. PRATT. [1837]

Alderson, B. : “ You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention.” (1 *Web. P. C.* 146.)

940. WALTON v. POTTER. N. P. [1841]

A specious variation in form, or ingenious alteration in the mode of adaptation, is an infringement of a patent. Tindal, C. J., in summing up the case to the jury, said: “ Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, to obtain either a patent for it himself or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right; and therefore, what you have to look at upon the present occasion is, not simply whether in form or in circumstances, that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff’s patent, but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff’s invention in order to make that fabric, or to make that article which they have sold in the way of their trade; whether, in order to make that, they have availed themselves of the invention of the plaintiff.” (1 *Web. P. C.* 586.)

941. NEILSON v. HARFORD. N. P. [1841]

Action for the infringement of a patent for the improved application of air to produce heat in furnaces. Parke, B., told the jury that if the invention consisted, as claimed by the plaintiff, in applying the air, heated while *in transitu*, then,

however great the improvement which the defendant's apparatus for accomplishing that object may be on that described in the specification, it is no less an infringement. (1 *Web. P. C.* 310.)

942. WALTON v. BATEMAN. N. P. [1842]

Cresswell, J., in speaking of the plaintiff's invention, said: "The defendants are not to resemble or counterfeit; they are not to make any addition to, or any subtraction from, it; availing themselves of that which is in truth the subject-matter of his patent; so as by such alteration to pretend that they are the true inventors of that article." (1 *Web. P. C.* 616.)

943. MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottom of ships." The patentee described his invention as consisting in making the said plates of an alloy of "foreign zinc," and of "best selected copper;" the metals being melted together in certain stated proportions. Tindal, C. J., told the jury that "although the patent describes the copper must be of the purest quality, yet, if persons could take an inferior kind of copper, and by dressing it up, and by some particular way of melting and refining it, give it exactly the same effect as the best kind of copper would have done, it must be for you to say whether in that case they intended to imitate and to evade the patent which the other party had granted to him." (2 *Web. P. C.* 101.)

Lord Lyndhurst, L. C., in delivering judgment upon the same point in the Court of Chancery, said: "The analysis proves that that compound (the metal manufactured by the defendants) consists, not of ordinary copper and zinc, but of those minerals in their greatest purity, and in the proportions recommended in the plaintiff's specification. If they were originally combined in this state the evasion is plain and direct. If they were purified in the course of this process, this, I think, would constitute a colourable evasion of the plaintiff's invention." (*Ib.* 95.)

944. HEATH v. UNWIN. [1845]

Parke, B., in delivering the judgment of the court, said : “ There is no doubt, we think, if a defendant substitutes for a part of a plaintiff’s invention some well-known equivalent, whether chemical or mechanical, he would probably be considered as only making a colourable variation.” (2 *Web. P. C.* 227.)

945. RUSSELL v. LEDSAM. [1845]

Letters patent may be infringed by a method which is an improvement upon the patentee’s invention, provided the two methods are, in a material part, the same. (14 *M. & W.* 580.)

946. GAMBLE v. KURTZ. [1846]

Action for the infringement of a patent for “ improvements in apparatus for the manufacture of sulphate of soda, &c.” The plaintiff, in his claim, said : “ I do not claim the exclusive use of iron retorts, but I do claim, as my invention, iron retorts worked in connection with each other, as above described.” The defendant had used two chambers, one of iron, and one of brick, connected by an opening through which the material could be pushed from one into the other :—Held, that there was an infringement. (3 *C. B.* 425.) Coltman, J., delivering the judgment of the Court of Common Pleas, said : “ The essence of the plaintiff’s improvement in making sulphate of soda was the use of two chambers, with separate furnaces, for the two stages of the process ; so that both could be kept in action at the same time, at the different temperature required for each stage ; and that principle is equally acted upon, and the same advantage gained, whether both chambers are of iron, or one is of iron and one of brick. The material of which the chambers are composed not being of the essence of the invention claimed, the patent right might be evaded, although the chambers used by the defendant were not of the material mentioned in the plaintiff’s specification.” (*Ib.* 435.)

947. STEAD v. ANDERSON. [1847]

The use of the plaintiff’s invention with slight immaterial

variations to make a colourable difference, or for any other purpose, is an evasion of the patent. (2 *Web. P. C.* 156.)

948. BARKER v. GRACE. [1847]

The specification of a patent for "improvements in the process of finishing hosiery and other goods manufactured from lamb's wool, &c.," stated the invention to consist in submitting hosiery and other similar goods to the finishing process of a *press* heated by steam, &c., *in the manner hereinafter mentioned*. A description was then given, by letters, of a drawing which represented a press, which consisted of a box heated by steam, up to which another box similarly heated was to be pressed by means of hydraulic pressure, or by screws, or other well-known means. After describing the method of pressing the goods between these hot boxes, the specification concluded by confining the inventor's claim to the process *as above described*:—Held, that a method of finishing hosiery goods, by passing them through heated *rollers*, was not included in this patent, and therefore was no infringement of it. (1 *Exch.* 339; 17 *L. J., Ex.* 122.)

949. STEVENS v. KEATING. N. P. [1847]

Action for the infringement of a patent for the manufacture of cements. The specification states the invention to consist in producing certain hard cements of the combination of the powder of gypsum, powder of limestone and chalk, with other materials, such combinations being (subsequent to the mixing) submitted to heat. The specification then describes the method of making cement from gypsum, in the course of which alkali (for instance, best American pearlash) is to be used, and is to be neutralized with an acid (sulphuric acid is stated to be the best); the result is to be subjected to heat. The patentee claimed "the processes of mixing the powdered materials, alkalies, and acids, as hereinabove described, &c." The defendant manufactured cement by combining gypsum with borax, and subjecting the whole to heat. It was in evidence that borax is composed of an acid and an alkali:—Held, by

Pollock, C. B., that there was sufficient evidence of infringement. (2 *Web. P. C.* 181.) His lordship told the jury that “if it had turned out that they (the defendants) had, by the use of borax, produced a substance very superior indeed, I think it would have been a fair question for the jury to consider, whether that was a colourable imitation or evasion, or whether it was a person travelling in his own direction, and making discoveries in the field that was not closed against him.” (*Ib.* 185.)

950. THE ELECTRIC TELEGRAPH COMPANY v. BRETT. [1851]

Action for the infringement of a patent “for improvements in giving signals and sounding alarms in distant places, by means of electric currents transmitted through *metallic circuits*.” The defendant arrived at the same result by using a circuit not *wholly* or continuously metallic throughout, but by using the earth, to an extent nearly amounting to the half, as the connecting medium between two portions of the metal. It appeared in evidence, that after the grant of the letters patent, it had been discovered that a large portion of the wire through which the electric current returned to the battery might be dispensed with by plunging into the earth the two ends of wire which would have been joined by the parts left out, the electric current passing from one end of the wire to the other as effectually as if a continuity of wire had been kept up:—Held, that though a circuit upon this principle would not be *wholly metallic*, yet, inasmuch as it was so in all that part which formed the substance of the patentees’ claim, viz., that part which gave the signals, it amounted to an infringement of the plaintiffs’ patent. (10 *C. B.* 838; 15 *Jur.* 579; 20 *L. J., C. P.* 123.)

951. HANCOCK v. MOULTON. Ch. [1852]

On an application to the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanized or cured caoutchouc, alleged to be an infringement of the plaintiffs’ patent, it appeared that this patent was for obtaining a certain useful product by subjecting a mixture of sulphur and caoutchouc

to heat. The mixture was first made mechanically, and then, by the operation of heat, the character of the caoutchouc was changed, so that it ceased to be liable to stiffen from cold. It was not decomposed by heat, and it was improved in elasticity. The patent extended to the incorporation of sulphur, and of sulphur only, with the caoutchouc by means of heat. The defendant subsequently obtained a patent for the combination of hyposulphate of lead and artificial sulphuret of lead with caoutchouc; that combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiffs' invention. Turner, V.-C.: "Assuming the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confine their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. But it was alleged by the plaintiffs that the materials were not in truth different, or at least that the materials which produce the result are the same. It was said that the hyposulphate and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that those parts being decomposed by *heat*, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent." (*Johnson's Patentee's Manual*, 3rd ed. p. 208.)

952. BATEMAN v. GRAY. N. P. [1853]

Action for the infringement of a patent for "certain improvements in valves or plugs for the passage of water or other fluids."

Martin, B., in summing up to the jury, said: "If a person takes an invention of this kind, and makes one like it, that is an infringement. It is my duty to tell you that the law will not permit a person to take an article that has been patented

and to give a substitute in place of it for the purpose of effecting the same end, by the use of equivalents, using the skill and knowledge which he may possess to evade the patent. If you believe that the defendant's instrument, though he might have employed skill and knowledge upon it, was taken by him substantially from the plaintiff's, and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiff's, it is my duty to tell you that that is an infringement of the patent. If that were not the law no patent would be safe, for a patentee is forced to produce to the public a specification of his invention, and he has had no opportunity of testing it so as to point out every application of it for public use. If it were permitted to persons of ingenuity to substitute in lieu of the patent some equivalent, it would be useless to grant patents of this kind, for an ingenious man could at any time infringe them by adopting other and possibly better means than those specified." (*Macr. P. C.* 102.)

953. UNWIN v. HEATH. H. L. [1855]

A. obtained a patent for certain improvements in the manufacture of iron and steel. The specification described the invention as consisting in "the use of carburet of manganese in any process whereby iron is converted into cast steel," and directed the unfused carburet of manganese to be put into the pot containing the steel in a fused state. The patentee claimed as his invention "the use of carburet of manganese in any process for the conversion of iron into cast steel." B. manufactured cast steel by placing oxide of manganese and carbonaceous matter into the pot at the same moment as the steel. Evidence was given that carburet of manganese would be formed by the combination of these substances before the steel was melted. They produced the same effect upon the steel as the carburet of manganese, at a cheaper rate. This method of producing the effect was not known at the time of taking out the patent:—Held, that this was a new invention, and not an infringement of

the patent. (5 *H. L. Cas.* 505; 16 *C. B.* 713; 25 *L. J., C. P.* 8.)

Crompton, J., in delivering judgment in the Exchequer Chamber, said: "The discovery of the new mode of making the carburet in the pot, in the course of the process, so as to be ready to alloy with the steel in a subsequent part of the process, may have been a discovery and an improvement on the plaintiff's invention, for which a patent might perhaps have been taken out, and, if taken out by a stranger, the plaintiff could not have used the new method without infringing the patent for the improvement. On the other hand, the new method could not in such case have been carried on without infringing the plaintiff's patent, if, as I think, it was an improved and neater mode of bringing the two substances together, being a use of carburet in the state of carburet in the manufacture of steel." (22 *L. J., C. P.* 10.)

Erle, J., delivering judgment in the same court, said: "I am of opinion that a patent for the use of a substance in a process is infringed by the use of a chemical equivalent for that substance, known to be so at the time of the use, if used for the purpose of taking the benefit of the patent, and of making a colourable variation therefrom. Taking the instance put in the argument in this case in the Exchequer, if the patent was for the use of soda in a process, and by subsequent analysis sodium and oxygen were discovered to be the elements of soda, the use of sodium and oxygen in the patented process, for the purpose of being equivalent to soda in that process, would appear to me to be an infringement, although the analysis of soda was subsequent to the patent." (*Ib.* 12.)

Coleridge, J., in delivering judgment in the same court, said: "There can be no doubt, I think, that an equivalent has been used. If that equivalent were known at the date of the specification to the plaintiff or ordinary chemists—those, I mean, who would bring to the reading of the specification such knowledge as must be presumed in those to whom the patent must be taken to be addressed—then it is within the specification, and the use of it is an infringement. If not, the contrary conclusion follows, and the use of it is an improvement, in virtue

of a new discovery. . . . Whether the equivalent be in its nature near to or remote from the thing itself, seems to be in principle wholly immaterial, and equally so that the one should be so nearly identical with the other, as that the one should be the component parts and the other the composite substance." (*Id.* 13.)

The judges, in answering the question put to them by the House of Lords, differed as to the question of infringement.

Crowder, J.: "The process of the plaintiff in error is an improvement upon the invention of the defendant in error (the patentee) while at the same time it is an infringement of his patent." (25 *L. J., C. P.* 11.)

Crompton, J.: "I do not agree with the argument for the plaintiff in error, that the question of infringement can depend on whether the mode of working alleged to be an infringement was, or was not, known to the patentee, or to those skilled in the particular matter at the time of the specification. . . . If a new process, of which he (the patentee) and all others were ignorant at the time of the specification, is found out afterwards, the exercise of such new process may be an infringement, provided that it is substantially the same with or includes the patented invention. An improved method of doing in effect the same thing may well be an infringement of the patent, though not known at the time of the specification. . . . It was said that what was done in the present case was an equivalent merely for what was pointed out in the patent and specification, that all known equivalents must be expressly or impliedly specified, that the alleged equivalent in the present case must be assumed to have been unknown at the date of the specification, and that it must be treated as a new discovery not within the range of the patent, and excluded from the specification, and, therefore, not an infringement. Such an argument could only, in my opinion, be of any weight in cases where the supposed equivalent is something really different from the thing itself, as if in the present case the alleged infringement had been by using, instead of the carburet of manganese, one or more substances which, alone or united, though not being carburet of manganese, would have had the same effect in making

the improved steel,—the use of such different things producing the same effect, whether operating in the same or a different manner, might be the use of things out of the patent, and might properly be called the use of an equivalent.” (*Ib.* 11.)

Williams, J.: “ Though the use of a chemical or mechanical substitute, which is a known equivalent to the thing pointed out by the specification and *claimed as the invention*, amounts to an infringement of the patent, yet if the equivalent were not known to be so at the time of the patent and specification, the use of it is no infringement. . . . If a patent is taken out for *the application of a principle*, coupled with a mode of carrying the principle into effect, the patentee is entitled to protection from all other modes of doing so, whether known or not known at the time of the specification.” (*Ib.* 13.)

Erle, J.: “ I am of opinion that a patent for the use of a substance in a process is infringed by the use of the elements of that substance known to be equivalent thereto *at the time of the use*, if used for the purpose of taking the benefit of the patent and of making a colourable variation therefrom. . . . If the discovery had been made after the patent, that carbon and manganese were elements of the carburet, equivalent to the carburet of manganese in the patented process, the use of those elements in that process for the purpose of being equivalent to the carburet, would, in my judgment, be a colourable variation and an infringement.” (*Ib.* 15.)

954. BOVILL v. PIMM. [1856]

In 1844, G. obtained a patent for “ improvements in grinding wheat and other grains.” He described as his invention “ the forcing and distributing of atmospheric air from the eye or centre of mill-stones, for the purpose of cooling the grain during the process of grinding ;” this was effected by an air-box placed below the mill-stones, into which air was forced by the rapid rotation of a fan or blower, which caused a current of air perpendicular to the axis of the fan ; and the air was conducted by a pipe through the eye of the lower stone to the centre of the two stones, and there distributed between them by an apparatus provided with fans or arms. In 1846, the plaintiff

obtained a patent for “improvements in manufacturing wheat and other grain into meal and flour.” His invention consisted in the application of ventilating vanes or screws at the centre of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current of air parallel to the axis of the vane, was attached externally to the eye of the upper mill-stone; the screw vane being set in rapid motion, the air was compelled to pass through the eye into the centre of the two stones, and so find its way out between them. In 1851, the defendant obtained a patent for “improvements in grinding wheat,” and his plan was to remove from the centre of both stones a large circular portion of each, and in this space, opposite to the separation of the two stones, to place a fan or blower, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones:—Held, that the defendant’s invention was no infringement of the plaintiff’s, but that each was a new method of accomplishing a well-known object, viz., the cooling grinding substances by the common principle of obtaining a current of air by a rotating vane. (11 *Exch.* 718.)

Pollock, C. B., in delivering the judgment of the court, said: “Where a subject is not new, as this certainly was not, viz., ‘the cooling of substances undergoing the process of grinding’ (which had been long known to be a desideratum in grinding, and to effect which various contrivances had been adopted, and several, if not many, patents taken out), any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase.” (*Ib.* 739.)

955. SIMPSON v. HOLLIDAY. Ch. [1864]

If a patentee claims as his invention the mixing of two chemical substances, and boiling them together, to produce a certain result; and the same result is arrived at by mixing the two substances together in the presence of a third body, without

boiling, that would be an infringement. (20 *Newt. Lon. Jour.*, N. S. 111.)

956. NEEDHAM v. OXLEY. Ch. [1865]

Where a patentee has been led up to the invention of his patented machine, by an idea thrown out by a previous patentee of a machine for the same purpose, but arrives at a similar result by another and different mode, there is no infringement. (21 *Newt. Lon. Jour.*, N. S. 300.)

DAW v. ELEY. Ch. [1865] See **114.**

957. CURTIS v. PLATT. H. L. [1866]

Held, affirming the judgment of the Lord Chancellor, that a patent for an entire combination is not infringed by a different combination, for the same object, of the same elements, though important, or of equivalents for them, if not a mere colourable evasion or imitation. The principle which protects a patentee against the use by others of mechanical equivalents is inapplicable to a case where the whole invention depends entirely on the particular machinery by means of which a well-known object is attained. (35 *L. J.*, Ch. 852.) The Lord Chancellor, in delivering his judgment in the court below, said: "If the invention be, as I have already described, nothing in the world more than a particular means to attain to a given result which is perfectly well known, then the invention is for the means, and you can no more prevent the invention of one distinct set of means being interfered with—you can no more say that it interferes with the invention of another, than you could say originally that there ought not to be patents granted for the invention of distinct means to an end. I would illustrate it familiarly by this kind of example: If we suppose a patent for a ladder to go down a pit, that patent may be made to comprehend all ladders, whether constructed of wood, or of iron, or of hemp, or of wire; but if another man invented a mode of letting men down the pit by a rope and pulley, it would be impossible to say that the one means of attaining a particular end was to be regarded as identical with, or comprehended in the other." (11 *L. T. Rep.*, N. S. 249.)

958. MURRAY v. CLAYTON. Ch. [1872]

A clumsy imitation of a patented machine, or a patented article, may be an infringement, although it is not such as would have been an anticipation defeating an inventor's right to a patent. Decided on the authority of *Daw v. Eley*. (*L. Rep.*, 7 Ch. 585.)

*Intention immaterial.***959. HEATH v. UNWIN.** Ch. [1847]

The doctrine laid down in this case by the Court of Exchequer (14 *L. J.*, *Ex.* 153), that, if a patent has been infringed unintentionally, the patentee is not entitled to redress, disapproved of. (15 *Sim.* 552.)

Shadwell, V.-C., said: "The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury), he is answerable for the consequences. In *Stevens v. Keating*, the Lord Chancellor disapproved of the case in the Court of Exchequer; and I must decline to act upon the principle which it lays down." (*Ib.* 553.)

960. STEAD v. ANDERSON. [1847]

The question of infringement depends not on what the defendant intends, but on what he does—per Wilde, C. J. (2 *Web. P. C.* 156.)

961. HEATH v. UNWIN. H. L. [1855]

Parke, B., said: "In delivering the judgment of the Court of Exchequer in a former stage of this case, I stated the opinion of the court to be, that there could be no indirect infringement if the defendant did not intend to imitate at all. That part of the judgment has since been justly objected to in *Stevens v. Keating*, and no doubt we were in error in that

respect. There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself." (25 *L. J., C. P.* 19.)

962. WALTON v. LAVATOR. [1860]

Erle, C. J.: "With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, *without any proof of knowledge of the article being patented, or of the infringement*, it would be sufficient evidence of infringement that the defendant had imported and sold." (29 *L. J., C. P.* 279.)

963. M'CORMICK v. GRAY. [1861]

Bramwell, B.: "I am satisfied there is no difference between making a thing with one intent and making it with another, because I always understood that if a man may do a thing he may do it with whatever intent he pleases." (31 *L. J., Ex.* 42; 7 *H. & N.* 25.)

964. NEWALL v. ELLIOTT. [1864]

Mere intention cannot make any act done an infringement which, without that intention, would not be an infringement. (10 *Jur., N. S.* 954; 13 *W. R.* 11; 10 *L. T. Rep., N. S.* 792.)

965. CURTIS v. PLATT. Ch. [1864]

Ignorance of the existence of a former invention is no answer to a charge of infringement, where the second invention is capable of being accurately represented as an imitation of the former. (11 *L. T. Rep., N. S.* 245.)

A Question for the Jury.

966. WALTON v. POTTER. N. P. [1841]

Tindal, C. J.: "Now, according to the general rule upon this subject (infringement), that is a mere question of fact, and peculiarly for the consideration of the jury, and it will be for you to say under the circumstances that have been brought in review before you, whether that which has been done by the defendants amounts to such an infringement or not." (1 *Web. P. C.* 586.)

967. MACNAMARA v. HULSE. N. P. [1842]

Where, in an action for infringing a patent for blocks for pavements, the plaintiff claimed as his invention that his block was bevelled both inwards and outwards on the same side of the block, and it was alleged that the defendant's blocks were an imitation of the plaintiff's, as two of the defendant's blocks were equivalent to one of the plaintiff's:—Held, that it was for the jury to say whether the defendant's blocks were in effect the same as the plaintiff's, although no single block of the defendant's was bevelled both inwards and outwards on the same side. (*Car. & M.* 471.)

968. NEWTON v. GRAND JUNCTION RAILWAY COMPANY. [1846]

The question, whether what the defendant has done is merely colourably different from the plaintiff's invention, is for the jury. (5 *Exch.* 331; 20 *L. J., Ex.* 427.)

969. STEVENS v. KEATING. N. P. [1847]

Upon the plea of not guilty his lordship said: "The question is, has the defendant done that which is within the claim—no matter whether the claim is good or not." (2 *Web. P. C.* 191.)

970. SELLERS v. DICKINSON. [1850]

The court will not, in deciding whether there has been an infringement, express an opinion as to whether the jury were

justified in their verdict, unless it is contended that the verdict was against evidence. (5 *Exch.* 323.)

971. DE LA RUE v. DICKENSON. [1857]

In an action for the infringement of a patent, the question of infringement is for the jury and not for the judge, although there be no question with respect to whether the defendant has or has not used the particular machine or process which is alleged to be an infringement. (7 *Ell. & Bl.* 738.)

Campbell, C. J., in delivering the judgment of the court, said: "There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But, if the evidence has a tendency to show that the defendant has used substantially the same means, to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, or of fact mixed with law, which the judge is bound to submit to the jury." (*Ib.* 755.)

972. SEED v. HIGGINS. H. L. [1860]

When a question of novelty, or infringement, depends merely on the construction of the specification, it is one entirely for the judge; but where it also depends on other circumstances, such as the degree of difference or of similitude between two machines, it is a mixed question of law and fact; what the jurymen find to have been done is the matter of fact, but the judge must apply that fact according to the rules of law, and is entitled and bound to say whether what has been done amounts to an infringement. (8 *H. L. Cas.* 550; 30 *L. J., Q. B.* 314; 6 *Jur., N. S.* 1264.)

973. CURTIS v. PLATT. H. L. [1866]

The question of infringement is a mixed question of law and fact. (35 *L. J., Ch.* 852.)

ACTION FOR INFRINGEMENT OF LETTERS PATENT.

Parties to the Action.

974. BOULTON v. BULL. N. P. [1795]

When a patentee has assigned part of his patent he may join with his assignee in bringing an action. (2 *H. Bl.* 464.)

975. GEORGE v. BEAUMONT. Ch. [1815]

Damages may be recovered against infringers, not only by the patentees but also by all who have obtained licences from them. Per Lord Eldon, L. C. (27 *Rep. Arts, 2nd Series*, 252.)

976. BLOXAM v. ELSEE. [1827]

The assignees of a bankrupt patentee may maintain an action for infringement of a patent. (6 *B. & C.* 169.)

977. DEROSNE v. FAIRIE. N. P. [1835]

Per Abinger, C. B.: A mere licensee can maintain no action for the infringement of the patent for which he has a licence. (1 *Web. P. C.* 155.)

978. CHANTER v. LEESE. Ex. Ch. [1839]

In suing upon an agreement between A., B. and C. of the one part, and D. of the other part, for royalties under an exclusive licence, founded upon a consideration to part of which A., B. and C. were each conducting parties, the action should be brought by all the parties to the agreement of the first part jointly. (1 *H. & H.* 224; affirmed in Ex. Ch., 5 *M. & W.* 698.)

979. SPILSBURY v. CLOUGH. [1842]

When a patentee assigned a third of his patent to A., and then entered a disclaimer, and subsequently assigned the remaining two-thirds of his patent to B., the two assignees, A. and B., may sue for an infringement committed after the date of the disclaimer. (2 *Gale & Dav.* 17.)

GIBSON v. BRAND. [1842] See **889.**

980. ELECTRIC TELEGRAPH COMPANY v. BRETT. [1851]

The assignees of a patent may maintain an action for infringement. (10 *C. B.* 838.)

981. CALDWELL v. VANVLISSENGEN. Ch. [1851]

Foreigners coming into this country are subject to actions for injuries done by their infringing on the sole and exclusive right granted by the Crown to patentees of inventions, in conformity with the law and constitution of this country. (9 *Hare*, 415.)

982. DENLEY v. BLORE. N. P. [1851]

The person physically using a patented invention, and not the person giving instructions and plans which include its use, is the party to be sued for an infringement; the contractor, for instance, and not the architect, in the case of a contrivance employed in house-building. (38 *Lon. Jour.* 224.)

983. SMITH v. THE LONDON & NORTH WESTERN RAILWAY COMPANY. [1853]

Where A. and B. are tenants in common of a patent assigned to them, if B. dies, actions for infringements committed in B.'s lifetime survive to A., who is entitled at law to recover the whole damages. (2 *Ell. & B.* 69; 17 *Jur.* 1071.)

984. DUNNICLIFF v. MALLETT. [1859]

It is competent to the assignee of a separate and distinct portion of a patent to sue for an infringement of that part,

without joining one who has an interest in another part,—the damages to be recovered in the action accruing to the former alone. (7 *C. B.*, *N. S.* 209; 6 *Jur.*, *N. S.* 252; 29 *L. J.*, *C. P.* 70; 8 *W. R.* 260.)

Erle, C. J., in delivering judgment, said: “The question is, whether an assignment of part of a patent is valid. I incline to think that it is. It is every day’s practice, for the sake of economy, to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day’s practice by disclaimer to get rid of part of a patent which turns out to be old. Being, therefore, inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action. Then, are the assignees bringing an action for an injury done solely to them by an infringement of that part of the patent which is thus vested in them alone, liable to be defeated because they have not joined the assignees of other parts of the patent, who have no manner of interest in the damages sought to be recovered in such action? I see no reason why the action should be defeated on any such ground. I see no reason why the plaintiffs should be put to the trouble and expense of applying for leave to use the names of the other parties, or of compelling them by means of a judge’s order to permit their names to be used upon an indemnity, where no practical advantage whatever is to be gained by it,—the injury being to the assignees of part only, and the damages to be recovered being their’s only.” (7 *C. B.*, *N. S.* 227.)

985. WALTON v. LAVATER. [1860]

The assignee of a patent may maintain an action for an infringement, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee. (8 *C. B.*, *N. S.* 162; 29 *L. J.*, *C. P.* 275; 6 *Jur.*, *N. S.* 1251; 3 *L. T. Rep.*, *N. S.* 272.)

An action is maintainable, although there has been no in-

fringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee. (*Ib.*)

986. RENARD v. LEVINSTEIN. Ch. [1865]

An exclusive licensee of a patent has a right to use the name of the patentee in an action for infringement. (2 *H. & M.* 628.)

987. BETTS v. DE VITRE. Ch. [1868]

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding such infringement may be in contravention of orders. (*L. Rep.*, 3 *Ch.* 441; 37 *L. J.*, *Ch.* 325; 16 *W. R.* 529.)

Particulars of Breaches.

988. PERRY v. MITCHELL. [1840]

The court has power, irrespective of any statute to that effect, to order the plaintiff, in an action for the infringement of a patent, to deliver particulars in writing of the infringements on which it is intended to rely. (1 *Web. P. C.* 269.)

Patent for the manufacture of improved pens. The specification described thirteen different kinds of improvements, referring to them by numbers. The court ordered the plaintiff to give the defendant particulars by the number of the pen on which infringements were alleged. (*Ib.*)

989. THE ELECTRIC TELEGRAPH COMPANY v. NOTT. [1847]

In an action for infringing a patent, the court has a general power to order a particular of the alleged infringement. But, where the specification claimed a combination of numerous improvements (in electric telegraphs), the court refused to compel the plaintiffs to give the defendants such particulars,

conceiving that from the nature of the patent, the plaintiffs would be thereby put to great difficulty and embarrassment, and that, under the circumstances (the matter having been debated in Chancery upon a motion for an injunction), the defendants must be taken to possess adequate information upon the subject. (4 *C. B.* 462; 16 *L. J.*, *C. P.* 174.)

990. TALBOT v. LA ROCHE. [1854]

In an action for infringement of a patent for "improvements in obtaining pictures or representations of objects," the court refused to compel the plaintiff in his particulars of breaches to specify particularly the persons and occasions, or the particular parts of the specification alleged to have been infringed, although the declaration merely averred an infringement in general terms. (15 *C. B.* 310; 2 *C. L. Rep.* 836.)

Jervis, C. J.: "If the two processes described in the specification are wholly distinct from each other, and the defendant's process may be an infringement of the one and not of the other, he ought to have better particulars. But, if the whole is substantially one process, he is not entitled to them. . . . We must not make the particulars more complicated than the specification." (*Ib.* 320.)

991. JONES v. LEE. [1856]

In an action by a patentee against his licensee on a covenant to pay for roving machines made with the plaintiff's invention, and to make none without,—breach, first, in not paying for roving machines made with the invention; and, secondly, in making machines without it; the defendant having, in answer to interrogatories, admitted the making of many hundreds of roving machines, but not with the plaintiff's invention, and having declared that he could not state to whom they were sold, nor give any further information about them, without disclosing his own evidence; and the plaintiff claiming in respect of all the machines the defendant had made, under one or other of the covenants, and asserting that he had seen some of them which had his invention applied:—Held, that the defendant was entitled

to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, so as to enable the defendant to understand, as far as possible, the nature of the machines as to which he was to be charged under either of the covenants, and that it was no answer to the application for such particulars that the defendant's answer to the interrogatories was insufficient to enable the plaintiff to furnish the particulars, for if the answers were insufficient, they should have been objected to. (25 *L. J., Exch.* 241.)

992. THE PATENT TYPE FOUNDRY COMPANY v. RICHARDS. [1860]

Upon an order for the delivery of further particulars of breaches, the plaintiffs enumerated certain instances, and added, "and the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches:"—Held, that this clause should be struck out of the particulars. (2 *L. T. Rep., N. S.* 359.)

JONES v. PRATT. [1861] See 1031.

993. NEEDHAM v. OXLEY. Ch. [1863]

Particulars of breaches delivered with a view to a jury trial of a patent case in this court are sufficient, if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him. (1 *Hem. & M.* 248.)

994. WREN v. WEILD. [1869]

The plaintiffs carried on the business of machine makers, and in their business sold machines to certain persons. The defendant wrote letters and made verbal statements to such persons, alleging that the machines so sold were infringements of a patent which he had obtained for such machines, and making claims in respect of such alleged infringement and the use of the machines.

An action having been brought by the plaintiffs in respect of the injury caused by these letters and statements, the defendant pleaded not guilty.

The court ordered him to deliver particulars to the plaintiffs, showing in what part or parts the machines of the plaintiffs mentioned in the declaration were an infringement of the defendant's patents, and pointing out by reference to line and page of his specifications what part of the inventions therein described he alleged to have been infringed. (*L. R.*, 4 *Q. B.* 213; 38 *L. J.*, *Q. B.* 88; 20 *L. T. Rep.*, *N. S.* 277.)

Notice of Objections, generally.

995. BULNOIS v. MACKENZIE. [1837]

In actions for infringing a patent, the notice of objection delivered by the defendant under 5 & 6 Will. 4, c. 83, s. 5, is not conclusive at his peril; but the court, under its general jurisdiction, may model its proceedings and order a fuller and further notice. The jurisdiction of the court as to these questions is analogous to that of set off. It is for the court to decide upon the sufficiency of the notice; this power is not created by the statute. (1 *Web. P. C.* 260; 4 *Bing. N. C.* 127.)

The notice of objections is meant to afford more specific information than the pleas. (1 *Web. P. C.* 263.)

996. FISHER v. DEWICK. [1838]

Application to the court for an amended notice of objections. Tindal, C. J., in delivering judgment, said: "The object of the statute (5 & 6 Will. 4, c. 83) was not, indeed, to limit the defence, but to limit the expense to the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. Under the fifth section, therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely.
 . . . If he (the defendant) would, in the Scotch phrase,

condescend upon the parts to which he objects, there would be an end to the difficulty." (1 *Web. P. C.* 267.)

Coltman, J.: "It is incumbent on the court to see that the objections are stated in a definite and intelligible form before the parties go down to trial, that the patentee may not be taken by surprise. The defendant is not precluded from bringing forward any number of objections, but he must state with precision what they are." (*Ib.* 268.)

997. *LOSH v. HAGUE.* [1838]

The defendant had omitted, on pleading, to give to the plaintiff a notice of any objections on which he meant to rely at the trial, and a summons was subsequently taken out before a judge at chambers for leave to deliver such notice *nunc pro tunc*. This summons being opposed, on the ground that a judge had not the power to grant the application, the word "other" in the section showing conclusively that unless some objections, one at least, had been given in, the authority under the statute could not be exercised, the matter came before the court.

Parke, B.: "The court has power to grant the defendant leave to plead *de novo*. Therefore, let the pleas already pleaded be considered as if pleaded *de novo*, and let the objections be then added, and considered as if delivered along with the pleas." (1 *Web. P. C.* 203 (n.).)

Abinger, C. B., in addressing the jury at the trial at *nisi prius*, said: "I never conceived those objections were intended to be urged before the jury; I thought they were merely to apprise the plaintiff of what he was to be prepared to meet." (1 *Web. P. C.* 203 (n.).)

998. *GILLET v. WILBY.* N. P. [1839]

It is not sufficient to state an objection in the notice of objections unless there be a plea to which it can be applied. (1 *Web. P. C.* 270.)

999. NEILSON v. HARFORD. [1841]

If the objections are not sufficiently specific, the plaintiff's course is to apply to a judge at chambers for an order for the delivery of a more specific notice; but if he omits to do so, he cannot object to the generality of the notice at the trial: the only question then is, whether the notice is sufficiently large to include the objections relied on by the defendant. (8 *M. & W.* 806; 1 *Web. P. C.* 331.)

Parke, B., delivering the judgment of the court, said: "The act (5 & 6 Will. 4, c. 83, s. 5) must be construed to mean that a mere copy of the pleas will not be a sufficient compliance with its provisions. It was passed after the new rules had required the several defences to be pleaded, and must, therefore, be considered as having intended to give to a plaintiff some additional advantage beyond the information which the record would give him. But that did not mean to say, nor do we think the Common Pleas meant to decide, that it would not be sufficient in some cases to give notice in the terms of the plea itself; the objection may be so completely and so fully expanded on the record, that a mere transcript of the plea itself may be sufficient; in other cases the plea may be so general in its language as to be insufficient as a notice, if transcribed from the plea merely. Each case must depend on its peculiar circumstances." (1 *Web. P. C.* 370.)

1000. WALTON v. BATEMAN. N. P. [1842]

The notice of objections should be drawn with reference to the pleas, or notice given of the pleas to which the objections are to be applied. (1 *Web. P. C.* 616.)

1001. MACNAMARA v. HULSE. N. P. [1842]

Lord Abinger, C. B.: "Whatever objections the defendants may have given you notice of, they cannot go beyond their pleas. I apprehend that the statute (5 & 6 Will. 4, c. 83) does not make the notice of objections stand in the place of pleas." (2 *Web. P. C.* 128 (n.))

1002. JONES v. BERGER. [1843]

The notice of objections must point out the defence with greater peculiarity than the record. The court will see that the objection is stated with reasonable particularity, according to the circumstances of the case. (1 *Web. P. C.* 544; 5 *M. & G.* 208.)

1003. R. v. MILL. *Sci. fac.* [1850]

The notice of objections is not part and parcel of the record, so as to be incorporated with the issues raised, and show that those specific objections are in issue. (1 *L. M. & P.* 695; 10 *C. B.* 379.)

1004. BETTS v. WALKER. [1850]

In an action for infringing a patent, if the defendant's notice of objections under stat. 5 & 6 Will. 4, c. 83, s. 5, is too general to give such information as the plaintiff is entitled to, it is no answer to a motion for better notice that the notice is as specific as the pleas. (14 *Q. B.* 363.)

1005. HULL v. BOLLAND. [1856]

In an action for the infringement of a patent, if the particulars of objections, delivered with the pleas in pursuance with the 15 & 16 Vict. c. 83, s. 41, are too general, the party who means to object to them must procure an order for better particulars. (1 *H. & N.* 134; 25 *L. J., Exch.* 304.)

1006. CHOLLET v. HOFFMAN. [1857]

The requirements of the statute 15 & 16 Vict. c. 83, as to the notices by the defendant, are confined to notices affecting the validity of the patent; and the defendant may, therefore, object to the want of registration of an assignment of the patent to the plaintiff, although it is not specially mentioned in his notices of objections. (7 *Ell. & Bl.* 686; 26 *L. J., Q. B.* 249.)

*As to first and true Inventor.***1007. FISHER v. DEWICK.** [1838]

On the delivery of amended particulars pursuant to an order of the court, a summons for further amended particulars was taken out and heard before the Lord Chief Justice Tindal at chambers. His Lordship, after time taken to consider, made the following alteration: The words "that the plaintiff was not in possession of the said alleged improvements before or at] the date of the letters patent," were struck out of the objection, that the plaintiff was not the true and first inventor of the whole or of any part of the said improvements. (1 *Web. P. C.* 551 (n.).)

1008. RUSSELL v. LEDSAM. [1843]

To an action for the infringement of a patent, the defendant pleaded: That the patentee was not the true and first inventor:—Held, that the notice of objections delivered under 5 & 6 Will. 4, c. 83, s. 5, need not state *who* the first inventor was, or under what circumstances the invention had been previously used. (11 *M. & W.* 647; 12 *L. J., Exch.* 439.)

Parke, B., in delivering the judgment of the court, said: "The principal point discussed was, whether or no it was necessary in an objection on the ground that the patentee was not the first inventor, or that the invention was not new, that the defendant should state who was the first inventor, or when, and in what place and under what circumstances it was used before. This point is not new, for it has been already before this court and also before the Court of Common Pleas, in the case of *Bulnois v. Mackenzie*. In that case the Court of Common Pleas would not require those particulars to be given, and their example has been followed by this court in the case of *Heath v. Unwin*. In the subsequent case, however, of *Jones v. Berger*, the Court of Common Pleas deviated from their former decision in *Bulnois v. Mackenzie*, and compelled the defendant to give the name of the first inventor. On consideration of the matter, however, we think that we ought to abide by the cases of *Heath v. Unwin* and *Bulnois v. Mackenzie*, and that no par-

ticulars of the circumstances under which this invention may have been previously used should be required from the defendant; and we are fortified in this view by the decision of the Court of Queen's Bench in the case of *Reg. v. Walton*, in which they adopted the same view. That was originally an application to the Master of the Rolls, which afterwards came before the Court of Queen's Bench, which we find, on inquiry, to have determined this point the same way." (11 *M. & W.* 651.)

As to prior User.

1009. BULNOIS v. MACKENZIE. [1837]

It is doubtful whether under the words (5th section of 5 & 6 Will. 4, c. 83) "notice of objection" the court can require a defendant to furnish the names of those who are alleged to have used the plaintiff's invention. Application refused on the ground that it might prejudice the defendant. (4 *Bing. N. C.* 132.)

1010. FISHER v. DEWICK. [1838]

An objection stated that "a particular improvement had been used by A. B., &c. (giving names and addresses), and divers other people within this kingdom and elsewhere;" the judge at chambers struck out the words "and divers other people," adding that "if the defendant discover other persons not named in the objections, he has the power of applying to a judge to add such persons." (1 *Web. P. C.* 551 (n.).)

1011. GALLOWAY v. BLEADEN. [1839]

Coltman, J., ordered names, addresses, and descriptions to be given, and the words "divers other persons" to be struck out. (1 *Web. P. C.* 268 (n.).)

1012. CARPENTER v. WALKER.

The objection stated the making of locks similar to the subject of the patent by the defendant and others, several years

before the date of the letters patent, and their sale to divers persons, and among others to one S. T., of &c. On summons to strike out the words "to divers persons, and among others," or to state the names and descriptions of the others besides S. T., to whom sales were made, the parties were referred to the court, who refused the application. (1 *Web. P. C.* 268 (n).)

1013. REG. v. WALTON. *Sci. fac.* [1842]

On *sci. fac.* to repeal a patent, the prosecutor having, while the record was in Chancery, filed notice of objections, under 5 & 6 Will. 4, c. 83, s. 5, namely, that other persons than the patentee had used the invention in *England* before grant of the patent; the Court of Queen's Bench, on motion supported by an affidavit stating that the defendant had no other means of gaining the information required, and was afraid of being taken by surprise at the trial, refused to order delivery of a particular stating the names and addresses of such persons. (2 *Q. B.* 969.)

1014. HEATH v. UNWIN. [1842]

It is not sufficient notice of an objection to say that the invention was wholly or in part used before, but it ought to point out what portions were previously in use. (10 *M. & W.* 684; 1 *Web. P. C.* 551; 2 *D. N. S.* 482; 6 *Jur.* 1068; 12 *L. J., Ex.* 46.)

1015. RUSSELL v. LEDSAM. [1843]

To an action for the infringement of a patent, the defendant pleaded: That the invention was not, when the letters patent were granted, a new invention:—Held, that the notice of objections delivered under 5 & 6 Will. 4, c. 83, s. 5, should specify whether the defendant objects to the patent generally as not new, or to part only, and, if so, to what part. (11 *M. & W.* 647; 1 *D. & L.* 347; 7 *Jur.* 585; 12 *L. J., Exch.* 439.)

1016. JONES v. BERGER. [1843]

The words "and elsewhere" should be omitted, the places to be specified should fresh evidence arise. The notice of objections is sufficient if it limits the inquiry to a particular species and class of persons, who are using it in a particular trade. (1 *Web. P. C.* 549.)

Maule, J., said: "It seems to me to be a reasonable particularization if it (the notice of objection) points out to the party who is to sustain the patent sufficiently the nature of the inquiry that the objector intends to rely on as to the patent. It seems to me not unreasonable to say 'at Nottingham and elsewhere;' for the nature of the fabric being specified, and the particular kind of starch also specified, it might well be, as my brother *Bompas* has argued forcibly, that there might be fabrics of that kind in the market, which could be shown to have been made of that kind of starch, though you may not be able to trace where they came from. I don't think it worth while to differ from my Lord Chief Justice in that respect." (1 *Web. P. C.* 550.)

The defendant should specify books or publications intended to be relied on. (1 *Web. P. C.* 548.)

1017. BENTLEY v. KEIGHLEY. [1844]

In case for infringing of a patent for improvements in machinery, the notice of objections delivered pursuant to 5 & 6 Will. 4, c. 83, s. 5, stated that the invention was known to and used by A. and B., *and others*, before the grant. The court refused to require the defendant to strike out the words "and others." Maule, J., in the course of the argument, said: "The plaintiff may know one person, and he may know that there are others who have used the article. Suppose the patent to be for an improvement in shipping, and the defence relied on were, that it had been used before, the defendant would not be bound, in his particular, to state the names of all the owners of all the ships in which he had seen the alleged improvement applied. But, if he states that the invention had been published to the world in a certain magazine or journal,

and also in other books and writings, he ought to specify all the books and writings." (7 *M. & G.* 652; 8 *Scott, N. R.* 372; 1 *D. & L.* 944; 13 *L. J., C. P.* 167.)

1018. HOLLAND v. FOX. [1853]

Where the defendant in an action for infringement of a patent states in the particulars of objection delivered with his pleas that the invention of the plaintiff had been used before, *inter alia*, at Sheffield, Birmingham and London, the court made an order, under the 15 & 16 Vict. c. 83, for further and better particulars. (1 *C. L. Rep.* 440; 1 *W. R.* 448.)

1019. PALMER v. COOPER. [1853]

The 41st section of the 15 & 16 Vict. c. 83, requires the defendant in an action for the infringement of a patent, to deliver with his pleas the particulars of any objections on which he means to rely at the trial; and when he intends to rely upon a prior user or publication, the particulars must state the place or places at which, and in what manner, the invention has been used or published prior to the date of the patent; and in the absence of such statement, the defendant will be precluded from giving evidence of such prior user or publication. The plaintiff's particulars of breaches cannot be called in aid of the defective particulars of objections. Although a judge at chambers has power to order the amendment of the particulars, he cannot introduce into such order any terms relative to the admissibility of evidence at the trial under such particulars which are inconsistent with the provisions of the 41st section. (9 *Exch.* 231; 2 *C. L. R.* 430; 23 *L. J., Exch.* 82.)

Parke, B.: "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the places named." (9 *Exch.* 236.)

Alderson, B.: "I think that the present residence of the parties who have been the users of the invention ought to be stated, as otherwise the plaintiff would not know where to go for his evidence." (*Ib.*)

1020. PALMER v. WAGSTAFFE. [1853]

Where, in an action for the infringement of a patent, the defendant relies on a general user of the supposed invention, it is sufficient to state, in his particulars of objection, under 15 & 16 Vict. c. 83, s. 41, that the invention was used by manufacturers generally at a particular place, without naming any person or specifying any manufactory. (8 *Exch.* 840; 17 *Jur.* 581; 22 *L. J.*, *Exch.* 295.)

Alderson, B.: "A defendant may rely either on a specified user by certain persons named, or on a general user by all persons at a particular place. In the former case, if he proves a user by any one of the persons named, that will support his objection; but if he rests his case on a general user, proof of a user by one person will not do. In fact, the plaintiff has no reason to complain of the generality of the statement, for the more general it is, the more the defendant must prove under it." (8 *Exch.* 842.)

1021. HULL v. BOLLAND. [1856]

The 15 & 16 Vict. c. 83, s. 41, does not prevent defective particulars from being available at the trial, and the plaintiff cannot resist the admission of evidence which is within the literal meaning of the particulars, on the ground that the statement is too general, and that the particulars do not give the required information as to the place in which the invention is alleged to have been used. (1 *H. & N.* 134; 25 *L. J.*, *Exch.* 304.)

Pollock, C. B.: "It is true that the statute contains a proviso that the place or places at which the invention is alleged to have been used shall be stated, but that proviso does not prevent particulars not containing such statement from being available, if not objected to on that ground before the trial." (1 *H. & N.* 137.)

As to Specification.

1022. FISHER v. DESWICK. [1838]

On the objection, "that the invention for which the said letters patent were granted is more extensive than, and did not correspond with, the invention described in the specification," his Lordship remarked, "I think the attention of the plaintiff should be called to the particular part or parts." His Lordship made the same remark on an objection of discrepancy between the drawings and specification. (1 *Web. P. C.* 551 (*n.*.)

1023. NEILSON v. HARFORD. [1841]

A statement in the notice of objections, that the specification is calculated to deceive, is sufficient to let in evidence as to any particular passage being false. (1 *Web. P. C.* 324 (*n.*.) Where the objection simply states the specification to be insufficient, if the plaintiff is contented to take that as notice, any objection may be made at the trial to show that the specification is insufficient. (*Ib.* 332.)

1024. HEATH v. UNWIN. [1842]

It is a sufficient notice to state "that the invention is not properly set forth in the specification," for the legislature never intended that the defendant should argue his case in the statement of objections, which he delivers in compliance with the act. (10 *M. & W.* 687; 12 *L. J., Ex.* 48.)

1025. JONES v. BERGER. [1843]

The objection that the plaintiff's specification did not "sufficiently distinguish between what was old and what was new," held sufficient, as the objection was to an omission in the specification. The allegation that the plaintiff did not state in his specification "the most beneficial method with which he was then acquainted, of practising his said invention," held sufficiently precise. (5 *M. & G.* 208.)

1026. LEAF v. TOPHAM. [1845]

In an action for the infringement of a patent, the defendant, pursuant to sect. 5 of 5 & 6 Will. 4, c. 83, delivered a notice of objections, one of which stated that the patentee did not, by the specification in the declaration mentioned, sufficiently describe the nature of the supposed invention; and the other stated that he had not caused any specification sufficiently describing the nature of the supposed invention to be duly enrolled in chancery:—Held, that the last objection was not sufficiently precise; and the court ordered an amendment, which was made by inserting the word “other” before “specification.” (14 *M. & W.* 146; 14 *L. J., Exch.* 231.)

Parke, B.: “I think the meaning of the last objection is too obscure. It may either mean, that there is no specification existing among the rolls of the court, or that that which has been enrolled is defective in not sufficiently describing the invention. It is not necessary that the notice of objections should set out the evidence on which the defendant relies, but it ought to be more specific than this is. The act of parliament which requires the notice of objections, was framed at a time when the general issue was the usual plea in cases of this kind, and it was no doubt intended to pass in the place of special pleas.” (14 *M. & W.* 148.)

As to Fraud and Misrepresentation.

1027. FISHER v. DESWICK. [1838]

An objection stated, that there were several machines, “such as (naming them) and others, to which the said improvements are inapplicable;” his Lordship struck out the words “and others.” (1 *Web. P. C.* 551 (n).)

1028. JONES v. BERGER. [1843]

The objection, that the plaintiff did not state the best mode with which he was acquainted is sufficient. (1 *Web. P. C.* 546.)

1029. RUSSELL v. LEDSAM. [1843]

To an action for the infringement of a patent, the defendant pleaded: That the report of the Judicial Committee of the Privy Council, and the letters patent thereupon, were procured by fraud, covin and misrepresentation:—Held, that the notice of objections delivered under 5 & 6 Will. 4, c. 83, s. 5, ought to state the species of fraud, covin and misrepresentation by which the patent was procured, on which he intends to rely. (11 *M. & W.* 647.)

*Interrogatories.***1030. TETLEY v. EASTON.** [1856]

Where a defendant does not deny the infringement, it is no ground for his refusing to answer interrogatories, that the answers would expose persons to whom he had sold the patented articles to actions. (18 *C. B.* 643 ; 25 *L. J., C. P.* 293.)

JONES v. LEE. [1856] See 991.

1031. JONES v. PRATT. [1861]

The plaintiff, in an action commenced in 1861 for damages for an infringement of his patent, granted in 1841, applied to be allowed to administer interrogatories to the defendant before delivery of declaration, asking, *inter alia*, for particulars of the number of machines manufactured, altered or sold by the defendant between the years 1841 and 1855, when the patent expired. The application was made on affidavits by the plaintiff's agent, that he had ascertained and believed that many machines, containing infringements of the plaintiff's patent, had been made and sold, without the leave of the plaintiff, by the defendant, between the said years, and that answers to the interrogatories would disclose many more breaches of the plaintiff's patent than had as yet been discovered, and that the discovery sought by the interrogatories was essential for the drawing the declaration in the action. The court refused to

allow the interrogatories to be delivered *before* declaration, but intimated that the plaintiff might probably be entitled to deliver them after issue joined, and that he would then be at liberty to amend the particulars of the breaches he would be bound to deliver with his declaration, in accordance with the answers the defendant might give. (30 *L. J.*, *Exch.* 365 ; 6 *H. & N.* 697.)

1032. THOMAS v. TILLIE. [1866]

See this case for the form and extent of interrogatories which may be exhibited to a defendant in an action for infringement of a patent before plea pleaded. (17 *Ir. C. L. R.* 783.) The same interrogatories were allowed in England, not reported. (*Ib.* 785.)

Discovery and Inspection.

1033. CROFTS v. PEACH. [1836]

In an action for the infringement of a patent, the plaintiff will not be compelled to produce a specimen of the patent articles, to enable the defendant to prepare his defence to the action. (2 *Hodg.* 110.)

1034. AMIES v. KELSEY. [1852]

An application to inspect the defendant's machinery may be made by the plaintiff under 15 & 16 Vict. c. 83, s. 42, whenever an action is pending, even before the delivery of the declaration ; but such inspection will not be granted as of course, or without the party applying for it showing that the inspection is material for the purposes of the cause. (22 *L. J.*, *Q. B.* 84 ; 1 *B. C. C.* 123 ; 16 *Jur.* 1047.)

1035. SHAW v. THE BANK OF ENGLAND. [1852]

In an action for the infringement of a patent, the court will not grant an order, under the 15 & 16 Vict. c. 83, s. 42, for an

inspection of a machine upon an affidavit "that the machine used by the defendants is the same for which the plaintiff has obtained a patent." (22 *L. J.*, *Exch.* 26.)

Pollock, C. B.: "The affidavit is too vague and defective for the court to grant this application. It ought, at least, to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement."

Referring to the 42nd section, his Lordship said: "This is a power only hitherto exercised by the Court of Chancery; and now that the legislature has given to the common law courts the power of granting injunctions, it must be presumed that those powers are to be exercised in the same way as they have hitherto been by the Court of Chancery." (*Ib.*)

1036. HARRISON *v.* SPIRE. [1853]

A rule nisi for an order to inspect a defendant's machinery, under the 42nd section of the Patent Amendment Act, 1852, will be granted on motion. (22 *L. T. Rep.* 92.)

1037. SMITH *v.* THE GREAT WESTERN RAILWAY COMPANY. [1854]

Where, in an action for an infringement of a patent, the plaintiff seeks, under sect. 6 of 14 & 15 Vict. c. 99, to discover by an examination of the defendant's books the amount of damage sustained by him by the infringement of his patent by the defendant, the court will not compel the defendant to grant such inspection, unless a *prima facie* legal right be established by the plaintiff; and it is not enough for the plaintiff to show that he has been injured in his patent, and that it is probable the amount of such injury will be ascertained by the examination asked for. (3 *W. R.* 69.)

1038. VEDI *v.* SMITH. [1854]

The "inspection" mentioned in the 42nd section of stat. 15 & 16 Vict. c. 83, is an inspection of the instrument or machinery manufactured or used by the parties, with a view to

evidence of infringement, and does not refer to an inspection of books, which is provided for by another act of parliament. (3 *Ell. & B.* 969 ; 1 *Jur., N. S.* 14 ; 23 *L. J., Q. B.* 342.)

1039. JONES v. LEE. [1856]

In an action by a patentee against his licensee on a covenant to pay for roving machines made with the plaintiff's invention, and to make none without,—breach, first, in not paying for roving machines made with the invention ; and, secondly, in making machines without it ; the defendant having, in answer to interrogatories, admitted the making of many hundreds of roving machines, but not with the plaintiff's invention, and having declared that he could not state to whom they were sold, nor give any further information about them, without disclosing his own evidence ; and the plaintiff claiming in respect of all the machines the defendant had made, under one or other of the covenants, and asserting that he had seen some of them, which had his invention applied :—Held, that the defendant was entitled to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, and that the plaintiff might inspect the machines on the premises of the defendant, and also examine him *vivâ voce*. (25 *L. J., Exch.* 241.)

1040. MEADOWS v. KIRKMAN. [1860]

In an action for the infringement of a patent for a mode of making veneers or mouldings, the court refused to order an inspection by the plaintiff of the defendant's manufactory and machinery ; it being doubtful on the plaintiff's affidavit whether his patent was for the kind of veneering, or for the process by which it was done ; and the defendant positively swearing that he used no machinery in the process. (29 *L. J., Exch.* 205.)

Pollock, C. B., said : “ We ought not to grant such an inspection without, at least, as good a ground for it as would be required in a court of equity ; or for any inspection of books or documents. Then it must appear that what is asked is really required to prove the plaintiff's case.”

1041. THE PATENT TYPE FOUNDRY COMPANY v. LLOYD;
SAME v. WALTER. [1860]

In an action against a printer for an infringement of a patent for improvements in the manufacture of type, the improvements consisting in the use of lead, tin and antimony in certain proportions, the plaintiff applied to the court under the 42nd section of the 15 & 16 Vict. c. 83, for leave to inspect, and, if necessary, to take specimens of the type for the purpose of analysis. His affidavit stated that he had obtained from the defendant specimens of the type and caused them to be analysed by a chemist who was dead, and that the type so analysed was an infringement of the patent; but did not set out the report of the chemist or state its substance, or whether or not it was in writing. The court refused to make an order that the plaintiff should be at liberty to take specimens for analysis. (5 H. & N. 192; 29 L. J., *Exch.* 207; 6 *Jur.*, N. S. 103.)

Martin, B., in delivering judgment, said: "We have to put a construction on the 42nd section of the 15 & 16 Vict. c. 83. It empowers the court, 'on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection and account, and the proceedings therein respectively,' as to them may seem fit. I am disposed to think that Mr. Webster has given a true guide to the construction of it, viz. that no one of these matters is to be dealt with separately, but the whole is to be read together. I entirely agree with the opinion of the Court of Queen's Bench in *Holland v. Fox*, that the intention of the legislature was to vest in the courts of common law the power to order an injunction, inspection and account, heretofore exclusively possessed by courts of equity, so that suitors may be saved the expense of being obliged to go to a court of equity. In applications like the present we ought to look to the rights of the parties, of the patentee as well as of the defendants, and to carry out the enactment, not by putting extreme cases, but dealing with the whole matter as a court of equity would, and as the Vice-Chancellor did in *Morgan v. Seaward*. I think that we ought to look at the injunction, inspection and account in the same spirit, and grant

or refuse them on such terms as would be fair between the parties." (5 *H. & N.* 198.)

Bramwell, B., said: "It is difficult to say that a person authorized to inspect might not consume a small portion of the matter to be inspected. Probably inspection must be construed with reference to the matter to be inspected. If the party inspecting cannot otherwise understand its nature and quality, he may probably consume some small portion of it; but when a sensible meaning with reference to the subject-matter can be given to the word inspection by construing it inspection by the eye, I think it must be confined to that. Type can be inspected by the eye. I think in the present case that more is asked for than the court has power to grant." (*Ib.* 200.)

Channell, B., said: "I do not say that the application in point of form must be for an injunction, yet I think that the right (to grant inspection) depends on the plaintiff satisfying the court that they would have granted an injunction if asked for." (*Ib.*)

On an application to the Court of Chancery, Wood, V.-C., made an order that the plaintiffs should be at liberty to take specimens of the type for analysis. (*John.* 727.)

1042. SAXBY *v.* EASTERBROOK. [1872]

The plaintiffs obtained a verdict in an action for the infringement of a patent; a rule to enter the verdict for the defendants was discharged; and the defendants appealed. An order was afterwards made for an account of profits, which was not appealed against, but on the parties appearing before the master for the purpose of taking the account, the defendants refused to produce their books. The court made absolute a rule for production and inspection of the defendants' books, and for interrogatories to the defendants, notwithstanding the pendency of the appeal. (*L. R.*, 7 *Exch.* 207; 41 *L. J.*, *Exch.* 113.)

Injunction.

1043. GITTINS v. SYMES. [1854]

The rule for a writ of injunction to restrain a defendant from infringing a patent, under the 82nd section of the Common Law Procedure Act, 1854, is a rule to show cause only, in the first instance. The same relief may be had under the Patent Law Amendment Act, 1852, s. 42. (15 *C. B.* 362; 24 *L. J.*, *C. P.* 48.)

1044. CLAYTON v. PERCY. [1854]

The plaintiff having recovered a verdict, an order for an injunction was obtained and made a rule of court. Upon the defendant continuing the infringement after personal service of the order on him, a rule was made absolute for attachment. (48 *Leg. O.* 150.)

1045. LISTER v. EASTWOOD. [1855]

Where, after verdict in an action for the infringement of a patent, an order for an injunction and for an account to be taken of profits made by the defendant is applied for under section 42 of the Patent Law Amendment Act, 1852, the court will not make an order for an injunction until it be shown that the defendant, after the verdict, has continued to infringe the patent; and before they will make an order for an account of profits to be taken, a strong case must be established that the defendant has made profits by the infringement of the patent. (3 *C. L. Rep.* 1249.)

See "Suit in Equity—Injunction."

Postponement of Trial.

1046. SMITH v. UPTON. [1843]

Notice of trial by proviso having been given in an action brought by the assignee of a patent for an infringement, in

which action the validity of the patent was put in issue, the court, at the instance of the plaintiff, postponed the trial on the ground that in a *scire facias* brought by the defendant to repeal the patent, a rule was pending in the Queen's Bench for entering a verdict for the patentee. (6 *M. & G.* 251.)

1047. MUNTZ v. FOSTER. [1844]

Action brought on the 21st July, and cause set down for trial at the Middlesex sittings after Hilary term. A writ of *scire facias* to repeal the patent issued on the 3rd of May, at the instance and on the prosecution of one of the defendants; the proceeding being duly prosecuted, the *scire facias* was set down for trial at the sittings after the previous Trinity term—prior to the commencement of the action—but not being then tried was entered for trial after Hilary term. In the ordinary course of things, the cause would first come on for trial. The court refused to order that the trial of the cause should be postponed until after the *scire facias* had been determined.

Tindal, C. J., said: "I feel very great difficulty where a plaintiff has duly put his cause in the list, in depriving him, under any circumstances, of that which may be called his common law right to try. Undoubtedly there are cases in which we should be justified in interposing; as, for instance, where public convenience requires it, or where such a course would manifestly be in furtherance of justice." (2 *Web. P. C.* 93 (n.).)

1048. PATTESON v. HOLLAND. [1845]

Where one action for infringement had been tried, and a rule *nisi* for a new trial had been obtained and argued, and another action was pending for another infringement of the same patent, and a *scire facias* had been sued out to repeal the patent, the court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*. (*Hind. on Pat.* 293.)

*Venue.***1049. CAMERON v. GRAY.** [1795]

A plaintiff cannot make an affidavit that the cause of action, in a case for the infringement of a patent, arose wholly in any particular county and not elsewhere, since the substratum of the action, namely, the patent, is at Westminster. (6 *T. R.* 363.)

1050. BRUNTON v. WHITE. [1825]

On a motion to change the venue, in a case for infringement, the court said there was no precedent for the application, and that unless some instance was cited in which it had been done they could not grant the motion. Rule refused. (7 *D. & R.* 103.)

*Evidence of the Subject-matter of a Patent.***1051. LEWIS v. DAVIS.** N. P. [1829]

In an action for the infringement of a patent, professing to be an improvement on a former patent, the specification of the former patent must be put in evidence, in order to show what the improvement really is. (1 *Web. P. C.* 489; 3 *C. & P.* 502.)

1052. BATEMAN v. GRAY. [1853]

In an action for infringing a patent, defendant pleaded only—(1) not guilty; (2) a traverse that plaintiff was the inventor; and (3) a traverse that the invention was new. At the trial, the plaintiff put in the specification, which claimed three old things; but he proved, by his own evidence, that the invention which he really claimed, and which he thought he had described in his specification, was the combination of the three things:—Held, that the specification was evidence for the jury, but not conclusive; and that they were warranted in finding that the invention was the combination. (1 *C. L. Rep.* 512.)

Pollock, C. B., said: "We think that what was the invention is a question for the jury, and that the specification does not conclude the plaintiff. It was evidence to be considered by the jury and no more." (*Ib.* 515.)

Evidence of Novelty of Invention.

1053. MANTON *v.* MANTON. N. P. [1815]

Action for the infringement of a patent for a hammer for the locks of fowling-pieces.

Gibbs, C. J., said to the jury: "The first witness, a man of considerable experience, had never seen any locks with the lips so perforated; *primâ facie*, that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before would be of no avail if one was called who had seen it and practised it." (*Dav. P. C.* 350.)

1054. R. *v.* HADDEN. *Sci. fac.* [1826]

On *scire facias* to repeal a patent for a machine, on the ground that it is not new, you may, to prove that, put into the hand of a witness, who had constructed a machine for the same purposes, a drawing not made by himself, and ask him whether he has such a recollection of the machine he made, as to be able to say that that is a correct drawing of it. (2 *C. & P.* 184.)

1055. *In re* CUTLER'S PATENT. Ch. [1839]

The identity of purpose, and not of name, is the criterion in judging of the similarity or dissimilarity of inventions. (1 *Web. P. C.* 427.)

1056. GALLOWAY *v.* BLEADEN. N. P. [1839]

It is only necessary for the plaintiff to make out a *primâ facie* case as to the novelty of his invention, to call upon the other side to show affirmatively that it is not new. This the plaintiff may do by calling persons who are conversant with

the subject of the patent, and who pass their time in understanding the nature of patents, and in following up and discovering what are the inventions that are going on from week to week, to say that they had not before heard that there had been such a discovery previous to the grant of the patent. (1 *Web. P. C.* 526.)

1057. WALTON v. POTTER. N. P. [1841]

Tindal, C. J., said to the jury: "It will be not immaterial to call your attention, upon this first head of inquiry, to the specification of the plaintiff's, and next that of the defendants' patent, in order that we may compare them together, and see whether there really is that variation in substance so as to give the denomination of a new discovery to what the defendants have done, or whether they are not following out the invention of the plaintiff, with some variation in the description, which may not allow it the name of a new discovery." (1 *Web. P. C.* 587.)

1058. HYDE v. PALMER. [1863]

In an action for the infringement of a patent taken out in 1849, the defendant, in support of a plea that the invention was not new, gave evidence that O., who was dead, had in 1846 used a process identical with that in the patent. On the cross-examination of the witnesses it appeared that, if O. used the invention and sold the product before the date of the patent, it was only in very small quantities, and that it was not brought into general use; and one of the witnesses was asked in cross-examination whether O. had not sold some of the product to S., and said he had. The plaintiff in reply called S., who gave evidence that in 1850 or 1851, O. sold him a small quantity of the product, and at the time of the sale said that it was a new article, that he did not wish it to be publicly known, and he would sell him all he could manufacture:—Held, that evidence of what O. said at the time of that sale was not admissible in reply, as it would not have been admissible in chief on an issue whether O., before 1849, used the invention. (3 *B. & S.* 657; 11 *W. R.* 433; 7 *L. T. Rep.*, N. S. 823; 32 *L. J.*, Q. B. 126.)

AMORY v. BROWN. [1869] See **1112.**

1059. BETTS v. NEILSON. H. L. [1871]

Where a patent had been taken out by D. in 1804, and another patent had been taken out by B. in 1849, and B. took proceedings against N. for infringement, to which N. set up as an answer want of novelty, and proved D.'s patent, evidence of all that was done in the trade to which the patent related between the date of D.'s patent and of B.'s patent, was admissible on this question of novelty. (*L. R.*, 5 *H. L.* 2.)

*Evidence of the Grant of Letters Patent.***1060. MINTER v. WELLS.** N. P. [1834]

Alderson, B.: "The patent is *primâ facie* evidence on the part of the person who claims the right that he is so entitled, and it is for the person who seeks to infringe that patent to show some circumstance whereby that right, which otherwise would be presumed to exist, is defeated, to show that the Crown's grant has been improperly obtained by the present plaintiff." (1 *Web. P. C.* 129.)

1061. RUSSELL v. CRICHTON. [1837]

Letters patent afford *primâ facie* evidence of the originality of the alleged invention. (1 *Web. P. C.* 677 (n).)

1062. NICKELS v. ROSS. [1849]

At the trial the plaintiff put in the letters patent and specification, and gave evidence to show that a machine like his had never been in use before the date of the letters patent:—Held, that this entitled the plaintiff to a verdict upon the issue joined on the plea of *non concessit*.

And *semble*, that the plea of *non concessit* did not impose upon the plaintiff the burthen of showing that the Crown had power to grant, until evidence had been given on the other side to impeach the patent; and that the averment in the declaration,

that the plaintiff was the inventor of the improvements for which the patent was granted, not having been traversed, the defendant was not at liberty to controvert that fact at the trial.

Held, also, that the plaintiff was entitled to a verdict on the issue joined on a plea, stating that the plaintiff had obtained the patent on a false representation that he was in possession of the invention in consequence of a communication from a foreigner resident abroad, without any proof that the invention was communicated to him by a foreigner residing abroad, as alleged in the petition recited in the specification,—a party availing himself of information from abroad, being an *inventor* within the meaning of the 21 Jac. 1, c. 3, s. 6. (8 C. B. 679.)

Evidence of Sufficiency of the Specification.

1063. TURNER v. WINTER. [1787]

Buller, J.: “I do not agree with the counsel who have argued against the rule, in saying, that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admit that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification.” (1 T. R. 606.)

1064. R. v. FUSSELL. N. P. [1826]

The evidence of a scientific man, that to carry out an invention from the specification would require a great deal of con-

trivance, is, in the absence of evidence to the contrary, sufficient proof of the insufficiency of the specification. (1 *Carp. P. C.* 449.)

1065. BROOKS v. RIPLEY. [1831]

If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentees, and plaintiffs will be nonsuited. (2 *Lond. Jour., C. S.* 35.)

1066. MINTER v. WELLS. N. P. [1834]

Alderson, B.: "The plaintiff, in order to establish his right, must show that the invention is new, and that it is useful, and that the specification is such that an ordinary workman could make the machine which would answer the purpose which the patent was intended to accomplish." (1 *Web. P. C.* 129.)

1067. CORNISH v. KEENE. N. P. [1835]

Upon an action for infringement, the specification is proved to be sufficient, if witnesses are called by the plaintiff, who have actually made the manufacture without any instruction except the specification; and none are called by the defendant, who could not understand the specification, had been misled by it, or incurred expense in endeavouring to copy or to imitate it. (1 *Web. P. C.* 502.)

NEILSON v. HARFORD. [1841] See 429.

1068. R. v. NICKELS. [About 1846]

Where, in a patent for machinery, the improvements are not sufficiently ascertained or described either by words or figures,

parol evidence is not admissible to explain the specification and show what is new. (*Hind. Law of Pat.* 186.)

THE PATENT TYPE FOUNDRY COMPANY v. RICHARDS.
Ch. [1859] See 435.

1069. YOUNG v. FERNIE. Ch. [1864]

Experiments conducted for the express purpose of manufacturing evidence, with a view to litigation, are to be looked at with distrust. (4 *Giff.* 609.)

PENN v. BIBBY; PENN v. JACK. [1866] See 353.

WREN v. WEILD. [1869] See 1097.

Evidence of Infringement.

1070. HUDDART v. GRIMSHAW. N. P. [1803]

Action for the infringement of a patent for a new mode of making cables and other cordage. Evidence was given on behalf of the plaintiff by an engineer, who was familiar with the subject of rope-making, that some rope, proved to be of the defendant's manufacture, agreed in its structure and in all its qualities with the rope made by the plaintiff's patented method. The witness knew of no other method of manufacturing such rope, which he believed to have been made in accordance with the plaintiff's patent:—Held, that this was *primâ facie* evidence, till the contrary was shown, of an infringement of the plaintiff's patent. (*Dav. P. C.* 288; 1 *Web. P. C.* 91.)

1071. HALL v. BOOT. N. P. [1822]

The sale of an article which might, during its manufacture, have been improved according to a patent process, coupled with the fact of the defendant having the machine necessary for practising such process in his possession, is sufficient evidence of infringement. (1 *Web. P. C.* 100.)

1072. MUNTZ v. FOSTER. N. P. [1844]

Tindal, C. J. : "For the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff." (2 *Web. P. C.* 99.)

1073. PALMER v. WAGSTAFF. [1854]

The plaintiff's patent, obtained for "*the mode of manufacture of candles by the application of two or more plaited wicks, so disposed that the ends always turn outwards,*" is not proved to be infringed by the mere production of a candle, made by the defendant, in which the wicks were so plaited and turned outwards. It must be further shown that the defendant made it by the method described in the plaintiff's specification, or in some way that the jury might consider colourable. (9 *Ex.* 494 ; 23 *L. J.*, *Ex.* 217 ; 2 *C. L. R.* 1052.)

1074. UNWIN v. HEATH. H. L. [1855]

Crompton, J. : "Proof of a user of an invention before the patent was granted, such as would be evidence that there was no novelty, if taking place after the patent, is evidence of an infringement." (25 *L. J.*, *C. P.* 13.)

THOMAS v. FOXWELL. [1858] See **922**.

1075. DAVENPORT v. RICHARDS. Ch. [1860]

The fact that the articles made by the plaintiff's and defendant's machines are identical, is a fair argument to show that an infringement of the plaintiff's patent has been committed. (3 *L. T. Rep.*, *N. S.* 504.)

1076. SEED v. HIGGINS. H. L. [1860]

The opinion of scientific witnesses as to whether there has or not been an infringement ought not to be received. Per Lord Wensleydale. (8 *H. L. Cas.* 550 ; 30 *L. J.*, *Q. B.* 314 ; 6 *Jur.*, *N. S.* 1264.)

1077. NEILSON v. BETTS. H. L. [1871]

Seemle, that, where the piracy alleged has taken place abroad, it becomes the duty of the defendant to give evidence of a negative character to prove (in answer to the *primâ facie* case made by the patentee) that the process used was of a different character from that which had been patented.

Where that negative evidence was not given by the defendant, but positive evidence on the part of the patentee was given by one workman that he had been employed at the foreign manufactory, and there saw the capsules manufactured by a process not distinguishable from that of the patentee:—Held, that these circumstances justified the conclusion of identity of material and process. (*L. R.*, 5 *H. L.* 1.)

*New Trial.***1078. LEWIS v. MARLING. [1829]**

New facts stated upon affidavit, which would be ground for repealing a patent by *scire facias*, will not be received on a motion for a new trial. (1 *Web. P. C.* 495.)

1079. WALTON v. POTTER. [1841]

Where the judge has left to the jury the specific issues raised on the record, and refused to put to them certain questions of fact, suggested by the defendant's counsel:—Held, no misdirection, or ground for a new trial.

Seemle, such questions can only be asked with the consent of all parties, and the jury are not bound to answer them. (11 *L. J.*, *C. P.* 138.)

*Costs.***1080. GILLETT v. WILBY. N. P. [1839]**

In an action for the infringement of a patent three pleas were pleaded: 1st, the general issue; 2nd, that the alleged

improvements were not new; and 3rd, that the plaintiffs were not the true and first inventors of the improvements:—Held, that the validity of the patent might be considered as having come in question under the second plea, so as to entitle the plaintiff to a certificate to that effect, under the 3rd section of the statute 5 & 6 Will. 4, c. 83. (1 *Web. P. C.* 270; 9 *C. & P.* 334.)

1081. LOSH v. HAGUE. [1839].

Where a defendant, in an action for the infringement of a patent, succeeds on a plea which goes to the whole action, he will be entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff has succeeded, and of the issues found for him. The certificate given by the judge under the 5 & 6 Will. 4, c. 83, s. 5, should be as to the determination of each objection of which notice has been given, and not as to the issues. (5 *M. & W.* 387; 7 *D. P. C.* 495; 3 *Jur.* 409.)

1082. GILLET v. GREEN. [1841]

An action on the case for the infringement of a patent is within the operation of the 3 & 4 Vict. c. 24, s. 2; and notwithstanding the provisions of the stat. 5 & 6 Will. 4, c. 83, s. 3, the plaintiff, recovering only nominal damages, cannot have his full costs, or triple costs, without a certificate under the former act. After the taxation the judge has no power to grant a certificate. (7 *M. & W.* 347; 9 *D. P. C.* 219; 1 *Web. P. C.* 271.)

1083. STOCKER v. RODGERS. N. P. [1843]

If, in an action for the infringement of a patent, the defendant plead not guilty, that the invention is not new, and that the specification is not sufficient; and the defendant at the trial consent to a verdict for the plaintiff, without any evidence being given, the judge will not certify under the stat. 5 & 6 Will. 4, c. 83, s. 3, “that the validity of the patent came in question before him.” (1 *C. & K.* 99.)

Erskine, J., said: "My certificate would affect third parties; and it would be possible, in a case like the present, for two parties, by collusion, to consent to a verdict in favour of a patent, and, if they could obtain a certificate under the 3rd section of the statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent." (*Ib.* 100.)

1084. NEWALL v. WILKINS. N. P. [1851]

After the plaintiff in an action for infringement has obtained a verdict, the record of a former trial, in which the patent was affirmed, is admissible to show that the plaintiff is entitled to treble costs. The defendant's case ought not to be prejudiced by the admission of the evidence upon the trial; but it ought to be proved subsequently. (17 *L. T. Rep.* 20.)

1085. HONIBALL v. BLOOMER. [1854]

In an action for the infringement of a patent, the 43rd section of the 15 & 16 Vict. c. 83, makes the certificate of the judge who tried the cause, that the defendant's particulars of objections have been proved by the defendant, a condition precedent to his right on taxation to any costs in respect of such particulars, even in the case of a nonsuit. (10 *Exch.* 538; 1 *Jur.*, N. S. 188; 24 *L. J.*, *Exch.* 11.)

Pollock, C. B., said: "With respect to the costs of the issues, there is no doubt that, where the plaintiff is nonsuited, the defendant is entitled to all the costs of the issues, that is to say, of the pleadings and evidence necessary to support them. But as these particulars are the creatures of this statute, and the costs of this particular class of proceedings are declared by the legislature to be no part of the general costs of the cause, and that in the absence of a certificate they shall not be recoverable, they are not recoverable." (10 *Exch.* 542.)

1086. GREAVES v. THE EASTERN COUNTIES RAILWAY COMPANY. [1859]

In an action for the infringement of a patent, defendants delivered, with their pleas, particulars of objections, pursuant

to stat. 15 & 16 Vict. c. 83, s. 41. The plaintiff having abandoned his action before trial:—Held, that the defendants were entitled to the costs of the particulars and of the evidence in support of them, for sect. 43 does not apply, so as to limit the ordinary right to costs, except when the cause comes on for trial. (1 *Ell. & Ell.* 961; 28 *L. J.*, *Q. B.* 290; 5 *Jur.*, *N. S.* 733.)

Held, also, that the cause not having been tried, the defendant, under 6 Geo. 4, c. 50, s. 34, was not entitled to the costs of a special jury applied for by him. (*Ib*)

1087. *BOVILL v. HADLEY.* [1864]

The 43rd sect. of the 15 & 16 Vict. c. 83, enacts, that it shall be lawful for the judge before whom an action for infringing letters patent shall be tried, to certify on the record that the validity of the patent came in question; and that “the record, with such certificate, being given in evidence in any suit or action for infringing the said letters patent,” shall entitle the plaintiff, on obtaining final judgment, to “his full costs, charges and expenses, taxed as between attorney and client,” unless the judge shall certify that he ought not to have such full costs.

An action having been brought by a patentee (substantially) for the recovery of royalties under a due licence, a compromise was entered into before the plaintiff’s case was closed, and an order of nisi prius was drawn up, under which the defendant was to pay an agreed sum, and a verdict was to be entered for the plaintiff in the action, for 40s. damages, and costs, with all “usual certificates.” After the cause was thus disposed of, the presiding judge, upon an *ex parte* application, indorsed on the record a certificate that the record in a certain action wherein *Bovill* was plaintiff and *Keyworth* was defendant, and the certificate thereon indorsed, was given in evidence at the trial of this action:—Held, that this certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being under the circumstances a “usual certificate” within the contemplation of the parties. (17 *C. B.*, *N. S.* 435; 10 *L. T. Rep.*, *N. S.* 650.)

1088. CURTIS v. PLATT. [1864]

The defendant obtained further time to plead, on the terms that the cause should be put down for trial before issue joined, and that short notice of trial should be taken. The pleas were delivered, and the plaintiff had a special jury nominated, but not struck. The action was then discontinued before issue joined or notice of trial given:—Held, that the circumstances of the case did not authorize a departure from the general rule, that costs incurred before notice of trial shall not be allowed. (33 *L. J.*, *C. P.* 255; 10 *Jur.*, *N. S.* 823; 10 *L. T. Rep.*, *N. S.* 383.)

Willes, J., said: “With respect to the second ground, it is contended, that as notice of objection is delivered with the pleas, the expenses incurred in preparing these objections ought to be allowed as accessory to these objections. But I am not satisfied that these expenses were connected with the objections; one instance given has been the looking into specifications of patents of a similar character; but the validity of such a claim would depend on whether the defendant knew, when he delivered the objections, the particulars of the invention, or whether he was merely making speculative inquiries. I have strong doubts whether such expenses should be allowed at all.” (10 *Jur.*, *N. S.* 823.)

1089. ELLWOOD v. CHRISTY. [1865]

In an action for the infringement of a patent, the plaintiffs claimed in their declaration a writ of injunction, and an account to be taken of all profits. The plaintiffs having obtained a verdict on all the issues, a rule *nisi* was obtained for the master to take an account of all profits made by the defendants. The defendants, on showing cause, made an affidavit stating what profits they had made. The court made the rule absolute on the terms that, if the plaintiffs should not succeed in surcharging the account stated in the affidavit by one-sixth, they were to pay costs of the rule and inquiry. (13 *W. R.* 498.)

*Account.***1090. HOLLAND v. FOX.** [1854]

In an action for the infringement of a patent, plaintiff obtained a verdict for 40s. damages. Afterwards he obtained a rule, absolute in the first instance, ordering defendant to render an account of all the articles which he had before and since the commencement of the action made or sold in breach of plaintiff's patent, and pay to plaintiff the moneys received for such articles. A rule nisi was obtained, on the part of the defendant, to discharge this rule. By the affidavits it appeared that defendant had made profits by the sale of the pirated articles since the commencement of the action ; but that he had discontinued the manufacture since the verdict and before the plaintiff's rule was obtained. And it appeared that, shortly after the action commenced, plaintiff's attorney had told the other side that plaintiff would take only nominal damages, and would, if necessary, file a bill in equity to obtain an account of the profits:—Held, that the action was still pending, so as to give this court jurisdiction under the Patent Law Amendment Act, 1852, sect. 42.

Held, also, that there having been a verdict with damages, and there being no continuing piracy such as would give ground for an injunction, no account of profits before action could be ordered ; but, held, that the defendant might be considered as trustee for the plaintiff of those profits which he had made, pending the action, after notice that plaintiff would require them ; and that an account of those profits might be ordered. The practice of the equity courts followed. (3 *ELL.* & *B.* 977 ; 2 *C. L. R.* 1576 ; 1 *Jur.*, *N. S.* 13 ; 23 *L. J.*, *Q. B.* 357.)

1091. VIDI v. SMITH. [1854]

Pending an action for infringement of a patent for an invention, plaintiff obtained, under the Patent Law Amendment Act, 1852, a rule *nisi* that defendant should render on oath an account of the sale of the articles (alleged to be pirated) sold

before the action, and of the profit made therefrom ; and keep an account of the articles to be sold and of the profit therefrom. The rule was drawn up on an affidavit that plaintiff had the patent, and that defendant had infringed it after notice. Cause being shown :—Held, that no retrospective account of profits made by sales before the action ought to be ordered before final judgment, and so much of the rule was discharged.

Held, also, that the court had jurisdiction to order an account to be kept in future, though no injunction was asked for, it appearing that there was a *primâ facie* case of infringement : and the court ordered that the rule should be absolute for such an account, on condition that the plaintiff elected not to claim damages at the trial, and undertook, if he failed in the action, to pay defendant the expense of keeping the account so ordered. (3 *Ell. & B.* 969 ; 2 *C. L. R.* 1573 ; 1 *Jur., N. S.* 14 ; 23 *L. J., Q. B.* 342.)

LISTER *v.* EASTWOOD. [1855] See 1045.

1092. TROTMAN *v.* WOOD. [1864]

The jury, in an action against the defendants for non-payment of royalties and for an account, found that the defendants had used a part of the plaintiff's invention :—Held, that the plaintiff was entitled to an account. (16 *C. B., N. S.* 479.)

1093. ELLWOOD *v.* CHRISTY. [1865]

The court will only direct an account to be taken, under the 42nd section of 15 & 16 Vict. c. 83, of the profits which have been actually made by the defendant, and not of the *loss which the plaintiff has sustained by the infringement* ; and, in the case of an assignee of the patent, the account will only be taken from the date of the registration of the assignment under sect. 35. (18 *C. B., N. S.* 494 ; 34 *L. J., C. P.* 130 ; 13 *W. R.* 498.)

1094. SAXBY *v.* EASTERBROOK. [1872]

An account will be granted as soon as the verdict is given, and the defendant cannot refuse to allow his books to be

inspected, for the purpose of taking an account, on the ground that he is about to appeal. (*L. R.*, 7 *Exch.* 207; 42 *L. J.*, *Exch.* 113.)

Damages.

1095. *ARKWRIGHT v. NIGHTENGALE.* N. P. [1785]

When a patentee, who has failed to establish his right under the patent upon a former occasion, sues for damages for an alleged infringement, the defendant is allowed to give evidence to show to what extent persons have acted upon the faith of the former verdict. (*Dav. P. C.* 55; 1 *Web. P. C.* 61.)

Consolidation of Actions.

1096. *THOMAS v. WINTER.* [1867]

The defendant was one of twenty-six against whom the plaintiff brought separate actions for infringement of the patent of a sewing-machine. A consolidation order was made by consent, and the plaintiff was authorized to select one action for trial, the defendants undertaking to be bound and concluded by the result of that action. Provision was made by the order for security for plaintiff's costs in case of an appeal. In the case selected by the plaintiff the decision both at the trial and in banc were in favour of the plaintiff, and the defendant neglected to prosecute an appeal to the Exchequer Chamber:—Held, upon application by the present defendant, who was not in the action tried, to be allowed to carry the case decided to a superior court,—that the fact of the neglect to appeal was not sufficient ground for the court's exercising its equitable jurisdiction, in amending or revoking the consolidation order. (17 *L. T. Rep.*, N. S. 148.)

*Threatening an Action for Infringement.***1097. WREN v. WEILD.** [1869]

Rule to set aside a nonsuit. The declaration contained counts to the effect that the plaintiffs made and sold spooling-machines, and that the defendant falsely and maliciously wrote to persons in treaty with the plaintiffs for such machines that they were infringements of a patent of the defendant's, and that if they were used, he would claim royalties for their use, and, if not paid, take legal proceedings; in consequence of which the plaintiffs lost the sale of their machines. There was no allegation that the defendant did this without reasonable or probable cause, nor, except indirectly, that the defendant had any patent. Plea, not guilty, and issue thereon. At the trial the plaintiffs, after proving the facts stated in the declaration, tendered evidence to show that the defendant's patent was void for want of novelty, that the defendant himself knew the facts which would render his patent void, and that the plaintiffs' machines were no infringement of the defendant's patent.

Lush, J., was of opinion that, inasmuch as the defendant's patent was still subsisting and not set aside on *scire facias* or otherwise, this evidence was immaterial. A rule for a new trial was subsequently discharged, when it was held, (1) that the evidence in question was immaterial to the issue raised; and (2) that the action would not lie unless the plaintiffs could affirmatively prove that the defendant's claim was made *malâ fide*. (*L. R.*, 4 *Q. B.* 730; 38 *L. J.*, *Q. B.* 327; 20 *L. T. Rep.*, *N. S.* 1007.)

Blackburn, J., in delivering the judgment of the court, said: "The advisers of the plaintiffs seem to have thought it was enough to maintain this action to show that the defendant could not really have maintained any action, and that, if well advised, he would have been told so, so as in this action indirectly to try the question whether an action for the infringement of the patent could have been maintained; whilst, as we think, the action could not lie unless the plaintiffs affirmatively proved that the defendant's claim was not a *bonâ fide* claim in support of a right which, with or without cause, he fancied he had, but

a *malâ fide* and malicious attempt to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation." (*L. R.*, 4 *Q. B.* 737.)

1098. ROLLINS v. HINKS. Ch. [1872]

There is no presumption in law in favour of the validity of a patent, and therefore a patentee is not entitled to publish statements of his intention to institute legal proceedings, in order to deter persons from purchasing alleged infringements of his patent, if he has no *bonâ fide* intention to follow up his threats by taking such proceedings, and the court will in such case restrain him from making such publication. (*L. R.*, 13 *Eq.* 355; 41 *L. J.*, Ch. 358.)

A person alleging the invalidity of a patent is not bound to assert his claim by *scire facias*, in order to establish his right to restrain the publication of statement by the patentee, threatening with legal proceedings persons buying articles of his manufacture alleged to be infringements of the patent. (*Ib.*)

CLARK v. ADIE. Ch. [1873] See 845.

1099. AXMANN v. LUND. Ch. [1874]

The court will restrain a patentee from issuing circulars threatening legal proceedings against infringers, unless he will undertake to commence proceedings to assert the validity of his patent; and the fact that the party seeking the aid of the court was formerly a licensee of the patent under the patentee, and had himself concurred in issuing similar circulars, does not prevent the court interfering after the expiration of the licence. ROLLINS v. HINKS followed. (*L. R.*, 18 *Eq.* 330.)

SUIT IN EQUITY.

Parties to the Action.

1100. WESTHEAD v. KEENE. [1838]

Where a company had been formed for the purchase of the plaintiff's patent, and no written contract had been signed, and no assignment had been executed by the plaintiff, but the company claimed some equitable interest in the patent, a demurrer to a bill, to which the company had been made defendants, on the ground of misjoinder of parties, was overruled. (1 *Beav.* 287.)

1101. DAVENPORT v. RICHARDS. [1860]

Where one only of several joint-owners of a patent, amongst whom any damages recovered would be divisible, is made the plaintiff, the bill, if not demurred to, is sufficient. (3 *L. T. Rep.*, *N. S.* 503.)

1102. RENARD v. LEVINSTEIN. [1865]

An exclusive licensee of a patent has a right to use the name of the patentee to restrain any infringement of the patent, and an interlocutory injunction for that purpose will, in a proper case, be granted. (2 *H. & M.* 628.)

1103. BETTS v. NEILSON. [1865]

Where the principals of a firm, which had infringed a patent, were out of the jurisdiction, and not amenable to the process of the court, the court restrained the managers who, though out of the jurisdiction, had appeared to the bill. (6 *N. R.* 221.)

1104. HASSALL v. WRIGHT. [1870]

The assignee of a patent may maintain a suit against the assignor, and subsequent licensees from the assignor with notice of the assignment, to restrain them from using the patent, although at the time of the institution of the suit the assignment has not been registered. *Seemle*, that registration of the assignment of a patent relates back to the date of the assignment, so as to entitle the assignee to maintain a suit to restrain an infringement instituted between the dates of the assignment and the registration. (*L. R.*, 10 *Eq.* 509; 18 *W. R.* 821.)

1105. ADAMS v. NORTH BRITISH RAILWAY COMPANY. [1873]

To a bill stating an agreement made between a general agent of the patentees of an American invention to introduce and sell the invention in Great Britain and the plaintiff, whereby the plaintiff was to have the sole agency and control of the working of the patent in England upon certain terms, including a share of royalties and profits, praying for an account for damages, and an injunction to restrain future infringements, the defendants, who were alleged to be using the invention, demurred:—Held, that the plaintiff was a mere agent for the sale of the invention, and was in no such position as gave him the right to file such a bill, which was in the form of a patentee's bill for infringement. (29 *L. T. Rep.*, *N. S.* 367.)

Pleading.

1106. KAY v. MARSHALL. [1836]

It is sufficient for the plaintiff to state on the face of the bill that he has done all that is required by the patent, and it is unnecessary for him to set out the specification.

An order, that a general demurrer to a bill should stand over, with liberty to the plaintiff to bring an action to try the validity of the patent, discharged, on the ground that it is too

great a departure from the practice of the court, and too inconsistent with the nature of the question before the court upon a demurrer, to be supported. (2 *Web. P. C.* 39; 1 *M. & C.* 373.)

1107. KAY v. MARSHALL. M. R. [1836]

Motion for leave to file a double plea. The bill was filed to restrain the infringement of the plaintiff's patent. The defendants disputed the validity of the patent on the grounds that so far as the invention was new it was useless, and that so far as it was useful it was not new. Leave granted. (1 *Keene*, 190.)

A defendant may file a single plea without an application to the court, but he cannot put in a double plea without that application and leave granted by the court. (*Ib.* 197.)

1108. WESTHEAD v. KEENE. [1838]

A bill filed by a patentee, to restrain the piracy of his patent and for an account, did not distinctly state the specification, or explain the nature of the invention for which the patent right was claimed; but it alleged that the specification was duly enrolled and that the drawings and description in the specification could not be set out in the bill, and it charged that the plaintiff was the inventor and that the invention was new. The court (not without some doubt) held, on the authority of *Kay v. Marshall*, that the bill was not demurrable. (1 *Beav.* 287; 2 *Web. P. C.* 36 (n).)

If a party have a defence beyond the record, he may plead it, or he may put in a short answer, admitting the facts stated by the plaintiff, but denying the plaintiff's right. (*Ib.*)

1109. CURTIS v. CUTTS. [1839]

Where a bill is filed to restrain the infringement by the defendant of letters patent, a sufficient case to justify the injunction must be stated by the plaintiff on the face of the bill, and he must not depend solely on the admissions contained in the defendant's answer for the granting or continuing of the

injunction. If the answer deny the invention to be new, and also the enjoyment under the letters patent, and state (as is the fact) that the specification is imperfectly set forth in the bill, the court will dissolve an injunction previously obtained, on affidavit, giving the plaintiff liberty to bring an action, although the defendant admits by his answer that he has made machines upon the principle comprised in the letters patent. (8 *L. J., Ch.* 184.)

1110. YOUNG v. WHITE. [1853]

The plaintiffs, who were the owners of a patent for obtaining oil from bituminous coal, charged the defendants with an infringement of their patent. The bill stated the patent and the specification, and also referred to various publications and other means by which it had obtained notoriety, in the whole of which J. Y., one of the plaintiffs, was represented as the inventor; and, after alleging that such would appear if the defendants answered the bill, the plaintiffs sought to obtain a discovery, not only of the plaintiffs' trade, but also of the processes they used in their manufacture. To this bill the defendants put in a plea, that J. Y. was not the first and true inventor, and, except as to the discovery, they answered such parts of the bill as were not covered by the plea:—Held, upon this plea, that the facts, which could not be laid before a jury as evidence in an action at law, brought by the plaintiffs, under an order of this court, for an infringement of their patent, were covered by the answer, but that, if other defences had been set up, the defendants might have been compelled to answer the other parts of the bill; and the plea was allowed, but leave was given to amend the order under which the action was brought, that the issue at law might be confined to the sole defence raised by this plea. (23 *L. J., Ch.* 190.)

DE LA RUE v. DICKINSON. [1857] See **1124.**

1111. SARAZIN v. HAMEL. [1863]

Whether, under a bill to restrain the infringement of a patent, it is necessary to allege that the patentee has duly paid the

instalments of stamp duties necessary to keep the patent alive, under the 16 & 17 Vict. c. 5, s. 2, *quære*. (32 *Beav.* 145.)

1112. AMORY v. BROWN. [1869]

In a bill to restrain an infringement of a patent, an express averment of the novelty of the invention protected by the patent is not necessary. (*L. R.*, 8 *Eq.* 663; 38 *L. J.*, *Ch.* 593.)

Sir W. M. James, V.-C., said: "I was at first struck at the absence of an averment as to the novelty of the invention, and I doubted whether such an averment was not necessary to support a bill in restraint of an infringement of a patent. But on looking at the form of a declaration at law for damages for the infringement, I find that it contains no allegation of the novelty of the invention. The allegation of the grant and production of the letters patent throws upon the defendant the *onus* of disputing the novelty, and therefore I think the bill sufficient without it."

Affidavits.

1113. HILL v. THOMPSON. [1817]

The affidavit in support of an injunction to restrain an infringement should state particularly in what the alleged infringement consists; and when the proportions mentioned in the specification are of the essence of the invention, it should state the defendant to have worked by them. (3 *Mer.* 624.)

When an injunction is applied for *ex parte*, it is incumbent on the party making the application to swear, at the time of making it, as to his belief, that he is the original inventor; for, although, when he obtained his patent, he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect. (*Id.*)

1114. HILL v. WILKINSON. [1817]

In the case of an alleged infringement of a patent, the injunction must be granted, or refused, according to the opinion the court may form after an examination of the affidavits. (2 *Coop.* 57 (n).)

1115. STURTZ v. DE LA RUE. [1828]

Lord Lyndhurst, L. C.: "There can be no doubt that, when a party comes for an injunction against the infringement of a patent, he ought to state that he believes, at the time when he makes the application, that the invention was new, or had never been practised in this kingdom at the date of the patent. It is not enough that it was believed to be new at the time when the patent was taken out." (5 *Russ.* 329.)

1116. BICKFORD v. SKEWES. [1837]

Injunction granted although, on account of the patentee being dead, there was no affidavit to the effect that he, at the time of application, believed himself to be the true and first inventor, and that the invention was new. (1 *Web. P. C.* 211.)

1117. STOCKING v. LLEWELLYN. [1842]

If there is any material variation between the allegations in the bill, or the aid sought by it, and the affidavits in support of the plaintiff's case, the injunction will be dissolved, with costs. (3 *L. T. Rep.* 33.)

1118. ELECTRIC TELEGRAPH COMPANY v. NOTT. [1847]

The court will, at any time previous to the hearing, postpone the hearing, in order to allow time for filing affidavits; but no affidavits filed after the hearing has begun may be read. (11 *Jur.* 273.)

1119. GARDNER v. BROADBENT. [1856]

A. B. in May, 1856, became the purchaser of a patent, which the defendant, as alleged, infringed subsequent to the

date of the purchase. A. B. obtained an injunction *ex parte* to restrain the defendant, on an affidavit in support, which stated that the patent had been recorded, and that it became and was good and valid. The court held this affidavit insufficient, and on that ground dissolved the injunction, with costs. (2 *Jur.*, N. S. 1041.)

Sir J. Stuart, V.-C., said: "When the plaintiff applied for an *ex parte* injunction, his affidavit ought to have stated clearly and distinctly that he believed the patentee, from whom he purchased the patent, was the original and true inventor, and that he believed that the invention had not been practised at the time when the patent was granted. That was necessary, because what the injunction asked for was, to protect a legal title, which legal title ought to be sworn to, and the facts supported before the court. The plaintiff was bound, in short, accurately to set forth his legal title to the invention in respect of which he claimed the protection of the court." (*Ib.*)

1120. WHITTON v. JENNINGS. [1860]

When a defendant to a bill filed for an injunction to restrain an infringement, or for leave to bring an action at law, stated by his answer that the invention was not novel, and that the plaintiff's patent was invalid, the court, on a motion by the plaintiff, without his having made an affidavit as to the novelty of the invention or validity of the patent, refused to grant him an injunction or to give leave to bring an action, unless he produced a clear and distinct affidavit that the invention was novel and the patent valid, but allowed the motion to stand over for that purpose. (1 *Dr. & S.* 110.)

1121. MAYER v. SPENCE. [1860]

In an injunction suit to restrain an infringement, a motion for leave to take proceedings at law ordered to stand over for the plaintiff to make an affidavit of his belief of his title to the patent, and of the alleged infringement. (1 *J. & H.* 87.)

1122. BETTS v. WILLMOTT. [1871]

The onus being on the plaintiff to show, not merely that the thing made is his own patented article, but that it has been unlawfully sold, he must be prepared to swear distinctly that it is not manufactured by him or his agent. The onus is then thrown upon the defendant. (*L. R.*, 6 *Ch.* 239; 25 *L. T. Rep.*, *N. S.* 188.)

*Interrogatories and Discovery.***1123. SWINBORNE v. NELSON.** [1853]

The plaintiff's right to discovery and to production rest on the same principle.

A defendant who submits to answer must answer fully; he cannot by denial of the plaintiff's title escape answering. Discovery of title deeds and of professional communications forms an exception.

The plaintiff and defendant had both patents for making gelatine. The plaintiff instituted his suit for redress against an alleged infringement of his patent, and the bill contained searching questions, requiring the defendant to set forth all the articles manufactured by him, the names and addresses of his customers, the prices and the profits, &c. The defendant denied all infringement. He said he had made his articles according to his own and not according to the plaintiff's patent, and he declined to give an account of such articles:—Held, that, notwithstanding his denial, he was bound to do so.

Dissent from the doctrine laid down in *Adams v. Fisher*, 3 *M. & C.* 526. (16 *Beav.* 416.)

1124. DE LA RUE v. DICKINSON. [1857]

When a defendant by his answer denies the fact of infringement, he is protected from making any discovery immaterial to that question, and which when that question is decided would be given under the decree. And it is not necessary to set up a defence of this nature by plea. (3 *K. & J.* 388.)

1125. HOWE v. M'KERNAN. [1862]

The plaintiff complained that the defendant had sold, under the plaintiff's name, sewing-machines which had not been manufactured by him, and he sought a discovery of all the machines sold by the defendant, the price, the profit, the names of the purchasers and other particulars. The defendant refused to answer, saying that he would thereby disclose the names of his customers and the secrets of his trade:—Held, that he was bound to answer. (30 *Beav.* 547.)

1126. FOXWELL v. WEBSTER. [1863]

The defendant will not be excused from answering fully, and at once, on the ground that the validity of the patent will require to be established by an issue. When separate bills have been filed against numerous defendants, the plaintiff is entitled to a separate answer from each defendant. (3 *N. R.* 103.)

1127. CROSSLEY v. STEWART. [1863]

In a suit to restrain infringement the defendants were required to set out the names and addresses of all persons from whom they had received sums of money for the use of articles alleged to be manufactured in infringement of the plaintiff's rights, even though such persons might reside abroad. (1 *N. R.* 426.)

1128. RENARD v. LEVINSTEIN. [1864]

In a suit to restrain the infringement of a patent for making dyes in a particular manner, the defendant denied that his process was an infringement, and alleged that his process was secret, and that his trade depended on keeping it secret:—Held, that he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials; but he was not bound to disclose the proportions in which he used the specified materials, or what the additional materials were. (3 *N. R.* 665; 10 *L. T. Rep.*, *N. S.* 94.)

1129. DAW v. ELEY. [1865]

Where the novelty of the invention is denied by the answer, the plaintiff has no right to a discovery of the particulars on which the defendant relies as showing a user of the thing patented prior to the date of the patent. (2 *H. & M.* 725.)

1130. BOVILL v. SMITH. [1866]

In a suit to restrain an infringement of a patent which is contested on the ground of anticipation by prior user, the plaintiff is not entitled to discovery from the defendant in answer to a general interrogatory as to the instances of prior user on which he relies. (*L. R.*, 2 *Eq.* 459.)

1131. HOFFMANN v. POSTILL. [1869]

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies that he who is bound to answer must answer fully.

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case; but a defendant may ask any questions tending to destroy the plaintiff's claim.

A defendant in a suit for infringement of a patent, in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in the specifications of previous patents, and asked him to show in what respect they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were not questions of fact, and that they related to the plaintiff's case; the defendant excepted to the answer, and the exceptions were allowed.

The plaintiff was required by interrogatories to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect

the correspondence, and that he had sufficiently set out the particulars of the infringement in his bill:—Held, that these answers were sufficient. (*L. R.*, 4 *Ch.* 673 ; 17 *W. R.* 901 ; 20 *L. T. Rep.*, *N. S.* 893.)

1132. MURRAY v. CLAYTON. *Ex parte* the Plaintiff: *Ex parte* the Defendants. [1872]

An injunction having been granted to restrain the infringement of a patent, with an inquiry as to damages, an order was made in chambers for an affidavit by the defendants as to the number of the patented machines sold by them, and the names and addresses of the purchasers and of the agents concerned in the transactions. They gave the number of the machines sold, but not the names of the purchasers. On an application by the plaintiff to consider the sufficiency of the affidavit, and another by the defendants to strike out of the order the words they objected to answer, unless the plaintiffs would undertake not to take proceedings against the purchasers:—Held, that the plaintiff was entitled to have discovery of the names and addresses of the purchasers, but not of the agents concerned, there being nothing to show that any agents had been employed. (42 *L. J.*, *Ch.* 191 ; *L. R.*, 15 *Eq.* 115.)

Inspection.

1133. BOVILL v. MOORE. [1815]

Lord Eldon: “ There is no use in this court directing an action to be brought if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article, and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by the plaintiff’s patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the

defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy at present is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine, and to see it work." (2 *Coop. C. C.* 56 (n).)

1134. BROWN v. MOORE. [1816]

Lord Eldon, referring to this case in *Kynaston v. The East India Company*, said: "I remember a case, where, on a suggestion that a machine used by the defendant was an infringement of a patent, the court ordered the defendant to allow an entry into his premises for the purpose of ascertaining by inspection whether the machine was an infringement." (3 *Swan.* 264.)

1135. RUSSELL v. COWLEY. [1832]

The court not only ordered that the plaintiff's witnesses should inspect the defendant's machinery at work, but that the defendant's witnesses should inspect the plaintiff's patented machinery at work pending an action for infringement, the object of the court being, to enable the parties to give the best evidence as to whether the defendant had been guilty of infringement or not. (1 *Web. P. C.* 458.)

1136. MORGAN v. SEAWARD. [1835]

The defendant was ordered to permit, after reasonable notice, an inspection of machinery made, or to be made, in pursuance of a certain contract. (1 *Web. P. C.* 169.)

1137. RUSSELL v. CRICHTON. [1837]

On motion by plaintiff for an order to inspect defender's works, the defender alleged that his manufacture involved a

secret process, the value of which would be lost, if inspection was allowed:—Held, that some inspection must be allowed, or else any patent might be infringed with impunity; and order pronounced for giving inspection of the works and manufacture of both parties, to certain viewers, at the sight of the sheriff, and for exhibiting the works in actual operation, so as to enable the viewers to give evidence at the approaching trial; the viewers being warned not to use any private information which they might acquire through that inspection, except for the purpose of so giving evidence. (*15 Dec. of Crt. of Sess.* 1270.)

1138. PATENT TYPE FOUNDRY COMPANY v. WALTER.
[1860]

The plaintiffs were owners of a type founding patent. The defendant was a printer, who used types alleged to be colourable imitations of the type patented by the plaintiff. On a bill for injunction:—Held, that the court had jurisdiction on motion to order the defendant to deliver a sample of type to the plaintiffs for analysis, and order accordingly.

Held, also, that laches sufficient to defeat the plaintiff's right to an interlocutory injunction was no bar to an order on the same motion for inspection and samples. (*John.* 727; 8 *W. R.* 353).

1139. DAVENPORT v. JEPSON. [1862]

Ordered that the plaintiffs and the defendant, Henry Jepson, by their solicitors and scientific witnesses, be at liberty, from time to time, upon giving three days' notice of their intention so to do, mutually to inspect the machines heretofore used by the plaintiffs and the said defendant in the manufacture of chenille, and that the same machines be put to work upon such inspection, and that the plaintiffs and the said defendant, by their said witnesses and solicitors, be at liberty to take samples of the chenille made or to be made upon the said machines.

And further ordered that the plaintiffs, by their solicitors and witnesses as aforesaid, be at liberty, upon the like notice, to

inspect the machines or exhibits marked, &c., produced by the said defendant, and referred to as exhibits in certain affidavits filed, &c., and to put the last-mentioned machines to work and to take samples of the produce thereof. (1 *N. R.* 307.)

1140. NEEDHAM v. OXLEY. [1863]

Where a patent for a combination of machinery only has been infringed, the court will not order the defendant's machines to be broken up, but will order them to be marked. (11 *W. R.* 852; 2 *N. R.* 388.)

1141. THE SINGER SEWING MACHINE COMPANY v. WILSON.
[1865]

Where the defendant deals in machines which are, as is alleged by the plaintiff, an infringement of his patent, the defendant will not be ordered, in a suit in respect of such infringement, to allow the plaintiff to inspect all the machines in his stock; but he will be directed to verify on affidavit the several kinds of machines that he has sold or exposed for sale, and to produce one machine of each class for inspection.

It is a matter of course to grant inspection where a *prima facie* case has been made out. (5 *N. R.* 505; 12 *L. T. Rep.*, *N. S.* 140.)

1142. PIGGOTT v. THE ANGLO-AMERICAN TELEGRAPH COMPANY. [1868]

Inspection refused where it would have disclosed important trade secrets, and, from the nature of the case, the plaintiff could have no difficulty in proving the nature of the alleged infringement used by the defendants. (19 *L. T. Rep.*, *N. S.* 46.)

Giffard, V.-C., said: "Of late years greater readiness has been shown by the equity courts to allow inspection in patent cases than by the courts of common law. But it has never been considered as a matter of right, nor have the equity courts considered themselves as precluded from exercising a proper discretion in applications of this description. The court ought

to be satisfied of two things: that there really is a case to be tried at the hearing of the cause; and that the inspection asked for is of material importance to the plaintiff's case, as made out by his evidence." (*Ib.*)

1143. NEILSON v. BETTS. H. L. [1871]

Where, as in ordinary cases, the duty of establishing that the thing patented has been pirated lies on the patentee, courts of equity grant limited orders of inspection for the purpose of enabling him to discharge that duty. Such orders cannot be granted where the piracy alleged has taken place abroad. (*L. R.*, 5 *H. L.* 1.)

*Injunction—Validity of Patent—Uninterrupted
Enjoyment.*

1144. HICKS v. RAINCOCK. [1783]

Demurrer to a bill, for an injunction to stay the infringement of a patent right, that the plaintiff had not established his right at law, overruled. (2 *Dick.* 647.)

1145. BOULTON v. BULL. [1796]

Injunction granted, where patentee had been in possession for twenty-seven years, that the question as to the validity of the patent might be tried. There was a verdict for the plaintiff, subject to the opinion of the court upon a case stated. The court was equally divided in opinion as to the validity of the patent:—Held, that the injunction should be continued until another action was brought. (3 *Ves.* 140.)

**1146. THE UNIVERSITIES OF OXFORD AND CAMBRIDGE v.
RICHARDSON.** [1802]

Injunction granted or continued to the hearing, though the patentee's legal title be doubtful.

Lord Eldon said: "It is then said, in cases of this sort the universal rule is, that, if the title is not clear at law, the court will not grant or sustain an injunction, until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory, in which this court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called possession under it; however doubtful it may be, whether the patent can be sustained, this court has lately said, possession under a colour of title is ground enough to enjoin, and to continue the injunction, till it shall be proved at law, that it is only colour and not real title." (6 *Ves.* 706.)

1147. HARMER v. PLAYNE. [1807]

Injunction granted, where the patentee had been in possession under the patent for thirteen years, until the right was tried at law; although considerable doubt existed as to the validity of the patent. (14 *Ves.* 130.)

Lord Eldon: "The ground upon which, where doubt is excited in the mind of the court, an injunction is granted, until the legal question can be tried, a ground that was acted upon in the case of Boulton and Watt, in some cases preceding that and some that have occurred since, is this: where the Crown on behalf of the public grants letters patent, the grantee, entering into a contract with the Crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under colour of the patent, the court has thought, upon the fact of that possession, proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard, that the grant of the Crown may in the result prove to have been valid. The question is not really between the parties upon the record; for, unless the injunction is granted, any person might violate the patent; and the consequence would be, that the patentee must be ruined by litigation. In the case of Boulton and Watt, therefore, though a case of

great doubt, upon which some of the ablest judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentee against all mankind, the injunction was granted, until the question could be tried." (*Ib.* 131.) "I do not say a case might not exist where possession might be distinctly proved, and yet there might be such strong doubt whether the specification was not bad in law, that the court would *brevi manu* interfere, and put an end to the injunction." (*Ib.* 133.)

1148. GEORGE v. BEAUMONT. [1815]

An injunction obtained on the grounds that the party, under pretence of treating with the patentees for a licence, had watched the process, and then practised it without a licence, will be dissolved if the validity of the patent be doubted, and an account will be ordered to be kept of the extent to which the invention has been practised, until the validity of the patent can be tried at law. (27 *Rep. Arts*, 2nd Series, 252.)

1149. HILL v. THOMPSON. [1817]

Where there has been a length of exclusive enjoyment under a patent, the court will grant an injunction in the first instance, without previously putting the party to establish his right at law. Otherwise where the patent is recent and its validity is disputed. Sometimes the court will direct the party, against whom the application is made, to keep an account pending the discontinuance of the injunction. (3 *Mer.* 622.)

The injunction having been dissolved, with liberty to the plaintiff to bring an action to establish his patent right, and the defendants to keep an account in the meanwhile; a verdict having been obtained for the plaintiff on the trial of the action, on application being made to revive the injunction, it was objected that the defendants intended to move for a new trial; and the matter was ordered to stand over till the result of that application should be known, the parties continuing to keep the account in the interim. (*Ib.* 631.)

HILL v. WILKINSON. [1817] See 1114.

1150. RUSSELL v. BARNSELY. [1834]

The fact of the pendency of an action against another party, is not a sufficient ground for continuing an *ex parte* injunction, without putting the plaintiff to bring an action against the new defendant. (1 *Web. P. C.* 472.)

1151. RUSSELL v. COWLEY. [1834]

Lord Lyndhurst: This court having directed a trial at law, and the jury having found for the patentee, and a motion that the verdict should be set aside and a nonsuit entered having failed, it is quite of course that an injunction should be issued until the hearing of the cause. (2 *Coop. C. C.* 59 (n.).)

1152. MORGAN v. SEAWARD. [1835]

Where the plaintiff is assignee of the patent the court may, on directing a trial instead of granting an injunction, order the defendant to admit the plaintiff's title to the patent. (1 *Web. P. C.* 169.)

1153. KAY v. MARSHALL. [1836]

Lord Cottenham, L. C., said: "The equitable relief flows from the legal title, and the question is whether, upon the statements in the bill, the court can take upon itself to decide that the plaintiff has no legal title. If the plaintiff, asking for equitable relief upon the ground of a legal title, states upon his bill a title which cannot be supported at law, the defendant may take advantage of it by demurrer; but if the plaintiff states himself to stand in the position of having so far established his title at law as to give him at least a *primâ facie* title, this court will so far give credit to such circumstance as to afford him the aid of its jurisdiction until the suit shall be in such a state as to call upon the court for a decision, or to direct such proceedings as may be necessary to complete the investigation of the right at law. . . . If a plaintiff comes here for equitable relief, after he has established his right at law against the defendant, the court will not withhold its assistance because it may doubt or disapprove the decision at law." (2 *Web. P. C.* 42.)

1154. LUKIE v. ROBSON. [1837]

An *ex parte* injunction having been obtained, and suffered to go undisturbed for two years, and the specification appearing free from obscurity and the evidence of novelty sufficient:—Held, that the court could not be doing wrong in upholding the injunction. (9 *Rep. Arts, N. S.* 55.)

1155. BICKFORD v. SKEWES. [1838]

Shadwell, V.-C.: “Whatever may be the objection to the specification, this court is bound to look to the fact that there has been an enjoyment under the patent, as a sort of practical answer to the theoretical objection.” Interlocutory injunction granted after enjoyment for six years. His Lordship, however, said: “I admit that if you were to say six years are sufficient, you may, by cutting off successive portions, reduce the six years to nothing. But I have nothing to do with any other case than the case before me.” (1 *Web. P. C.* 213.)

1156. COLLARD v. ALLISON. [1839]

Although a patent is of long standing, yet if, from the nature of the alleged invention, or the conflicting evidence as to its novelty, its validity appears to be doubtful, or if the evidence of exclusive possession is not satisfactory, the court will not grant an injunction until the title has been established at law.

After the patentee had obtained a verdict in an action brought to try the validity of the patent, the court refused to grant an injunction to restrain the infringement of the patent, on the ground that a rule *nisi* for a new trial had been obtained and was pending in the court of law, and that the legal title of the patentee was therefore still undecided. (4 *M. & C.* 487.)

1157. CURTIS v. CUTTS. [1839]

Lord Cottenham: “The rule upon which the court acts in granting an injunction, where the validity of the patent alone is disputed, requires, not merely that there shall have been possession and enjoyment under the patent, but such possession

and enjoyment must have been undisturbed and exclusive.” (2 *Coop. C. C.* 60 (n.).)

1158. BICKFORD v. SKEWES. [1839]

When the court has interfered, in aid of a legal right, by granting an injunction upon the terms of the plaintiff's bringing an action, it will deprive the plaintiff of the injunction if he does not commence and proceed with his action with due promptness; but it will not do this if the defendant has been supine in the cause. (4 *My. & Cr.* 498; 8 *L. J., Ch.* 188.)

1159. NEILSON v. HARFORD. [1841]

Where the plaintiff is directed to proceed at law, in order to try the validity of his patent, and obtains judgment, an injunction is allowed almost as a matter of course. (1 *Web. P. C.* 373.)

1160. NEILSON v. FORMAN. [1841]

The legal right of a plaintiff ought to be established beyond all possibility of doubt before the court will be justified in granting an injunction, which, by stopping extensive works, will do a mischief to the defendant that, if the plaintiff do not succeed, can never be repaired. (2 *Coop.* 61 (n.).)

1161. MUNTZ v. GRENFELL. [1842]

Per Knight Bruce, V.-C.: The patent having been worked by the plaintiff and defendant as partners, under circumstances affording a presumption that the defendant did not, during the existence of the partnership, dispute that the patent was valid, the Court of Chancery will, upon an interlocutory application for an injunction, assume that the patent is valid. (2 *Coop.* 61 (n.).)

1162. MUNTZ v. FOSTER. [1843]

Upon an appeal, from an order of Bruce, V.-C., for an injunction to restrain the infringement of a patent, Lyndhurst,

L. C., said: "The patentee has been in possession of his exclusive privilege for several (eleven) years, and the court will not, on any suggested defect of the specification, allow the enjoyment of that privilege to be disturbed until the title has been decided in a court of law." (2 *Web. P. C.* 95.)

1163. BRIDSON v. M'ALPINE. [1845]

Motion for an injunction to restrain an infringement ordered to stand over for the plaintiff to bring an action to establish his right. The plaintiff obtained a verdict, but the defendant tendered a bill of exceptions, which could not be determined without some considerable delay. Upon the motion being renewed, the court, under the circumstances, ordered it to stand over till the bill of exceptions had been disposed of. (8 *Beav.* 229.)

1164. DIRCKS v. MELLOR. [1845]

If the defendant admit the validity of the patent, the title of the plaintiff and its infringement by him, the court will at once issue its injunction with costs. (26 *Lond. Jour.* 268.)

HADDEN v. SMITH. [1847] See **1223**.

1165. HEATH v. UNWIN. [1847]

The plaintiff, having obtained a patent for an improved method of making steel by the application of carburet of manganese, brought an action against the defendant for infringing his patent by using two ingredients, which, when fused, would produce carburet of manganese. The Court of Exchequer held that the patent had not been infringed, either directly or indirectly, because the defendant was ignorant of the fact that he was using the same substance as that employed by the plaintiff. A motion for an injunction upon a bill filed prior to the action was now opposed, on the ground that the decision of the court of law was final, and the bill ought to be dismissed. The court considered that although the act was committed unconsciously, the defendant was liable for the injury

he had done, and consequently retained the bill, and gave liberty to the plaintiff to bring another action. (16 *L. J., Ch.* 283.)

1166. THE ELECTRIC TELEGRAPH COMPANY v. NOTT.
[1847]

As a general rule the court ought not to give its aid to the legal right by injunction unless satisfied, the legal right being disputed, that in the result such legal right will be established; or, the legal right not being disputed, that the acts complained of are a violation of it. There is an exception where the sole question is the validity of a patent, and there has been a user of the patent, and an exclusive enjoyment under it for a reasonable time. The court will in such a case interpose by injunction, until the validity of the patent has been ascertained by a trial at law. But where, though the validity of the patent is not disputed, yet there is conflicting evidence upon the question of infringement, the general rule applies, the court will not grant an injunction until it has been ascertained by a trial at law that there has been an infringement. (2 *Coop.* 41.)

1167. STEVENS v. KEATING. [1847]

Application to restrain defendant from infringing plaintiff's patent. Shadwell, V.-C., said: "I cannot but myself think, with reference to the very language that was used by my Lord Chancellor in the case of *Kay v. Marshall*, that where a patent has been taken out for several years, and there has been a dealing upon it, a user of it, that it is not, at the end we will say of twelve years, to be set aside merely because speculations may be made of more or less force upon its validity as regards the language of the specification. Now I cannot but myself think, therefore, that in this case there has been such a *prima facie* established legality of the plaintiff's patent, that it is the duty of the court to grant the injunction; but the plaintiff, of course, must be put to bring such action as will try the validity of the patent, and then the defendant will have the opportunity of trying the question fairly, and showing whether the specula-

tive objections to the specification or the case of the plaintiff shall prevail." (2 *Web. P. C.* 176.) Affirmed on appeal, Cottenham, L. C., said: "I have, in common with other judges, of whom Lord Eldon was one, frequently expressed my opinion, that in doubtful cases great care ought to be taken by this court not to grant an injunction which is at all likely to prove unfounded; because if it turns out to be unfounded, you are doing an irreparable injury to the party restrained, whereas by withholding it, you may be permitting some injustice, but certainly not an injustice at all equal to that which you are doing by improperly granting it. That rule, however, is confined to cases where there is a serious doubt in the mind of the judge as to whether the title to the injunction is made out or not, for if the court sees that there is a clear case for an injunction, it would be absurd to say, go to law and prove that which you have already proved here, before I grant an injunction. In patent cases, however, a rule steps in which is quite consistent with the general rule to which I have just referred, and, indeed, is only an instance of the exception which a correct statement of that rule must always include, viz., that long and uninterrupted possession shall be considered such *prima facie* evidence of title as to justify the court in protecting the patent right by an injunction until its invalidity, if it be invalid, shall have been established by an action at law." (2 *Ph.* 335; 2 *Web. P. C.* 177.)

1168. CROSSKILL v. EVORY. [1848]

Though a patentee has enjoyed his patent for a considerable time, and has succeeded in several actions for an infringement thereof in upholding his patent, and has obtained injunctions restraining the parties so infringing, yet, if there be a new infringement by a different party, an injunction to restrain him will not be granted till after a trial at law, however palpable the infringement by the party may be. (10 *L. T. Rep.* 459.)

1169. BRIDSON v. BENECKE. [1849]

The plaintiff having been put to establish his legal right, succeeded on the trial, but the defendants tendered a bill of

exceptions. An injunction was granted, under the circumstances, before the bill of exceptions had been disposed of. (12 *Beav.* 1.)

1170. PIDDING v. FRANKS. [1849]

Where the court directs an action, instead of granting an injunction, against the equitable assignee of a patent, it will not exact from the defendant any admission as to the validity of the patent. (1 *Mac. & G.* 56.)

1171. CALDWELL v. VANVLISSENGEN. [1851]

Injunction granted against subjects of the kingdom of Holland, to restrain them from using on board their ships within the dominions of England, without the licence of the plaintiffs, an invention, to the benefit of which the plaintiffs were exclusively entitled under the Queen's patent, the title of which had been maintained at law against several attempts to impeach it. Where a legal right exists, the court cannot refuse to interfere for its protection, upon grounds which depend exclusively on considerations of national policy. (9 *Hare*, 415; 21 *L. J., Ch.* 97; 16 *Jur.* 115.)

Turner, V.-C.: "It is part of the duty of this court to protect property pending litigation; but when it is called upon to exercise that duty, the court requires some proof of title in the party who calls for its interference. In the case of a new patent, this proof is wanting: the public, whose interests are affected by the patent, have had no opportunity of contesting the validity of the patentee's title, and the court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoyment under the patent (the enjoyment of course including use), the public have had the opportunity of contesting the patent; and the fact of their not having done so successfully affords, at least *primâ facie*, evidence that the title of the patentee is good; and the court therefore interferes before the right is established at law." (9 *Hare*, 424.)

1172. BAXTER *v.* COMBE. Ir. Ch. [1851]

On a motion for an injunction to restrain the infringement of a patent, an order was made that the motion should stand until the plaintiff brought an action at law. There was a verdict for the plaintiff, and the defendant tendered a bill of exceptions, pending which the motion was renewed; the court granted an injunction, the plaintiff undertaking to abide any order which the court might make, by directing an issue, or otherwise, to ascertain the damage, if any, which the defendant should sustain by obeying the order, in case the defendant should obtain judgment in the action at law. (3 *Ir. Ch. R.* 245.) The Right Hon. T. B. C. Smith, M. R., said: "I think it is the duty of a judge, in considering a case of this kind, to see whether the defence set up is a mere legal one, beside the merits of the case: and although he must be cautious, and take care that no injustice is ultimately done to the defendant by granting the injunction, yet he is bound, when he has, as in this case, legal authority as high as that of any judge in either country on the only question in the case—that question being merely a legal one, and altogether beside the merits—not to allow the defendant, during the next four months, to go on making and selling these machines, and to appropriate still further to his own use the benefit and advantage of the plaintiff's invention, on the ground that the wording of the patent goes too far, and patents a principle, and is not confined to what was undoubtedly the invention of the plaintiff." (*Ib.* 252.)

1173. BROWN *v.* KIDSTONE. [1852]

The patent was not obtained for Scotland till some months after it had been obtained for England. In the interval a description of the invention had appeared in a magazine circulated in Scotland:—Held, that this publication created such a *prima facie* objection to the patentee's title, that he could not interdict parties in Scotland alleged to be using the invention without a licence. (1 *S. M. & P.* 769.)

1174. NEWALL v. WILSON. [1852]

Where a patent had been in force for twelve years, and had been the subject of four suits against different persons, all of which terminated favourably to the patentee, and in two of which verdicts had been given in favour of the validity of the patent:—Held, that in a fifth case, the patentee was entitled to an injunction pending the trial of the legal right, although a fresh fact was brought forward, tending to impeach the novelty of the invention. (2 *De G., M. & G.* 282.)

1175. HANCOCK v. MOULTON. [1852]

Length of time and uninterrupted enjoyment of a patent give a colour of right even where there has not been a trial at law. The court ought not to grant an injunction to restrain an infringement of a patent before a trial at law, unless the evidence of infringement be such that the court would on the same evidence commit the defendant for a breach of the injunction. (*M. Dig.* 506.)

1176. FLAVELL v. HARRISON. [1853]

Plaintiff made kitchen ranges which he called “Flavell’s Patent Kitcheners,” but he had not obtained any patent. The court refused to restrain the defendant from selling ranges under the same name until the plaintiff had established his right at law. (1 *W. R.* 213; 17 *Jur.* 368.)

1177. LISTER v. EASTWOOD. [1855]

Where a patentee had brought an action for damages, and at the trial an arbitration had been agreed to, upon which the arbitrator by his award had established the validity of the patent, and the patent had been again invaded; the court, upon a bill filed for an injunction to restrain the infringement, held, that the award of the arbitrator must be considered as equivalent to a verdict establishing the validity of the patent, against which there had been no motion for a new trial. (26 *L. T. Rep.* 4.)

1178. GARDNER v. BROADBENT. [1856]

Sir J. Stuart, V.-C., said: "If the plaintiff is in a position to support by proper evidence his title to the patent, and to prove the fact of its having been infringed, he is in every other respect, in spite of the recency of its date (1855), entitled to move in this court *ex parte* for an injunction. . . . There is no law of this court which prevented a patentee by the recency of his patent from applying for an injunction *ex parte*; and I wish it to be understood that the law of the court is that laid down by Lord Eldon in the case of *The Universities of Oxford and Cambridge v. Richardson*." (2 *Jur.*, N. S. 1041.)

1179. BETTS v. MENZIES. [1857]

Where there is doubt as to the validity of the plaintiff's patent, but he has had eight years of undisturbed enjoyment under it, and the defendant has neglected to dispute the validity of the patent on a former occasion, when he had the opportunity of doing so, an injunction was granted, and plaintiff ordered to proceed to trial at law. (3 *Jur.*, N. S. 357.)

Wood, V.-C. said: "Where a person has been long in the enjoyment of a right, undisputed and undisturbed, he shall have the protection of this court in such enjoyment against an invader until such invader shall establish his rights at law; he shall be held to have a right to have his enjoyment protected, any disturbance of which it would be so difficult to compensate. On the other hand, it is true, it would be nearly as difficult to compensate the defendant if he be unjustly restrained." (*Ib.*) "The law of this court is, that where the patentee has had long enjoyment, there he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful." (*Ib.* 358.)

1180. CLARK v. FERGUSON. [1859]

Bill for an injunction to restrain the defendants from working the plaintiff's patent, dated April, 1859, for an improved kind of block for lowering boats. The defendants were employed

to manufacture blocks for the plaintiff, but having, as they claimed, discovered an improvement on the plaintiff's invention, they requested the plaintiff to introduce such alleged improvements into his specification, and allow the defendants a share of the profits. The plaintiff having refused this the defendants applied for a patent, and claimed a right to work their invention independently of the plaintiff. Injunction granted, under the circumstances, in spite of the recent date of the plaintiff's patent. (1 *Giff.* 184.) Sir J. Stuart, V.-C.: "It is not a mere matter of course, because a patent is recent, to call on the patentee to establish his rights at law before he can obtain relief in this court. It is in the discretion of the court to require a plaintiff to assert his rights at law or otherwise, according to the nature of the case." (*Ib.* 187.)

1181. HILLS v. EVANS. [1862]

Lord Westbury: "It is the habit and the rule of a Court of Equity not to grant that injunction (to restrain infringement), at all events at the hearing, and not to make it perpetual unless the legal validity of the patent has been conclusively established." (4 *De G., F. & J.* 289.)

1182. DAVENPORT v. JEPSON. [1862]

The court will, since the 25 & 26 Vict. c. 42, enter into the question of the validity of a patent on a motion for an interim injunction. The powers of the court are not limited by the above Act. (1 *N. R.* 173.)

1183. RENARD v. LEVINSTEIN. [1864]

Lord Justice Knight Bruce: "It is necessary, to support a motion to dissolve an injunction, that there should be at least a fair *prima facie* case in the opinion of the judge or judges who may have to decide the matter as to the validity of the specification; if not in every patent case, at least in one which arises upon a patent of no great age. . . . With a patent no older than the present patent is (three years), though its age is no objection to an interlocutory injunction of itself, in the present

stage of the cause there ought to be no injunction, and upon that ground alone I am of opinion that this injunction should for the present be dissolved." Defendant to keep an account. (10 *L. T. Rep.*, *N. S.* 177.)

1184. DAVENPORT v. GOLDBERG. [1865]

Where the plaintiffs have had thirteen years' user of their patent, their right to which had been established, once at law and once in a Court of Chancery, the validity of the patent is sufficiently established as against an infringer, who, in order to get rid of it, must proceed by *scire facias* to repeal it. (2 *H. & M.* 282.)

1185. BOVILL v. GOODIER. [1866]

Where the validity of a patent has not been the subject of any legal proceeding, the patentee must prove its validity at law before a Court of Equity will protect him; but having once established its validity, then a Court of Equity will protect him against another person until that person proves its invalidity.

But a defendant is not to be concluded by a trial at law, establishing the validity of the patent, to which he is no party, and is not to be driven to contest the validity of the patent by a *scire facias*. (35 *Beav.* 427).

1186. PENN v. BIBBY. [1866]

After a trial before the Vice-Chancellor, without a jury, in which issues were found for the plaintiff, a motion for a new trial having been refused by the Vice-Chancellor, and on appeal refused by the Lord Chancellor, was being taken by appeal to the House of Lords. The court declined to suspend the final order for an injunction pending the appeal to the House of Lords. (*L. R.*, 3 *Eq.* 308; 36 *L. J.*, *Ch.* 277.)

1187. THE WILLCOX AND GIBBS SEWING MACHINE CO. v. WOOD. [1869]

The court refused to restrain the defendants from selling as the plaintiffs' sewing machines, "with the latest improvements,"

old sewing machines manufactured and patented by the plaintiffs without such improvements. (20 *L. T. Rep.*, *N. S.* 10.)

1188. DUDGEON v. THOMSON. [1874]

Sir G. Jessel: "The court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

The fact of an interdict having been granted against the defendant by the Court of Sessions in January, 1873, held to be sufficient *prima facie* evidence of the validity of a patent for the United Kingdom granted in 1866, to warrant the court granting an interlocutory injunction. (30 *L. T. Rep.*, *N. S.* 244.)

1189. PLIMPTON v. MALCOLMSON. [1875]

An injunction to restrain an alleged infringement will not be granted on an interlocutory application, unless it can be shown that there has been active user of the invention, even where the patent has been in force for eight years. (44 *L. J.*, *Ch.* 257.)

Injunction—Infringement must be shown.

1190. HILL v. THOMPSON. [1817]

Lord Eldon, L. C.: "The affidavits in support of the injunction represent, that the defendants have made iron in the way mentioned in the specification. But, whether it is to be considered as a patent for extracting iron from slags or cinders, by working and smelting, and by the admixture of certain materials, to reduce the percentage to 40 per cent., or for mixing cinders, limestone, and mine rubbish in certain propor-

tions ; it should, before any injunction was granted, have been pointed out that the patent was actually infringed by so mixing the ingredients, or so reducing the percentage." (3 *Mer.* 625.)

1191. WOOD v. COCKERELL. [1819]

Per Lord Eldon: Where there is one question whether a patent is valid, and another question whether it has been infringed, the Court of Chancery would be going a great way if it took upon itself to grant an injunction. (2 *Coop.* 58 (n.).)

1192. ABBOTT v. WILLIAMS. [1837]

A party will be restrained from selling an article in such a state that it may be applied by others so as to infringe a patent, though they may not be restrained from applying it themselves to a different purpose. (9 *Rep. Arts.* 103.)

1193. LOSH v. HAGUE. [1837]

An injunction being applied for, it is not sufficient for the defendant to admit the infringement and promise not to repeat it, the plaintiff is still entitled to an injunction. (1 *Web. P. C.* 200.)

BRIDSON v. M'ALPINE. [1845] See **1213.**

ELECTRIC TELEGRAPH COMPANY v. NOTT. [1847] See **1166.**

HANCOCK v. MOULTON. [1852] See **1175.**

1194. DAVENPORT v. RICHARDS. [1860]

Where there is a *prima facie* case of infringement of a patent, the length of time which the patent has been enjoyed by the patentee will influence the court in granting an injunction against the parties who are alleged so to have infringed upon the patentee's rights. (3 *L. T. Rep., N. S.* 503.)

1195. NEILSON v. BETTS. H. L. [1871]

Where an alleged piracy has taken place abroad it becomes the duty of the defendant to give evidence of a negative

character to prove (in answer to the *prima facie* case made by the patentee) that the process used was of a different character from that which had been patented. Where that negative evidence was not given by the defendant, but positive evidence on the part of the patentee was given by one workman that he had been employed at the foreign manufactory, and there saw the capsules manufactured by a process not distinguishable from that of the patentee:—Held, that these circumstances justified the conclusion of identity of material and process, and were sufficient warrant for the grant of injunction. (*L. R.*, 5 *H. L.* 1.)

1196. BETTS v. WILLMOTT. [1871]

In a suit to restrain the sale of a patented article, it is incumbent on the plaintiff not only to prove the sale, but to prove that the article was not made by himself or his agents. (*L. R.*, 6 *Ch.* 239; 19 *W. R.* 369.)

Injunction—Delay and Acquiescence.

1197. LOSH v. HAGUE. [1837]

Sir L. Shadwell, V.-C.: “On the 23rd of March, the plaintiff received some information that there was an evasion of his patent, and some portion of time it appears was spent in making inquiries; there was notice given distinctly on the 8th of May. Then some further correspondence takes place, and letters between the parties; and then a bill is filed, on the 7th of July, and the application is virtually made. I cannot but think, therefore, that the plaintiff has come in sufficient time.” (1 *Web. P. C.* 201.)

1198. BACON v. JONES. [1839]

The plaintiff knew of the alleged infringement in August, 1835, but did not apply for an injunction till 1839. The court refused to grant an injunction or to retain the bill. (4 *My. & Cr.* 438).

Lord Cottenham, L. C., said: “It is no trifling grievance to

a defendant to have a chancery suit hanging over him for four years, in which, if the court shall so determine at the hearing, he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity, or even any proportionate advantage to his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time? It appears to me that it would be very injurious to sanction such a practice, more especially when I can find no case in which the court has thought it right to retain a bill, simply for the purpose of enabling a plaintiff to do that which these plaintiffs might have done at any time within the last four years." (*Ib.* 439.)

1199. BRIDSON v. BENECKE. [1849]

A special injunction, on notice, to prevent the infringement of a patent refused, on the ground of delay, notwithstanding the plaintiff's long enjoyment under the patent, and the establishing of its validity in an action against another party. (12 *Beav.* 1.)

Lord Langdale, M. R., said: "I think that a party coming for the assistance of this court to protect a legal right, not absolutely established, against the party who is alleged to have infringed it, ought to come at an early period. I do not say, at the earliest possible period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard, in the same condition as an injunction *ex parte*, which it would not be expedient to do. The rule of this court is very strict, that you must apply in proper time." (*Ib.* 3.)

1200. BAXTER v. COMBE. Ir. Ch. [1850]

Delay in filing the bill is a ground for refusing the injunction.

Where the patent was obtained in 1846, the alleged infringement of it took place in 1847, and the bill was not filed for more than two years afterwards, the injunction was refused. (1 *Ir. Ch. R.* 284.)

1201. HANCOCK v. MOULTON. [1852]

A patentee is not bound to bring actions in respect of every infringement, but in order to support an injunction against an infringer, who has been permitted to go on for some time, and against whom no action has been brought, distinct notice ought to be given to him that the patentees would seek to enforce their right. (*M. Dig.* 506.)

1202. NEWALL v. WILSON. [1852]

A patentee does not acquiesce in the infringement of his patent by omitting to proceed by *scire facias* to set aside a subsequent patent extending to part of his invention, unless such subsequent patent is put in practice. (2 *De G., M. & G.* 282.)

1203. SMITH v. THE LONDON AND SOUTH WESTERN RAILWAY COMPANY. [1854]

The owners of a patent for a peculiar mode of manufacturing iron wheels for railway carriages, having discovered that several railway companies were violating their patent, brought an action for damages against one of such companies only, but did not in any way give notice to the other companies to discontinue their infringements of the plaintiffs' right. In the action, the validity of the patent was disputed, and it was not decided until three years after the patent had expired, when a verdict was given for the plaintiffs, with large damages. Thereupon the plaintiffs filed a bill for an account of profits, and an injunction against another of the companies who had infringed their patent, complaining of acts done nine years before:—Held, that the delay was not excused by the pendency of the action, but was fatal in the plaintiffs' case. (*Kay*, 408.)

1204. BOVILL v. CRATE. [1865]

Where an interlocutory injunction to restrain infringement of a patent was moved for in a suit in which the bill was filed in July, and it appeared that the plaintiff wrote complaining

of the infringement in the preceding November, and knew of the defendant's proceedings in the previous August, the injunction was refused on the ground of delay. (*L. R.*, 1 *Eq.* 388.)

Injunction—Expired Patents.

1205. CROSSLEY v. BEVERLEY. [1829]

Injunction granted generally to restrain the sale, both before and after the term limited by the patent, of machines piratically manufactured while the patent was in force. (1 *R. & M.* 166; 1 *Web. P. C.* 119.)

1206. CROSSLEY v. THE DERBY GAS LIGHT COMPANY. [1834]

Although a patent has expired, the court will grant an injunction to restrain the sale of articles manufactured in fraud of that patent previous to its expiration. (4 *L. J., Ch.* 25.)

1207. PRICE'S PATENT CANDLE COMPANY v. BAUWEN'S PATENT CANDLE COMPANY. [1858]

On the 28th of November, 1856, the plaintiffs filed a bill for an injunction to restrain the defendants from infringing their patent. On the 10th of December the motion was heard, and ordered to stand over until the hearing, the plaintiffs to bring an action. At the hearing it appeared that the plaintiffs had obtained a verdict, and the defendants admitted that, down to the 8th of December, they had used the plaintiffs' patent process, but denied that they now had in their possession any candles or substances of which the bill sought to have an account:—Held, that, under these circumstances, the court could not grant an injunction, and consequently could not decree an account. (4 *K. & J.* 727.)

Sir W. Page Wood, V.-C, said: "The plaintiffs' patent is gone; and whatever may now appear, *ex post facto*, to have

been their rights when they applied for the interlocutory injunction, if, at the hearing, there is nothing upon which an injunction can operate, the arm of the court is stayed, and I am bound by the authorities to say, that, there being at the hearing nothing to which the jurisdiction of equity can attach, the case is reduced to damages, and the bill must be out of court." (*Ib.* 731.)

1208. DAW v. ELEY. [1867]

A. obtained, in a suit against B. for infringement, a decree by which the validity of the patent was declared, and an injunction was granted to restrain infringement. Upon motion to commit B. for breach of the injunction:—Held, that it was open to B., in answer to the motion to commit, to show that, the patent having been determined, there was no longer any order of the court in existence which he could be said to have infringed. (*L. R.*, 3 *Eq.* 496; 36 *L. J.*, *Ch.* 482.)

Injunction—Rival Patentees.

1209. BASKETT v. CUNNINGHAM. [1762]

Upon a bill brought by the king's printer to restrain the defendant from the publication of certain Acts of Parliament, &c., to which the patentees for printing law books were also defendants, the Court of Chancery refused to interfere between the contending parties, but left them to adjust their rights at law, and therefore only restrained the defendant from printing at any other than a patent press. (2 *Eden*, 137.)

1210. COPELAND v. WEBB. [1862]

Where two parties have obtained patents for the same invention, a Court of Chancery will not interfere by injunction, but leave them to try the legal right by *scire facias*, being disabled by reason of the first section of the 25 & 26 Vict. c. 42, from

directing a case for the opinion of a court of law. Under these circumstances it was ordered that the defendant should keep an account, and that the matter should stand over till the hearing. (11 *W. R.* 134; 1 *N. R.* 119.)

Procedure on Application for Injunction.

1211. BACON *v.* JONES. [1839]

In August, 1835, a patentee filed a bill to restrain an alleged infringement of his patent, and the defendant having by his answer denied the validity of the patent, and also the fact of the alleged infringement, the plaintiff made no interlocutory application for an injunction, but went into evidence in support of his case, and in May, 1839, brought the cause to a hearing. The Master of the Rolls, being of opinion that the plaintiff, upon the evidence, had not made out a case which would have supported an injunction if applied for in the interlocutory stage, refused to give him an opportunity of establishing his title at law by retaining his bill, with liberty to bring an action; and dismissed the bill with costs; and the Lord Chancellor, on appeal, affirmed this decision. (4 *My. & Cr.* 433.)

Cottenham, L. C.: "When a party applies for the aid of the court, the application for an injunction is made either during the progress of the suit or at the hearing; and in both cases, I apprehend, great latitude and discretion are allowed to the court in dealing with the application. When the application is for an interlocutory injunction, several courses are open: the court may at once grant the injunction, *simpliciter*, without more—a course which, though perfectly competent to the court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff's title; or it may follow the more usual, and, I apprehend, more wholesome practice in such a case, of either granting an injunction, and at the same time directing the plaintiff to proceed to establish his legal title, or of requiring him first to establish his title at law,

and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the defendant, in the meantime keeping an account. Which of these several courses ought to be taken must depend entirely upon the discretion of the court, according to the case made." (*Ib.* 436.)

"Generally speaking, a plaintiff who brings his cause to a hearing is expected to bring it on in such a state as will enable the court to adjudicate upon it, and not in a state in which the only course open is to suspend any adjudication until the party has had an opportunity of establishing his title by proceeding before another tribunal. And I think the court would take a very improper course if it were to listen to the plaintiff who comes forward at the hearing and asks to have his title put in a train for investigation, without stating any satisfactory reason why he did not make the application at an earlier stage. When he comes forward upon an interlocutory motion the court puts the parties in the way of having their legal title investigated and ascertained; but when a plaintiff has neglected to avail himself of the opportunity thus afforded, it becomes a mere question of discretion how far the court will assist him at the hearing, whether it will then assist him at all." (*Ib.* 437.)

1212. BACON v. SPOTTISWOODE. [1839]

Where a bill is filed by a patentee for an injunction to restrain an alleged infringement of his patent, the plaintiff is not precluded from asking for an injunction at the hearing by the fact of his not having applied for it on an interlocutory motion; but the not moving for the injunction imposes on the plaintiff, in such a case, the obligation of making out a clear and unexceptional title at the hearing; and if he fails in that, and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause as evidence of a *primâ facie* case, giving him a right to further time, for the purpose of enabling him to establish more satisfactorily his legal title.

A patentee brought the cause to a hearing, without having previously moved for an injunction, and, the court being of opinion that on the evidence then produced an injunction would

not have been granted on an interlocutory application, refused to retain the bill to give the patentee an opportunity of establishing his right at law, but dismissed it with costs. (1 *Beav.* 382.)

1213. BRIDSON v. M'ALPINE. [1845]

Lord Langdale, M. R.: "Where an injunction is asked to restrain the infringement of a patent, the court has occasion to consider—first, the validity of the patent; and, secondly, the fact of the infringement. Where those two facts are established, it is within the power, as it is the duty of the court, to grant the injunction.

"There are many cases in which it is not clear either that the patent is legally valid, or that it has been infringed. It depends on the degree of doubt which exists on these questions whether the court will grant the interim injunction. In such cases it will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction. These things are to be carefully considered: the right between the parties is a legal right, and being a legal right, this court, in cases where the matter is doubtful, is naturally anxious to obtain the decision of a court of law, where the matter is properly cognizable, before it interferes to prevent a party exercising his *prima facie* rights.

"According to the doubt which may exist in the mind of the court upon the facts, and, according to the degree of inconvenience to the parties, the court, not thinking fit to grant the injunction at the time, may take one of several courses: it may either refuse to grant the injunction simply, or it may refuse it on the terms of the party undertaking to keep an account, or it may direct the motion to stand over, on the terms of the plaintiff proceeding to a trial at law. When it has been determined that the plaintiff must first establish his right at law, the court does not generally interfere with the mode of trying the legal question, though in some instances it may require the parties to make the necessary admissions of facts to facilitate the trial. It is to be remembered that the proceeding is not like the trial of an issue, but an action in the ordinary form,

with which, generally speaking, the court will not interfere until the legal right has been determined at law. I must, however, qualify this by saying that, in cases of overwhelming mischief, this court has authority to interfere at any time." (8 *Beav.* 230.)

1214. STEVENS v. KEATING. [1847]

When the court grants an injunction, the order ought not merely to direct that an action shall forthwith be brought, with liberty to the parties to apply in case of delay, but to give such directions of its own, in the first instance, as will insure the speedy trial of the action. An injunction granted pending an action to be brought by the plaintiff, for the speedy trial of which special directions were given, was dissolved on the ground of the plaintiff not having duly complied with those directions. The plaintiff to keep an account. (2 *Ph.* 333.)

1215. THE PATENT TYPE FOUNDRY COMPANY v. WALTER.
[1860]

Sir W. Page Wood, V.-C.: "With respect to obtaining a perpetual injunction, the rule is established by *Bacon v. Jones*, that in patent cases, unless the plaintiff takes steps to bring the matter before the court by motion before the hearing, he will not, in general, be entitled to a perpetual injunction at the hearing. He is therefore not at liberty to wait for the hearing, but the court requires him to place the matter in course of investigation at the earliest possible period." (*John.* 730.)

1216. MAYER v. FIRTH. [1860]

In a suit for an injunction to restrain the defendants from infringing the plaintiff's patent, and for an account, &c., the plaintiff may move to proceed with an action at law to try the right, on a proper affidavit, without previously moving for an injunction. (2 *L. T. Rep., N. S.* 536.)

1217. BOVILL v. GOODIER. [1866]

An objection to the validity of a patent on the ground of the expiration of a foreign patent for the same invention cannot be

taken at the hearing of a suit to restrain the infringement of the patent, until it has been raised by the answer. (*L. R.*, 2 *Eg.* 195.)

FERNIE *v.* YOUNG. H. L. [1866] See 1254.

Order for Injunction.

1218. BETTS *v.* DE VITRE. [1865]

See this case for form of order for a perpetual injunction to restrain defendants from further infringement of a patent; as to costs personally against directors of a limited liability company, and as to accounts and inquiries to ascertain damages sustained by a patentee in consequence of the infringement of a patent. (12 *L. T. Rep.*, N. S. 51.)

1219. MURRAY *v.* CLAYTON. [1872]

The plaintiff was patentee of a brick-making machine. The defendants patented another machine, which was held by the Lords Justices, overruling the decision of the Vice-Chancellor, to be an infringement of the plaintiff's patent on the ground that the plaintiff's machine was entitled to protection as a new and useful combination of well known parts. By the terms of the order the defendants were restrained from selling any machines similar to those of the plaintiff and generally from imitating the plaintiff's invention, "or any part thereof or making any addition thereto or subtraction therefrom." The defendants shortly afterwards patented a new invention, in which many of the parts of the plaintiff's machine were used, but which did not present all the distinctive features of it nor exactly the same combination:—Held (on a motion by the plaintiff to commit the defendants for breach of the injunction), that the order for an injunction must be taken with reference to the pleadings, and the allegations in the bill, and that the defendants' last patent was not within the meaning of the order, but that, as there had not been strict compliance with the order in the other instances brought forward against the

defendant, no costs could be given him. An appeal from this decision was dismissed with costs by the Lords Justices. (21 *W. R.* 498.)

Account of Sales and Profits.

1220. JONES v. PEARCE [1831]

Shadwell, V.-C.: "Where an undertaking by the defendant to keep an account will afford to the court ample means of doing justice to the plaintiff, should his legal right be established, the court rarely grants the interim injunction." (2 *Coop.* 58.)

1221. CROSSLEY v. THE DERBY GAS LIGHT COMPANY.
[1834]

Lord Brougham, L. C.: It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on expending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit, without having ever been exposed to share in the losses which might have been sustained. Such delay is sufficiently explained when the conduct of the defendants has been such as to lull the plaintiff's suspicions to sleep. (1 *Web. P. C.* 120.) As to the practical difficulties in working out a decree, directing an account of profits made by an infringement, see the report of this case in 3 *M. & Cr.* 428.

1222. BACON v. SPOTTISWOODE. [1839]

A plaintiff is not entitled to any account, even though he may have a right to an injunction, when the bill alleges that the defendant has sold and used, it being the fact that he has sold for no profit, and it not appearing that he has used otherwise than by furnishing the patent article to his customers, although the defendant may have derived a collateral profit from the use of such articles by their customers, where that case is neither alleged in the bill nor proved. (1 *Beav.* 387.)

1223. HADDEN v. SMITH. [1847]

The plaintiff granted a licence to the defendant to use two patents, upon payment of certain royalties. The plaintiff afterwards put in a disclaimer as to part of his patent; the defendant refused to continue paying the royalties, on the ground that the licence was void. The bill prayed an account of royalties under the licence; and in case the defendant should dispute the plaintiff's right to payment by reason of the invalidity of the patent or otherwise, then that the defendant might be restrained from continuing to manufacture articles the subject of the patent:—Held, upon demurrer, that if the licence were void, and the defendant was not bound to account, he ought to be restrained from acting without the authority of the plaintiff. Demurrer overruled. (17 *L. J.*, *Ch.* 43.)

1224. MITCHELL v. BARKER. [1851]

Where, upon the face of the affidavits, the evidence as to the validity of the patent and its infringement was distinctly contradictory, an injunction was refused, but the plaintiff was directed to bring his action at law, the defendant undertaking to keep an account in the meantime. (39 *Lond. Jour.* 531.)

1225. SMITH v. THE LONDON AND SOUTH WESTERN RAILWAY COMPANY. [1854]

The right to a decree in equity for an account of the profits made by the manufacture and use of articles in infringement of a patent, is incident to the right to an injunction to restrain future infringements; and where no case is made for the injunction, the account will not be decreed. (*Kay*, 408.)

Wood, V.-C., in delivering judgment, said: "The true ground of the relief in these cases is laid down in *Bailey v. Taylor* (1 *R. & M.* 73), where Sir J. Leach, M. R., says 'The court has no jurisdiction to give to a plaintiff a remedy for an alleged piracy, unless he can make out that he is entitled to the equitable interposition of this court by injunction; and in such case the court will also give him an account, that his remedy here may be complete. If this court do not interfere

by injunction, then his remedy, as in the case of any other injury to his property, must be at law.' (*Ib.* 75.) Unless that primary right to an injunction exists, this court has no jurisdiction with reference to a mere question of damages." (*Ib.* 408.)

1226. PRICE'S PATENT CANDLE COMPANY v. BAUWEN'S PATENT CANDLE COMPANY. [1858]

The rule in patent cases, that this court cannot decree an account unless it can grant an injunction, applies, notwithstanding it may appear at the hearing that, since an interim injunction was moved for, the defendants have sold articles which, had the facts and law been then sufficiently ascertained, the court would have restrained them from selling. (4 *K. & J.* 727.)

1227. KERNOT v. POTTER. [1862]

An agreement was entered into between K. and P. that K. should take out a patent for purifying paraffin and assign it to P.; that P. thereupon would work it for fourteen years, if it could be so long worked at a profit; would not purify paraffin by any other process, and would pay to K. a royalty upon all purified paraffin sold. That P. would keep accurate account of all paraffin purified according to the patent, render them half-yearly and verify them. The patent was taken out, and P. commenced working upon it, but shortly afterwards abandoned the use of the process, alleging that it could not be worked at a profit, and refused to pay any royalty. K. thereupon brought an action at law for royalties, and recovered judgment. Pending this action, P. gave notice to determine the agreement, because the invention could not be worked at a profit. K., after obtaining judgment, filed his bill, asking for an account of subsequent royalties, an injunction to restrain the defendant from purifying paraffin under any other process, or, if the court should hold the agreement to have been determined, for relief against the defendant as an infringer of the patent:—Held, by the Lord Justice Turner, that in a case of this nature it was in the discretion of the court whether it would direct an

account or leave the parties to their remedy at law, and that, in the present case, the account being only a part of an agreement which the court could not wholly enforce, the plaintiff ought to be left to his remedy at law. (3 *De G., F. & J.* 447.)

1228. HILLS v. EVANS. [1862]

Where an injunction was granted to restrain an infringement, liberty was given to the plaintiff, instead of an account, to bring an action at law for damages, in lieu of an account. (8 *Jur., N. S.* 531.)

1229. EDWARDS v. NORMANDY. [1864]

E. being owner of one-third of an American patent, assigned his interest therein to N., the legal owner of the other two-thirds, in consideration of receiving one-fifth of the profits to arise from sales of the invention in America, for which N. agreed to account to him, and he deprived himself of all right to interfere in arrangements made for licensing such sales. N. was, in this transaction, the agent of a company who were beneficial owners of the two-thirds of the American patent, and of an English patent for the same invention, and was the exclusive manufacturer of the invention in England, but bound to supply his manufacture to the company only. The company granted to G. an exclusive licence for the sale of the invention in America, supplying him with machines at certain prices, higher than those at which they bought from N., and receiving from G. one-third of the net profits arising from the American sales:—Held, 1st, that G. was not liable to account to E. for his profits; 2nd, that the company were bound to account to E. for profits arising from the sale to G. at higher prices than were paid to N.; 3rd, that N. was not bound to account to E. for the profits arising from the manufacture of the invention. (3 *N. R.* 562; 12 *W. R.* 548.)

1230. MATHERS v. GREEN. [1865]

Where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention

without the consent of the others, and without accounting for the profits so made. (*L. R.*, 1 *Ch.* 29.)

1231. NUNN v. D'ALBUQUERQUE. [1865]

The defendant having in ignorance infringed the plaintiff's patent, submitted, and he offered before suit to pay the amount of profits made, which were very trifling. At the hearing, although a perpetual injunction was granted, no costs were given, and an account was granted only upon the plaintiff's request and at his peril. (34 *Beav.* 595.)

1232. RENARD v. LEVINSTEIN. [1865]

It is no sufficient answer to a motion for an interlocutory injunction that the defendant has volunteered to keep an account. (2 *Hem. & M.* 628.)

1233. FOX v. DELLESTABLE. [1866]

F. obtained a patent for umbrella ribs, and enjoyed it uninterruptedly to its conclusion, with the exception of an action for damages by H., another patentee, who recovered 300*l.* and a manufacture and sale of the ribs by D. & D. six months before it expired. F. filed a bill and restrained D. & D., and the cause came to a hearing nine months after the expiration of the patent. Malins, V.-C. said: "I have no hesitation in concluding that although the patent has expired, if the bill was previously filed, the plaintiff is entitled to an account, if the court sees a proper case for it; but I am relieved from so deciding on my own responsibility, inasmuch as very recently V.-C. Wood has so held; and, even if it had not been for that case, I should have come to the same conclusion. But regard must be had to the particular circumstances of the case, and the question is whether, under the circumstances of this case, I ought to give relief. To justify me in doing so, I must be satisfied of the validity of the patent." (15 *W. R.* 149.)

1234. MOXON v. BRIGHT. [1869]

A patentee agreed with a machine maker that the machine maker should make machines according to the patent and sell them, taking a certain sum upon each machine for himself, and paying to the patentee as a royalty the amount charged for the machines above that sum:—Held, that the patentee could not maintain a suit in equity for an account against the machine maker as agent, although in one case he received a sum of money for the patentee. (*L. R.*, 4 *Ch.* 292.)

1235. DE VITRE v. BETTS. [1873]

The rule that, upon a decree against a party for the infringement of a patent, the patentee is not entitled under 21 & 22 Vict. c. 27, ss. 2, 5, to have both an account of profits and an inquiry into damages, is now established, and applies to every case of infringement. The patentee must therefore elect which of the two forms of relief he will adopt. (*L. R.*, 6 *H. L.* 319; 21 *W. R.* 705.)

Damages.

1236. NEWALL v. WILSON. [1852]

An allegation as to the defendant's inability to be answerable in damages, held not irrelevant upon a motion for an injunction against the infringement of a patent. (2 *De G., M. & G.* 282.)

1237. NEEDHAM v. OXLEY. [1863]

Where a bill prays in the alternative an inquiry as to damages, or an account of the defendant's profits, but no issue as to damages was submitted to the jury, the court will not refer an inquiry to assess damages to chambers, but will grant the alternative. (8 *L. T. Rep.*, *N. S.* 604; 2 *N. R.* 388.)

1238. BETTS v. DE VITRE. [1864]

The jurisdiction given by the Chancery Amendment Act, 1858, to award damages when relief is sought by injunction

against wrongful acts, extends to the case where the court had previously the power of giving some other form of remedy, as, for example, an account of profits.

Since the Chancery Acts, 1858 and 1862, the question of damages will still be left to be decided by a jury where there is extreme difficulty in their assessment by the court itself.

Therefore, in a suit for an injunction by a patentee who had granted no licences, the court put him to his election whether he would have an account of profits or an action for damages against the defendants; following the form in *Hills v. Evans*. (11 *Jur.*, N. S. 9; 11 *L. T. Rep.*, N. S. 533.)

1239. DAVENPORT v. RYLANDS. [1865]

The plaintiff's bill prayed for an injunction against the infringement of his patent by the defendant, for an account of profits and for damages. After the filing of the bill, but before the hearing of the cause, the patent expired. The infringement being proved, the court held that, for the purpose of awarding damages under the act 21 & 22 Vict. c. 27, its jurisdiction related back to the time of the filing of the bill. For, otherwise, the object of the statute, which was to enable a Court of Equity to give full and complete relief to a suitor without recourse to a court of law, would be defeated. (*L. R.*, 1 *Eq.* 302; 35 *L. J.*, *Ch.* 204; 14 *L. T. Rep.*, N. S. 53.)

Wood, V.-C., said: "The inquiry will be in the form, 'what damage the plaintiff has sustained,' and not 'what damage, if any,' he has sustained, as it would be in the case of a trade-mark. There is this difference between the case of a trade-mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee." (*L. R.*, 1 *Eq.* 308.)

1240. PENN v. BIBBY. [1866]

Where bills to restrain the infringement of a patent have been filed against both the person who manufactures and the person who uses the article, and issues of fact have been found for the plaintiff, it is the right of the plaintiff to have not only an account against the manufacturer, but also damages against the person using the article, wherever it be found. (*L. R.*, 3 *Eq.* 308; 36 *L. J.*, *Ch.* 277.)

1241. PENN v. JACK. [1867]

A suit was instituted to restrain the defendants from infringing the plaintiff's patent for an invention applicable to steam vessels. By the decree the defendants were ordered to pay to the plaintiff the damages which he had sustained by reason of the defendants' user or vending of the invention. The plaintiff had been in the habit of granting licences to use the invention at the rate of 2*s.* 6*d.* per horse-power per ship:—Held, that the compensation to which the plaintiff was entitled was a sum calculated on this basis upon the ships to which the defendants had applied the invention, and that he was not entitled to any additional sum in respect of contracts which he had missed by reason of the defendants' piracy.

The plaintiff having, in another suit, obtained a decree against certain wrongful users (not being manufacturers) of unlicensed machines fitted by the defendants with the plaintiff's invention, had, in some instances, been paid his ordinary royalty by such users:—Held, that, in every such instance, no further royalty was payable by the manufacturer. (*L. R.*, 5 *Eq.* 81; 37 *L. J.*, *Ch.* 136.)

1242. BETTS v. NEILSON. [1868]

Damages may be awarded, although not specifically prayed by the bill; 21 & 22 *Vict. c.* 27. (18 *L. T. Rep.*, *N. S.* 159.)

1243. BETTS v. GALLAIS. [1870]

The court will not entertain a bill for the mere purpose of giving relief in damages for the infringement of a patent, when

the bill has been filed so immediately before the expiration of the patent as to render it impossible to have obtained an interlocutory injunction. (*L. R.*, 10 *Eq.* 392; 22 *L. T. Rep.*, *N. S.* 841.)

1244. NEILSON v. BETTS. H. L. [1871]

A patent having been sustained, the decree granted an injunction against further infringement, directed an inquiry as to damages and an account as to profits. The decree was varied by striking out, in accordance with the respondent's election, the order for the account of profits. Per Lord Westbury: The two things are hardly reconcilable, for if you take an account of profits you condone the infringement. (*L. R.*, 5 *H. L.* 1.)

1245. DE VITRE v. BETTS. H. L. [1873]

A suit had been instituted by a patentee to restrain the defendants from infringing his patent, and asking for an account of profits made by the defendants by sale or manufacture of the material which formed the subject of the patent. The validity of the patent and the fact of infringement by the defendants had been decided in the plaintiff's favour by the court without a jury. The plaintiff asked, at bar, for damages or for an account of profits of which he had been deprived by reason of such infringement. The court below directed an account of profits made by the defendants by the use and exercise of the plaintiff's invention, and an inquiry what sum ought to be paid by the defendants in respect of damage sustained by the plaintiff by the defendants' use and exercise of the plaintiff's invention.

The Lord Chancellor, on appeal to the House of Lords, said: "The case of *Neilson v. Betts* most undoubtedly decided the general principle that, upon a decree against a party for the infringement of a patent, the patentee is not entitled both to an account of profits and an inquiry into damages. That principle applies generally and without any distinction at all. It applies to every case of infringement; and, therefore, it must be taken to have settled conclusively that point, that the patentee must, in all these cases where he has a decree, elect whether he will

have an account of profits or an inquiry into damages. He cannot have both." Decree varied accordingly. (*L. R.*, 6 *H. L.* 321.)

Trial of Questions of Law and Fact.

1246. SPENCER v. JACK. [1862]

In a suit instituted to restrain an infringement, an issue was directed, as to the novelty of the plaintiff's "*invention*." On the defendant's motion, for this issue was substituted one, as to the novelty of the plaintiff's "*invention or manufacture*." On appeal it was directed, that the question of novelty should be tried on two separate and distinct issues; one, as to whether the plaintiff's improvements constituted a *new invention*; the other, whether it constituted a *new manufacture*. (3 *De G., J. & S.* 346.)

1247. DAVENPORT v. JEPSON. [1862]

The effect of the 25 & 26 Vict. c. 42, is, not to limit the power of a Court of Chancery, nor to affect its procedure, but to prohibit it from sending cases to be tried by a Court of Common Law. Consequently a defendant is entitled to have the question of the validity of the patent raised, even on an interlocutory motion. (1 *N. R.* 173.)

1248. NEEDHAM v. OXLEY. [1863]

On the trial of issues in a patent case, the court will allow an issue to go to the jury, for the purpose of raising, as a question of fact, the point whether there is a substantial variance as between the complete and the provisional specification. (8 *L. T. Rep., N. S.* 532.)

1249. YOUNG v. FERNIE. [1863]

In order to bring a case within the proviso contained in the 25 & 26 Vict. c. 42, s. 2, authorizing the Court of Chancery, notwithstanding the act, whenever it shall appear that a question

of fact may be more conveniently tried by a jury at the assizes, or at any sitting in London or Middlesex for the trial of issues in the Superior Courts of Common Law, to direct such trial, the Court of Chancery must be satisfied that the administration of justice in the particular case may be more conveniently exercised and promoted by directing such issues, than by completing the hearing and the inquiry before itself. (1 *De G., J. & S.* 353; 9 *L. T. Rep., N. S.* 590.)

Lord Westbury said: "In a patent case particularly, and in this case, having regard to the nature of the questions raised, I do not think that anything more inconvenient can be suggested than that, where there are mixed questions of law and fact, the one bound up with the other and scarcely capable of being separated, an attempt should be made to cut the cause in halves and to send one half of it to be tried by a jury in a Court of Common Law, reserving the other half for determination in this court." (1 *De G., J. & S.* 355.)

1250. CURTIS v. PLATT. [1864]

The practice introduced into Chancery of having separate issues is not peremptory, and must be regarded as nothing more than a convenient mode of arranging the questions to be decided by the court. (11 *L. T. Rep., N. S.* 250.)

1251. PENN v. JACK. [1866]

Upon the trial of issues in a patent case the plaintiff is entitled to call evidence in reply, for the purpose of rebutting a case of prior user set up by the defendant.

But after the evidence for the defence has been summed up, the defendant will not be allowed to adduce further evidence in answer to that given by the plaintiff in reply. (*L. R., 2 Eq.* 314; 14 *L. T. Rep., N. S.* 495.)

1252. MORGAN v. FULLER. [1866]

A defendant will not be allowed to add a totally new issue of fact not in any way suggested by his answer to the issues which have been already directed for trial.

In order to raise such new issue the defendant must file a supplemental answer. (*L. R.*, 2 *Eq.* 296.)

1253. BOVILL v. GOODIER. [1866]

After a patentee had established his patent as against one person at law, he instituted proceedings for an infringement against another in equity. The court granted the defendant an issue as to the novelty of the invention, but refused it as to the utility of the invention and the sufficiency of the specification, holding that the utility was not contested, or had been proved in the suit, and that the sufficiency of the specification had been already decided in the action at law, a decision in which this court, so far as it was matter of law not depending on the novelty of the invention, concurred. (*L. R.*, 2 *Eq.* 195; 35 *Beav.* 427.)

1254. FERNIE v. YOUNG. H. L. [1866]

Lord Westbury: "In the procedure of Chancery, according to the old practice, these rules were established. If, in the evidence given before the court, or in the proceedings before the court, there arose a considerable controversy upon a question of fact, it was usual for the Court of Chancery to direct an issue to be tried before a jury at common law, for the purpose of informing itself in what manner that question of fact ought to be answered; but when the proceedings before the Court of Chancery involved a mixed question of law and fact, then it did not direct an issue, but it directed an action, or it retained the bill in order that an action might be brought, for the purpose of having the assistance of a court of law both upon the question of fact by means of a jury and upon the question of law by means of the court. A third description of cases was this, namely, where relief was sought in equity founded entirely upon a legal title, and then, where the legal title had not been established by the decision of a court of law, it was the habit of the Court of Chancery to direct the bill to be retained, with liberty to the plaintiff to bring an action to establish his title; and such in the case of a bill brought by a

patentee for relief in a Court of Chancery was the settled rule of procedure, with the exception perhaps only of cases where the patent was of such age and had been so generally recognized and submitted to by the world that the Court of Chancery did not require that its legal validity should first be established.

“ Now, in that state of things it occurred to all men desirous of amending the law and removing the inconvenience consequent upon that necessity of a double procedure, that it would be desirable to make the Court of Chancery self-sufficient, and enable itself to try, by the aid of a jury, and by the oral examination of witnesses, all questions arising before it both of law and of fact. Accordingly, by the Chancery Amendment Act, 1858, in the 3rd section, power was given to the court to direct any question of fact to be tried by a jury before itself; and then, in another section, the court was empowered to dispense with the jury and itself to try the question of fact. This power given to the court was converted into an obligation by the Act of 1862, and extended to questions of law as well as to questions of fact. It is quite clear, therefore, that the procedure to be adopted under these statutes would, in the case of a patent, be analogous to, and altogether usurp the place of, the old mode of procedure which would have been adopted under the former practice. The legislature was extremely desirous of preserving and giving to the mode of procedure which it thus directed, the same legal effect that would have been given to the old procedure under an issue at law or an action at law. This desire has been emphatically expressed by the legislature in the words of the 5th section, in which it directs ‘ that the verdict of a judge shall be of the same effect as the verdict of a jury under this act.’” (*L. R.*, 1 *H. L.* 78.)

1255. *HOFFMANN v. POSTILL.* [1868]

V.-C. Giffard intimated that in future he should treat the hearing of issues in patent cases as the hearing of the cause, and would not advance them before the cases in the paper, except upon a special case made. (19 *L. T. Rep.*, *N. S.* 276.)

1256. HENDERSON v. RUNCORN SOAP AND ALKALI COMPANY. [1868]

A trial of issues will not be granted at the request of the defendant when opposed by the plaintiff. (19 *L. T. Rep.*, *N. S.* 277.)

1257. ARNOLD v. BRADBURY. [1871]

The usual issues may be granted in a patent suit before the hearing of the cause, although the defendant denies the validity of the patent. (*L. R.*, 6 *Ch.* 706, reversing the decision of the *V.-C.*, 24 *L. T. Rep.*, *N. S.* 613.)

Right to a Jury.

1258. NEEDHAM v. OXLEY. [1863]

When questions of fact are determined by a special jury before the Court of Chancery itself, it is not necessary to certify, under 21 & 22 Vict. c. 27, for the special jury. (2 *N. R.* 388; 8 *L. T. Rep.*, *N. S.* 604.)

1259. DAVENPORT v. GOLDBERG. [1865]

The defendant in a suit to restrain the infringement of a patent has no right to have the issues of fact referred to a jury *ex debito justitiæ*; and where the issues raised have been already determined, such reference will in general be refused. But if it appear that there is a really doubtful question at issue, the court will not decide it for itself, if either party desire a jury. (2 *Hem. & M.* 282.)

1260. TANGYE v. STOTT. [1865]

Where the plaintiff's counsel in his opening made charges which were not raised by the pleadings, and the defendant's counsel thereupon asked for a jury, the application was acceded to, and the cause ordered to stand over. (14 *W. R.* 128.)

1261. BOVILL v. HITCHCOCK. [1868]

The defendant to a bill for an injunction to protect a legal right cannot *ex debito justitiæ* require to have such right tried by a jury; for the court, before the statutes 21 & 22 Vict. c. 27, and 25 & 26 Vict. c. 42, sent such cases to be tried at law, not in order that they might be tried by a jury, but because the court, having no jurisdiction to try a legal right, required to have the judgment of a court of common law upon it. (*L. R.*, 3 *Ch.* 417.)

1262. PATENT MARINE INVENTIONS COMPANY v. CHADBURN. [1873]

In the absence of special circumstances the ordinary issues in a patent suit will be tried before the court itself without a jury. (*L. R.*, 16 *Eq.* 447; 21 *W. R.* 745; 28 *L. T. Rep.*, *N. S.* 614.)

*Particulars of Breaches.***1263. NEEDHAM v. OXLEY.** [1863]

Particulars of breaches delivered with a view to a jury trial of a patent case are sufficient, if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him. (1 *H. & M.* 248.)

Sir W. Page Wood, V.-C., said: "The object of having these particulars delivered, is to give the defendant fair notice of what the complaint against him is, not to tie the plaintiffs down to the precise terms of any verbal definition, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to; but I should be very sorry to introduce anything like special pleading into the practice of this court, or to allow verbal criticism to interfere with a determination of the merits of the contest." (*Ib.* 51.)

1264. CURTIS v. PLATT. H. L. [1866]

The plaintiffs are bound by the particulars of breaches delivered. The principle of the 41st section of the Patent Law

Amendment Act, 1852, is applicable to trials in chancery, in which particulars of breaches are ordered, as well as to trials at common law. (35 *L. J.*, *Ch.* 852.)

1265. BATLEY v. KYNOCK. [1874]

Although, upon the trial of questions in a patent suit, the plaintiff's particulars of breaches should give the defendant full, fair and distinct notice of the case intended to be made against him, it is not necessary, in the case of an alleged infringement of a patent for improvements in a particular article (*e.g.*, cartridges), for the particulars to point out the precise portions of the specification alleged to have been infringed when the thing alleged to be an infringement has been made an exhibit. (*L. R.*, 19 *Eq.* 229.)

See also *Action for Infringement—Particulars of Breaches.*

Particulars of Objection.

1266. CURTIS v. PLATT. [1863]

The principle upon which the court proceeds in regulating the form of particulars of objections on the trial of a patent case, is to guard against a surprise upon a plaintiff by production on the trial of evidence of prior user or publication of which he has no notice. Therefore it will require the defendant, in stating those instances on which he intends to rely, to put the plaintiff in possession of all he himself knows, so far as to enable him to identify the instances alleged. (8 *L. T. Rep.*, *N. S.* 657.)

1267. RENARD v. LEVINSTEIN. [1864]

On the trial of a suit in equity to restrain the infringement of a patent, the court, sitting without a jury, will not use the same strictness in matters of pleading as would be necessary in a trial before a jury; but will follow that course of procedure which it deems best in order to diminish the expense, and hasten the determination of the suit. Therefore, although a de-

fendant gave no notice of objection to the patent on the ground of prior publication up to the time of proving the cause, and only gave notice of such objection after the plaintiff's case was closed and the defendant's had been opened, the court then allowed a motion by the latter to amend his particulars of objection by an allegation of prior publication in a given document. Costs of motion and extra costs thereby incurred to be paid by the defendant in any event. (11 *L. T. Rep.*, *N. S.* 505; 13 *W. R.* 229.)

1268. DAW v. ELEY. [1865]

The defendant will not be allowed, in the course of the hearing before the court without a jury, to introduce evidence of a prior user not disclosed by the particulars of objection, although such evidence may have only come to his knowledge since the delivery of the particulars of objection. *Semble*, that the court will give the defendant leave, on short notice of motion, to amend his particulars of objection, so as to introduce such newly discovered evidence. (*L. R.*, 1 *Eq.* 38.)

1269. BOVILL v. GOODIER. [1865]

The defendant will not be required to deliver particulars of his objections to the patent, where replication has been filed and the court has refused to direct issues. (*L. R.*, 1 *Eq.* 35; 35 *L. J.*, *Ch.* 174; 35 *Beav.* 264.)

1270. DAW v. ELEY. [1865]

A plaintiff in a patent case, where the novelty of the invention is denied by the answer, has no right to a discovery of the particulars on which the defendant relies as showing a user of the thing patented prior to the date of the patent. (2 *Hem. & M.* 725.)

1271. MORGAN v. FULLER. [1866]

In a suit to restrain the infringement of a patent for improvements in the construction of carriages, the alleged inven-

tion consisting of a particular mode of opening and closing the heads of carriages, particulars of objections stating that head-joints similar to those used in the plaintiff's alleged invention had been, before the date of the patent, commonly used *by carriage builders generally throughout Great Britain*, and that head-joints, similar to those described in the specification, had been actuated in their motions in the way described, before the date of the patent, *by various carriage builders in or near London, Liverpool, Manchester and Southampton, and various other of the principal towns of Great Britain*, were held insufficient.

Semble, that where the objection points to the public use of a particular preparation, the words "by various makers in or near London," might be sufficient.

Semble, also, if the defendant could not give the names of the carriage builders *in or near London, &c.*, he would be required to specify the class or classes of carriages with respect to which the alleged prior user had taken place, and that might have been held sufficient. (*L. R.*, 2 *Eq.* 297.)

1272. BOVILL v. SMITH. [1866]

In a suit to restrain an infringement of a patent which is contested on the ground of anticipation by prior use, the plaintiff is not entitled to discovery from the defendant in answer to a general interrogatory as to the instances of prior user on which he relies. (*L. R.*, 2 *Eq.* 459.)

1273. PENN v. BIBBY. [1866]

Particulars of objections filed by a defendant were ordered to be amended by the insertion of words specifying "the persons by whom, the places where, the dates at, and the manner in which," there had been the alleged user prior to the date of the plaintiff's patent.

In complying with this order, the defendant was permitted, in his amended particulars, to preface his statement of the specific instances of alleged prior user with the words "amongst other instances," in order to give him an opportunity of apply-

ing for leave to re-amend by inserting any further instances of prior user which he might discover. (*L. R.*, 1 *Eq.* 548.)

1274. BOVILL v. GOODIER. [1867]

The object in directing issues to be tried at law is to ascertain the real state of the facts; and therefore the court in a patent case will allow further particulars of prior user of the invention to be brought forward on proper notice. (36 *L. J.*, *Ch.* 360.)

Evidence.

1275. THE SINGER SEWING MACHINE COMPANY v. WILSON.
[1865].

The provisions made for the taking of evidence by the General Orders of the 5th February, 1861, are not to be taken as altering the rules of procedure laid down by the 15 & 16 Vict. c. 86, except where the alteration is express. The former are, where not inconsistent with them, supplementary to the latter; therefore, although the time for cross-examination of a deponent given by Rule 19 had elapsed, the opposite party were still at liberty to compel him to attend and answer by the mode prescribed in sect. 40. (11 *L. T. Rep.*, *N. S.* 670.)

PENN v. JACK. [1866] See **1251.**

1276. POUPARD v. FARDELL. [1869]

Where a defendant to a suit in which replication is filed has given evidence of instances of prior user not mentioned in his answer, and leave has been granted to the plaintiff to adduce fresh evidence to disprove these instances, the defendant will not necessarily be entitled to bring further evidence to rebut the fresh evidence so adduced by the plaintiff. (18 *W. R.* 59.)

*New Trial.***1277. FERNIE v. YOUNG.** H. L. [1866]

Where a Court of Chancery has directed an issue to try a question of fact, before a jury, or before a judge without a jury, and a verdict has been found by the jury or the judge, it will not enter into the question of fact and set aside the verdict without a motion for a new trial or for judgment *non obstante veredicto*. (*L. R.*, 1 *H. L.* 80.)

If one party enrols a decree before the time for a new trial expires, the other party is not thereby prevented from moving for a new trial. (*Ib.* 64.)

1278. SIMPSON v. HOLLIDAY. H. L. [1866]

The Court of Appeal in Chancery has not, under the 21 & 22 Vict. c. 27, power, on an application for a new trial, to reverse the findings of a Vice-Chancellor on issues of fact tried before him, but, where the issues raise mixed questions of law and fact, if the decision of one of the questions discussed is sufficient to dispose of the case, the Court of Appeal may give a final judgment upon it, without ordering a new trial. (*L. R.*, 1 *H. L.* 315.)

1279. CURTIS v. PLATT. H. L. [1866]

The 3rd section of the 21 & 22 Vict. c. 27 (Chancery Amendment Act, 1858), does not, by reference to proceedings at common law, impose limits upon the right of appeal previously existing against any order made in the Court of Chancery. Where, therefore, an order had been made in the Court of Chancery by a Vice-Chancellor, on his own findings, upon a trial without a jury, and that order had been confirmed by the Lord Chancellor on appeal:—Held, that the order of the Lord Chancellor was the subject of appeal to the House of Lords. (*L. R.*, 1 *H. L.* 337.)

1280. PENN v. BIBBY; PENN v. JACK. [1866]

In dealing with the finding of the court below, upon questions of fact, under the jurisdiction given by the Chancery Amendment Act, 1858, the court of appeal is placed precisely in the situation of the judges of the courts of common law when a rule is obtained to set aside the verdict of a jury; consequently, the court will not consider whether the finding was proper, but merely whether there was sufficient evidence to warrant the verdict. Where the motion for a new trial is grounded on the improper rejection of evidence, the evidence ought to have been formerly tendered to the judge of the court below, and rejected by him. (*L. R.*, 2 *Ch.* 127; 36 *L. J.*, *Ch.* 455.)

*Consolidation of Suits.***1281. DILLY v. DOIG.** [1794]

Lord Loughborough, L. C.: "I do not remember any case upon patent rights, in which a number of people have been brought before the court as parties, acting all separately upon distinct grounds; it has always been against a particular defendant. In a case here, not long ago, upon *Boulton & Watts' Patent*, there were several bills." (2 *Ves. jun.* 487.)

1282. FOXWELL v. WEBSTER. [1863]

One hundred and thirty-four suits were instituted against as many defendants by a patentee for infringement of his patent, and interrogatories were served. Seventy-seven defendants, combining together amongst themselves so as to make four bodies in all, moved, before putting in any answer, that the plaintiff might be directed to proceed with one suit only until it should have been determined, or until the validity of the patent should have been finally determined, or until further order; and that the proceedings in the other suits might in the meantime be stayed, or that the time for answering and producing documents might be enlarged, the moving defendants

undertaking to be bound by the result of the selected suit so far as the question of the validity of the patent was concerned. The court, upon terms, and the plaintiff not opposing, made an order with a view of trying before itself the question of validity in the first instance, before entering upon the question of infringement. (4 *De G., J. & S.* 77.)

1283. BOVILL v. CRATE. [1865]

Wood, V.-C.: "After getting information of case after case of infringement, the plaintiff might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them: 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind?' I do not think any court could complain of a patentee for taking the course I am suggesting." (*L. R.*, 1 *Eq.* 391.)

Taking Bill Pro confesso.

**1284. THE GROVER AND BAKER SEWING MACHINE COMPANY
v. MILLARD.** [1862]

In a case where the defendant, who was out of the jurisdiction of the court, had not put in an answer, although the time for answering had long expired, and had never appeared to the bill, the court, on the plaintiff applying for leave to enter an appearance in order to take the bill *pro confesso*, ordered that notice should be given to the defendant, that unless he put in an answer within fourteen days from the service of such notice, an appearance would be entered for him, and proceedings taken to take the bill *pro confesso*. (8 *Jur.*, N. S. 713.)

*Bill of Review.***1285. DAW v. ELEY.** [1867]

A. obtained, in a suit against B. for infringement, a decree by which the validity of the patent was declared, and an injunction was granted to restrain infringement. If, upon motion to commit B. for breach of the injunction, it is shown that the patent has ceased to be of any validity at the date of decree:—Held, that the only mode of getting rid of the decree is by bill of review, showing that it was erroneous in declaring the patent to be valid and subsisting. (*L. R.*, 3 *Eq.* 509; 36 *L. J.*, *Ch.* 485.)

*Counsel.***1286. DAW v. ELEY.** [1865]

The practice, as to hearing counsel on the facts in issue before the court sitting as a jury, is the same as at common law, but as to the points of law arising in the same case, the ordinary practice of the court is observed. (13 *L. T. Rep.*, *N. S.* 399.)

Costs.

STOCKING v. LLEWELLYN. [1842] See **1117.**

1287. GEARY v. NORTON. [1846]

The plaintiff is entitled to the costs of an injunction, although the defendant promises to commit no further act of infringement. (1 *De G. & S.* 9.)

1288. STEVENS v. KEATING. [1850]

On a bill filed for an injunction, the plaintiff obtained the injunction on motion, the defendant appearing and opposing the motion; the bill was subsequently dismissed with costs:—

Held, that the defendant was entitled to the costs of the motion which he had unsuccessfully opposed. (1 *Mac. & G.* 659.)

1289. LISTER v. LEATHER. [1858]

Where the court considers the plaintiff entitled to full costs as between solicitor and client, the decree or order should contain an express direction that the costs be so taxed, notwithstanding the 43rd section of the Patent Law Amendment Act, 1852, provides that he shall have such full costs, unless the judge shall certify that he ought not to have them. (4 *K. & J.* 425.)

1290. CLARK v. FERGUSON. [1859]

Where the bill, praying for an injunction to restrain the infringement of a patent, described the plaintiff as a lieutenant in her Majesty's ship *Gladiator*, now on service, the court refused to compel him to give security for costs. (1 *Giff.* 184.)

1291. BETTS v. CLIFFORD. [1860]

On a bill to restrain the infringement of a patent, a motion for injunction was ordered to stand over until after the trial of an action, nothing being said about costs. In the action, the plaintiff succeeded on the issue as to the infringement, but failed in establishing the validity of his patent. The bill was afterwards dismissed with costs:—Held, that the defendant's costs of the motion were costs in the cause.

There must be some special circumstances, beyond the mere weight of the cause, to justify the allowance of the costs of a third counsel. Examples of such special circumstances are cases of illness, and cases where a junior counsel is called within the bar, and it becomes necessary, according to the rules of the bar, to retain another junior; and cases where the third counsel (of the common law bar) has been engaged in a case, the evidence and judge's notes in which form a substantive part of the plaintiff's case. (1 *J. & H.* 74.)

1292. NEEDHAM v. ONLEY. [1863]

In a suit for infringement before a court of chancery, the judge may grant a certificate, in accordance with 5 & 6 Will. 4, c. 83, s. 3, that the validity of the patent came in question, as upon an action in a court of common law. (8 *L. T. Rep.*, *N. S.* 604; 2 *N. R.* 388.)

1293. RENARD v. LEVENSTEIN. [1864]

Where the defendant was ordered to pay costs incurred by him through amending his particulars of objections, the court refused, on the application of the plaintiff, to put him upon the terms of given security for their payment on proof that he had a place of business in England. (11 *L. T. Rep.*, *N. S.* 505; 13 *W. R.* 229.)

1294. BETTS v. DE VITRE. [1864]

The directors of a limited company, and acting as its agents, infringed a patent, and were made defendants, together with the company, to a suit, the bill in which prayed for an injunction and costs:—Held, that the decree must be made against the directors as well as the company, and that the directors were personally liable to pay the costs. (11 *Jur.*, *N. S.* 9; 11 *L. T. Rep.*, *N. S.* 533.)

Sir W. Page Wood, V.-C.: “Where there is a wilful act against the rights of a patentee after he has obtained a verdict, and the certificate of a judge that his title came in question, all the world must be taken to know that that was fairly and completely tried and disposed of, and, if they infringe the patent, they infringe it, with a liability for costs, in consequence of the full right being disposed of.” (11 *Jur.*, *N. S.* 11.)

1295. DAVENPORT v. RYLANDS. [1865]

A patentee is entitled to costs as between solicitor and client at the discretion of the judge, under the 15 & 16 Vict. c. 83, s. 43, in any suit to protect his rights under a patent, the validity of which has been previously established, notwith-

standing the fact that the validity of the patent is not questioned in the subsequent suit. (*L. R.*, 1 *Eq.* 302 ; 35 *L. J.*, *Ch.* 204.)

1296. NUNN v. D'ALBUQUERQUE. [1865]

The defendant, having in ignorance infringed the plaintiff's patent, submitted, and he offered before suit to pay the amount of profits made, but did not offer to pay the plaintiff's costs. At the hearing, the court refused to give the plaintiff his costs, although a perpetual injunction was granted. (34 *Beav.* 595.)

1297. PENN v. BIBBY. [1866]

Where, in a suit to restrain the infringement of a patent, issues are directed, and the judge certifies that the validity of the letters patent came in question, the plaintiff cannot, at the hearing of that suit, have more than party and party costs, the provisions of the 43rd section of the Patent Law Amendment Act, 1852, applying only to subsequent actions and suits. (*L. R.*, 3 *Eq.* 308; 36 *L. J.*, *Ch.* 277.)

1298. PENN v. BIBBY. [1866]

Upon leave being granted to a defendant to re-amend objections by inserting certain further specified instances which had come to his knowledge, he was ordered to pay the costs of the application, and the costs arising out of and consequent upon the re-amendment were reserved. (*L. R.*, 1 *Eq.* 548.)

1299. DE VITRE v. BETTS. H. L. [1873]

The appellants gave notice to the respondent that a decision favourable to their contention on one point of the pending appeal having been given in another case by a court of final appeal, they were prepared to withdraw from the remaining points of their appeal and pay the respondent's costs up to the date of their doing so, on condition that the respondent would consent to a variation in the order appealed from, in conformity with the decision favourable to the appellants' one contention

which had been so given during the pendency of the appeal. The appellants added, that in the event of the respondent rendering it necessary to proceed with the appeal in spite of such decision they should, if successful, ask for the costs of the appeal. The respondent declined to consent to such variation:—Held, that he must pay the costs of the appeal from the date of his refusal to accede to the appellants' proposal. (21 *W. R.* 705.)

1300. BETTS v. CLEAVER. [1872]

Where a leader has been employed in a suit but not retained, the costs of employing him as third counsel at the hearing will not be allowed as between party and party, although the junior counsel who drew the pleadings has, before the hearing, been called within the bar.

A similar affidavit was filed by the plaintiff in each of several suits. The solicitor for the defendants took an office copy of the affidavit in one suit only, and examined at the Record Office the affidavits in the other suits:—Held, that he was not entitled to charge for perusing the affidavits in the other suits. (*L. R.*, 7 *Ch.* 513.)

ADDENDA.

1301. SMITH *v.* DICKINSON. [1804]

Action on an agreement by the defendant, not to avail himself of or to take any undue advantage of a communication made to him by the plaintiff, of an invention for which the plaintiff intended to take out a patent. The defendant committed a breach of the agreement by fraudulently obtaining a patent for the invention in his own name:—Held, that the plaintiff was entitled to recover damages for this breach. (3 *B. & P.* 630.)

1302. BLOXAM *v.* ELSEE. N. P. [1825]

If a servant, while in the employ of his master, makes an invention, that invention belongs to the servant, and not to the master. (1 *C. & P.* 558; *Ry. & Mo.* 187.)

1303. CALDWELL *v.* VANVLISSENGEN. Ch. [1851]

The Crown has always exercised a control over the trade of the country; and though restrained by the common law and the Statute of Monopolies (21 Jac. 1, c. 3) within reasonable limits, the Crown might grant the exclusive right to trade with a new invention for a reasonable period. The 21 Jac. 1, c. 3, did not create but controlled the power of the Crown in granting to the first inventor the privilege of the sole working and making of new manufactures. (9 *Hare*, 415; 16 *Jur.* 115; 21 *L. J.*, Ch. 97.)

1304. *In re* ASHENHURST'S PATENT. [1853]

The sealing of letters patent having been prevented by the filing of objections, which were subsequently withdrawn by the objector, the objector was ordered to pay the costs. (2 *W. R.* 3; 22 *L. T. Rep.* 109.)

1305. *In re* BRANDIES' PATENT. Ch. [1853]

On a petition to discharge an objection filed by H. against the sealing of a patent to the petitioner B., where B. and H. had been partners, and where the late Attorney-General had reported in favour of the petitioner, but the present Attorney-General had allowed the patent to H. to be sealed, a compromise was recommended to be settled by the junior counsel of the court, the patent to the petitioner to be forthwith sealed. (1 *Eq. Rep.* 121.)

1306. TILLIE & ANDERSON'S PATENT. [1854]

Where the sealing of letters patent has been delayed by the entering of a caveat, the Lord Chancellor has a discretion to extend the time beyond one month from the expiration of the six months of provisional protection. (2 *W. R.* 182; 22 *L. T. Rep.* 249.)

1307. MYERS v. BAKER. [1858]

In an action for a penalty under the 5 & 6 Will. 4, c. 83, s. 6, for putting on an article, made according to a patent, the words "K. & G. Patent Elastic," without the licence of the patentee, it is no defence "that the invention was not a new manufacture." But it is necessary to prove that such words did imitate, and were so put on by the defendant "with a view of imitating" the mark of the patentee. (3 *H. & N.* 802; 7 *W. R.* 66.)

1308. DAW v. ELEY. Ch. [1867]

The 15 & 16 Vict. c. 83, s. 25, applies where a foreign patent is *de facto* granted, though it is afterwards cancelled *ab initio*. (36 *L. J.*, Ch. 482; *L. R.*, 3 *Eq.* 496; 15 *L. T. Rep.*, N. S. 559.)

1309. LEE v. WALKER. [1872]

On the 28th of April, 1870, the plaintiffs retained the defendant, a patent agent, to obtain for them letters patent for "a new automatic vase or depôt for holding coals," and on

the 30th a provisional specification was filed. Nothing more was done by the defendant until the end of August, when he gave notice of his intention to proceed with the patent, pursuant to sect. 12 of 15 & 16 Vict. c. 83 ; and in October he applied for the fiat of the Attorney-General for sealing the patent.

In the meantime, viz., on the 15th of June, 1870, one P. had, as the defendant was aware, filed a provisional specification for "improvements in coal vases," which turned out to be substantially the same as the plaintiffs' invention, and had, on 10th of September, obtained a grant of letters patent for the same.

The Attorney-General rejected the plaintiffs' application, upon the authority of *Ex parte Bates*, where under similar circumstances the second applicant for provisional protection, in the absence of fraud, was held entitled to have his letters patent sealed, of which decision, though pronounced in May, 1869, the defendant was ignorant:—Held, that there was evidence of negligence on the part of the defendant. (*L. R.*, 7 *C. P.* 121.)

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LONDON :
PRINTED BY C. ROWORTH AND SONS,
NEWTON STREET, W.C.

